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# THE UNITED STATES PATENTS QUARTERLY

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## PREFATORY NOTE

With this issue, The United States Patents Quarterly is inaugurated to provide decisions on patents, trade marks and copyrights in a convenient and extensively indexed form.

Every effort has been made to prevent the publication from being merely another addition to the heavy loads already carried by shelves in the libraries of patent attorneys. Before the actual decision to issue the book was made, hundreds of letters were addressed to potential subscribers. These letters, asking whether the proposed service would be sufficiently valuable to warrant initiation, brought answers which stamped the contemplated service as thoroughly feasible. Many suggestions advanced in these communications from the leading patent attorneys of the United States have been incorporated in the publication.

The United States Patents Quarterly provides the texts of scores of decisions printed in The United States Daily during the indicated three-month period. Among these decisions are many not published elsewhere.

The decisions are arranged chronologically according to the dates of appearance in The United States Daily. Thus the publication may be used as a supplement to files composed of clippings from the daily newspaper.

The syllabi of all decisions are presented. These are keyed according to dates to serve in an intermediate manner between the indexes and the texts of the decisions.

All decisions are listed in the Table of Cases and in the Digest which is arranged alphabetically according to head notes. Indexes devoted to citations in the patents and trade marks decisions also are included. An additional index covers the numbers of patents involved in the decisions.

ASSOCIATED INDUSTRY PUBLICATIONS

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## MARCH 4

# *Outlet for Electrical Fixture*

EX PARTE RYAN. APPEAL NO. 1224, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1701935 was issued February 12, 1929, to Francis T. Ryan for electric fixture outlets, on application No. 67493, filed November 7, 1925.

The decision of the Examiner rejecting claims 1 and 2 for an electric fixture outlet was affirmed.

The Board found that appellant's device, in which the socket member was attached to the bottom of the box by means of a single fastening bolt located in an axial bore of the socket member was not patentable over a prior art device in which a plurality of attaching screws were employed, the screws extending longitudinally of the socket member and having threaded engagement with the part to which the socket member was attached.

Claim 3, differing from the prior art in specifying that the canopy at its upper end encircles the wall box, was deemed patentable.

Samuel N. Pond and Fisher, Towle, Clapp & Soans for appellant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Ruckman and Landers) follows:

This is an appeal from the action of the examiner finally rejecting claims 1, 2 and 3. Claim 1 is illustrative of the appealed claims and reads as follows:

"1. In an outlet fixture of the character described, the combination of a wall box having a tapped hole in its bottom, and axially bored socket member disposed with its base in contact with said box bottom, a fastening bolt passed through the axial bore of said socket member and threaded into said hole, circuit wires led through said box into said socket member, a plug cooperating with said socket member, and fixture wires leading from said plug."

The references relied upon are: Newton, 1469587, October 2, 1923; Symmes, 1483252, February 12, 1924.

The claims are drawn to an outlet fixture and are directed to that type in which a plug connection is placed in the wall box. The wires are received through an opening in the bottom of the box and connected to terminals in the socket member.

Wires lead from the plug member through a lateral opening in the pipe member by which the canopy and fixture

chain are supported. They pass longitudially through this pipe member and along the chain member.

The upper end of the canopy surrounds the lower edge of the wall box, said edge projecting below the ceiling. The socket member is attached to the bottom of the box by means of a single fastening bolt which is located in an axial bore of the socket member.

Claim 1 is drawn to emphasize this latter feature. However we believe the claim unpatentable over Newton, in which a plurality of screws are utilized for attaching the socket member to the member 19. The latter member is in turn fastened to the bottom of the wall box and consequently the bottom of said member in effect may be considered as a portion of the bottom of the wall box.

The attaching screws used by Newton extend longitudinally of the socket member and have threaded engagement with the part to which the socket member is attached. We believe it did not involve invention to use a single screw centrally located in lieu of the two screws shown by Newton.

Claim 2 is deemed unpatentable over Newton, in which the member 19 (see Fig. 12) may be regarded as the equivalent of the stud recited in the claim. The tube 40 is connected at its upper end by means of the parts 39 and 38 to the member 19. An opening is provided which permits the wires to extend laterally from the tube as they pass from the latter to the plug member.

Claim 2 is also deemed unpatentable over the patent to Symmes, taken in connection with the patent to Newton. Symmes' stud member 12 is not rigidly attached to the wall box, but we see no patentable novelty in this feature in view of Newton.

It is not believed the reference to the bottom wall of the box in the claim constitutes a clear distinction over Symmes in which the lower wall 2 may be regarded as the bottom wall.

Claim 3, in addition to the limitations discussed above, states that the canopy at its upper end encircles the wall box. This feature is not shown in either of the references. We deem this claim patentable.

The decision of the examiner is affirmed as to claims 1 and 2 and reversed as to claim 3. Limit of appeal to Court of Appeals 40 days. Rule 149.

## MARCH 5

# *Stone-like Table Top Fastener*

EX PARTE COPEMAN. APPEAL NO. 428, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1701529 was issued February 12, 1929, to Lloyd G. Copeman for Tables, on application No. 715046, filed May 22, 1924.

A prior patent, showing a table top of moulded stone-like material having embedded therein wooden base members and supporting frame members of moulded stone-like material connected to the top by clips embedded in the frame members, was held to anticipate several of claims 1, 2, 4, 5 to 11 directly and to differ from the others only as to immaterial features to be found in other references.

Claim 3, calling for means embedded in both the top and frame and extending through the wooden base member, a feature not present in the prior set, was allowed.

Upon a finding that claim 12 included internally threaded bushings embedded in the moulded material, a feature not present in any of the references, and that it had been improperly rejected as drawn to the old combination of a table and leg fastening and bracing means, it was passed as patentable.

Claim 13, differing from the art in specifying a supporting frame of moulded stone-like material having integral cross members of the same material for supporting table drawers with reinforcing members at the corners of the frame and

at the juncture of the cross members with the frame, was allowed.

Stuart C. Barnes for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Henry and Ruckman) follows:

This is an appeal from a final rejection of claims 1 to 13, inclusive. Claims 1, 9 and 11 are reproduced for illustrative purposes.

"1.—A table of moulded stone-like material, comprising a moulded top, a separate moulded frame for supporting the top, and means embedded in both the top and the frame for securing them together."

"9.—In a table, a frame structure of moulded stone-like material having angle members embedded in the material at the corners of the frame for reinforcing the frame."

"11.—In a table, a frame structure of moulded stone-like material having internally threaded bushings embedded in the moulded material for receiving screws adapted to secure the frame to other table parts."

The references relied upon are: Hendrick, 517005, March 20, 1894; Price, 948770, February 8, 1910; Cahill, 973165, October 18, 1910; Rice, 1384852, July 19, 1921.

The appealed claims are directed to the construction of a table of moulded stone-like material. Most of the claims state the construction broadly but some of them are limited to details of construction.

The claims have been rejected on the Hendrick patent in view of the patents to Price, Rice and Cahill. The view of the examiner seems to be that the general structure or organization claimed is disclosed by the Hendrick patent and the other references teach such modifications of the Hendrick construction as would be necessary to meet the appealed claims.

We think it is doubtful if the Hendrick patent is a good basic reference. The table top of the reference is not secured to the skirt portions, but merely rests thereon by gravity and there is nothing in the reference construction corresponding to the wooden base member included in a number of the claims.

In our opinion the Price patent is the most pertinent reference. It shows a table top of moulded stone-like material having embedded therein wooden base members. It also shows supporting frame members of moulded stone-like material connected to the top by clips embedded in the frame members.

Some of the claims are directly met by the Price patent while others differ from the disclosure thereof in immaterial details shown in other references. It is stated in the Price specification that the structure thereof may be used as a table, line 12, of page 1 and the description of Figure 1.

Claim 1 is literally met by the Price patent for the irons 3, 3, and the wooden blocks 9, 9, which constitute the means for securing the top 6 to the supporting frame 1 are embedded in the frame and top, respectively.

Claim 2 is also met by the Price patent. The beveled edges of the base members 9 embedded in the moulded top may be said to constitute a part of the means for permanently securing the top and frame together.

Claim 3 calls for a structural detail not disclosed in any of the references. We refer to the limitation to means embedded in both the top and frame and extending through the wooden base member. As the prior art is presented to us claim 3 should be allowed.

Claim 4 is not patentably distinguished from the Price reference, regard being had to the blocks 9 embedded in the table top and the irons 3 embedded in the frame. Moreover, the Cahill patent shows slabs of stone-like material secured together by pins embedded in the slabs.

Claims 5, 6, 7 and 8 are met by the Price patent. These claims are broader than claims 1, 2 and 4.

Claims 9 and 10 are not patentably distinguished from the Price construction. The members 3, 3, are embedded in the frame structure and serve to strengthen such structure. When the parts are assembled the members may be said to be embedded in an edge or corner of the frame structure. Moreover, there is nothing inventive broadly in reinforcing concrete at any point needing reinforcement.

Touching Claim 10, which calls for perforated angle members employed to reinforce concrete. This is shown at 7 in Figure 2 of the Price patent.

Claims 11 and 12 are included in the general rejection heretofore mentioned, in which the Hendrick patent is relied on as a basic reference. These claims include internally threaded bushings embedded in the moulded material. We do not find this feature in any of the references.

It may be that the examiner did not intend to reject Claims 11 and 12 along with the other claims, for it is stated that these claims were rejected as drawn to the old combination of a table-and-leg fastening and bracing means shown by the Hendrick patent.

We think the claims in question are not open to rejection on the ground of old or exhausted combination. The claims do not include the table top, and the legs are not directly included.

Claim 11, in our opinion, should not be allowed, since it only calls for internally threaded bushings embedded in moulded material for receiving securing screws. This is an old construction shown in the patents to Cleverdon et al., No. 913875, March 2, 1909; Percival, No. 938073, October 26, 1909; Bennett, No. 1108859, August 25, 1914.

Claim 12 is not met by the art of record or that cited against Claim 11, and may be allowed.

Claim 13 is directed to the supporting frame of moulded stone-like material having integral cross members of the same material for supporting table drawers with reinforcing member at the corners of the frame, and at the juncture of the cross members with the frame. The cited prior art does not show the structural limitations above enumerated. In the absence of a reference, Claim 13 should be allowed.

The rejection of Claims 1, 2, 4, and 5 to 11, inclusive, is affirmed. The rejection of Claims 3, 12 and 13 is reversed.

## MARCH 7

# *Method of Wiring Contact Pins*

EX PARTE GOODRIDGE. APPEAL NO. 1117, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1702234 was issued February 12, 1929, to Gilbert W. Goodridge for a method of wiring contact pins, on application No. 60898, filed October 6, 1925.

The method of connecting a lead wire within an open-ended contact pin, the only requirements being that the two elements be associated with flux between them at the proper place and then dipped into hot solder, was held to be unpatentable. Claims 1, 2 and 3 were disallowed. Claim 4, however, was found to include features not suggested in the references and was allowed.

Howson & Howson for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Skinner and Redrow) follows:

This is an appeal from the action of the examiner finally rejecting claims 1, 2, 3 and 4. Claims 1 and 4 are illustrative and read as follows:

"1. The method of connecting a lead wire within an open-ended contact pin, which comprises dipping the open end of the pin into hot solder while flux and

the lead wire are present within the pin at the open end thereof.

"4. The method of connecting a lead wire to a hollow pin having at its contact end an opening of less diameter than the internal diameter of the pin, which comprises coating an end of the lead wire with flux, passing said end through the pin until its fluxed end is extended through said end opening and portion of the flux is scraped off within the pin, and dipping said end of the pin in hot solder."

**References Are Cited.**

The references relied upon are: Lucas, 1322026, November 18, 1919; Brough, 1542366, June 16, 1925; Housekeeper, 1587156, June 1, 1926; "Soldering and Brazing" by Hobart, published 1919, Van Nostrand, N. Y.

This application relates to soldering and particularly to soldering the outer ends of the lead wires to the ends of the hollow contact pins through which the wires pass, in vacuum tube bases. The hole in the outer end of the hollow contact pin is but slightly larger than the lead wire so that when the lead wire with flux on it is thrust through the opening from the inside the flux will be scraped into a collected mass surrounding the wire just inside the opening in the end of the hollow pin. The assembled structure is then dipped into a bath of molten solder whereby the space between the end of the wire and the inside of the hollow pin and the hole where the flux is located are filled by solder, which solidifying in place makes a secure union.

**Three Claims Rejected.**

Claims 1, 2 and 3 while referring to the disclosed particular relation as to article are rather broad as to the actual soldering steps. The only requirements as to these are that the two elements be associated with flux between them at the proper place and then dipped into hot solder, stated in varying scope as to the assembling step. These claims may be in two ways, first that taken purely as steps of method, the references to the particular elements treated as no weight patentably in them, that is, that lead wire and contact pin are merely to be considered to be any two pieces of metal to be united and their form or function is immaterial, or second, that if any importance attaches to the elements, is invention involved here over uniting other pieces of metal by the dipping method, which is old? After full consideration we believe that the first view is the better of the two but in either case no patentable difference is involved over the references. Soldering by dipping two associated pieces of metal is old and the use of flux is so well known that no invention is involved in placing flux where union is desired in a dipping process. The publication by Hobart does not mention flux but it is thought to be clearly either an oversight or that flux was so well known that it was not thought necessary to mention it. It is certainly of no patentable novelty to use flux wherever found necessary in soldering. In the usual method and in Brough and Housekeeper flux is used without doubt. We see no patentable novelty in applying flux as broadly stated in the relation of claims 1, 2 and 3 or in applying the dipping process to uniting the wires and contact pin here involved. It seems to us that it would be one of the obvious ways of soldering here as elsewhere. It is not overlooked that it may be very convenient and give a good joint but we still think it lacks patentable novelty over the state of the art.

Claim 4 is believed to include features not suggested by any of the references and may be allowed.

The rejection is affirmed as to claims 1, 2 and 3 and reversed as to claim 4.

Limit of Appeal to Court of Appeals 40 days.

# Elements Separate in Prior Art Later Apparent in Combination

EX PARTE KNUFMANN. APPEAL NO. 1515, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1700535 was issued January 29, 1929, to Henry Leo Knufmann for a protector for mattresses, on application No. 709169, filed April 26, 1924.

The eight claims of the application rejected by the examiner, were found to be allowable on appeal as being for combinations which were not shown in any one of the references, though each of the elements of the combinations was shown to be old in some one of the patents cited.

Milans & Milans for applicant.

The full text of the decision of the Board of Appeals (First Assistant Commissioner Kinnan, Examiners-in-Chief Henry and Ide) follows:

### Rejected Eight Claims.

This is an appeal from the decision of the examiner rejecting all eight of the claims of the application. Of the rejected claims the following are repeated as typical and illustrative of all of the claims:

"1. A protector for mattresses comprising a sheet of flexible protective material, and stretching and holding means including separate spreading members associated with separate sections of the sheet at the side marginal portions thereof, the oppositely disposed spreading members of the respective sections of the sheet being of substantially equal length, flexible strap members, and means for connecting one of the strap members to each one of the spreading members and to a bed bottom.

"2. A protector for mattresses comprising a sheet of flexible protective material provided at each side with separate hems along separate side marginal portions thereof, separate rod members in said hems, flexible straps, and means for connecting one of the straps to each one of the rod members and a bed.

"3. A protector for mattresses comprising a sheet of flexible protective material, provided at each side with a hem along a side marginal portion thereof, rod members in the hems, flexible straps, and means for connecting the straps to the said rods and a bed, said means including coupling devices each having a portion fitting around one of the hems and rods, and having a part thereon for engagement by a part on one of the straps, and securing members extending through the coupling devices and into the rods."

The references relied upon by the examiner are: Mathews, No. 46569, February 28, 1865; Richards, No. 803193, October 31, 1905; Menten, No. 1151495, August 24, 1915; Bisbing, No. 1438475, December 12, 1922.

Other references of record are: Coffman (Fr.), No. 336826, January 28, 1904; Malarkey, No. 1107683, August 18, 1914; Brent, No. 1206808, December 5, 1916; Lavezzi, No. 1245244, November 6, 1917; Rodkey, No. 1402796, January 10, 1922.

The device forming the subject matter of the application is a mattress protector or covering designed for use upon sectional mattresses, the sections of which may be placed at angles to each other. The cover is provided with separate hems on each side thereof to receive separate stretcher rods. The rods are made in sections on each side of the cover so that when the mattress sections are placed at an angle to each other the cover and stretcher rods may conform therewith and the cover be held smoothly upon the sections of the mattress. Slits are cut into the cover from the edges thereof between the sections of the hems, and these slits are reinforced. To detachably secure the cover to the bed frame flexible straps having detachable fastening devices are provided, one for each stretcher rod section.

The claims are all drawn to combinations which are not shown in any one of the references. Each of the elements of the combination is shown to be old in some one of the patents cited, but they are not combined in any one mattress covering.

### Canvas Tautly Stretched.

The patent to Richards shows a canvas hammock-like sheet adapted to be stretched tautly between the bars of a stretcher. The sheet is provided with a hem on each of its longitudinal sides, in which there is a stretcher rod or bar 7,

and the canvas sheet is fastened to the side bars of the stretcher by means of flexible straps 8 and buckles.

The patent to Menten shows a combined cot and hammock comprising a canvas bottom having separated hems at its sides each containing a section of a sectional side bar. Slidable tubes on the sections of the side bars may be extended over the adjacent ends of the side-bar sections to hold the sections rigidly in alinement when the device is to be used as a stretcher or cot. The side hems are cut away at points opposite the connections of the side-bar sections to facilitate operation of the tubular couplings.

The patent to Bisbing shows a bed cover holding device comprising a rod, for each side of the bed, about which the edge of the bed cover is adapted to be wrapped. To secure the bed cover edge about the rod and to secure connected parts to the bed frame an elastic flexible strap is provided having at one end a spring hook adapted to be sprung over the wrapped rod to clamp the bed cover to the rod. The other end of the elastic flexible strap is provided with a ring to receive a belt having a buckle whereby the ring end of the strap may be secured to the bed rail.

The patents to Brent and Rodkey show a specific form of clamp resembling somewhat the form of hem engaging clamp shown in Fig. 3 of the application.

The patent to Coffman shows a specific elastic strap and hooks for securing the sides of a bed cover to a bed frame.

The patent to Lavezzi shows a detachable cover for a mattress. The parts of the cover are detachably fastened together by ball-and-socket fasteners.

Mathews shows a foldable bed bottom and mattress. The bed bottom is made in sections and foldable at angles to each other to form a chair support for the patient, or foldable together to form a compact package suitable to be carried by hand. This patent shows a waterproof cover or sheet detachably connected by bottonholes therein engaging over buttons on the mattress. There are no stretcher rods on the cover edges nor straps for securing the cover edges to a bed frame.

**Detachable Means Shown.**

The patent to Malarkey shows detachable means for connecting the corner parts of a cover to a mattress.

Claims 1 and 2, as now presented, are more specific than claims 1 and 2 originally presented or the amended claims 1 and 2 that were finally rejected. The present claims 1 and 2 were admitted by the examiner for the purpose of appeal but different references are now relied upon by him to anticipate these claims in their present form. Claim 1 is rejected on Mathews in view of Richards, Menten and Bisbing. The examiner says:

"Mathews shows the idea of stretching a protective fabric over a mattress.

"Richard shows the desirability of introducing spreading members 7 in hems of the fabric to secure a smooth effect. Menten shows that if such members are to conform to a changing inclination they should be made in separate parts or selections. Bisbing shows that such members may be held in place by a flexible strap attached to a part of the bed bottom.

"The sections of Menten are of substantially equal length."

To apply the references cited by the examiner for claim 1 it is necessary to modify the construction of Mathews to show "spreading members associated with separate sections of the sheet at marginal portions thereof," shown in the cot or hammock bottom of Menten who shows no mattress cover at all. It is also necessary to substitute for the button hole and button fastening means of Mathews for securing the cover to the mattress, flexible strap members, and means for connecting one of the strap members to each one of the spreading members and to a bed bottom. Mathews does not show either one or a plurality of stretcher members to which the flexible strap members could be secured, as specified in the claim. We think there is not sufficient foundation in the patent to Mathews to sustain the rejection of claim 1.

The examiner says: "Claim 2 is rejected on Mathews in view of Richards and Menten for the reason given against claim 1. Menten has separate hems."

**Comparison Made.**

Mathews does not show either hem, stretcher bar or flexible strap in connection with the mattress cover and we think the patent to Mathews should either show these parts or equivalents there or to support the rejection. Claim 2 should be allowed for the same reason as claim 1.

The examiner says: "Claim 3 is rejected on the same references as claim 2 with the addition of Bisbing, showing parts 7 having a portion fitting around the rods and having parts 9 for en-

gagement with a part of the fastening strap. It would not involve invention to fasten these parts 7 to the rods by common fasteners such as staple tacks."

We think claim 3 should be allowed, inasmuch as the foundation reference would have to be modified to show some missing features that are claimed and of these features that are shown in other patents there would have to be a modification of the structure thereof to make them conform to the terms of the claim.

The remaining claims are more specific than those already considered and since many references are relied upon to disclose all of the elements we think these claims should also be allowed.

The decision of the examiner is reversed.

# *Equipment for Use in Canning Fish*

NICHOLAS v. E. W. BROWN COMPANY. No. 1149, DISTRICT COURT FOR THE DISTRICT OF MAINE.

APPARATUS for use in the fish-canning industry, set forth in plaintiff's patent No. 1492178, covering a combination consisting of three elements, a conveyor for feeding loaded trays of fish to packing stations located at intervals along the side of the apparatus, a refuse conveyor at a lower level, and a means for delivering waste from the bed of the feeding conveyor to the refuse conveyor on the lower level, was held not infringed.

The court ruled that since plaintiff's and defendant's devices were alike, except that the patent included a means for delivering the refuse from the bed of the feeding conveyor down to the refuse conveyor at a lower level, and this element the plaintiff had been required to abandon in view of prior art, he could not claim equivalency based upon that element.

Also, it was stated that, since defendant omitted this element from the combination, its device did not infringe, since the omission of one element of a combination covered by any claim averts any charge of infringement based on that claim, whether or not the omitted ingredient was essential to the combination, and whether or not it was necessary to the operativeness of the machine.

The full text of the opinion of the court, delivered by Judge Peters, follows:

This is a suit at law to recover damages for the infringement of plaintiff's patent No. 1492178, an apparatus for use in the canning industry. The defense is invalidity of the patent, based upon non-patentability, and non-infringement.

**The First Defense.**

I have not considered the first defense, because the presumption of validity accompanying the patent, and the fact that the apparatus described has been apparently recognized by the trade as a valuable and important new contrivance in the packing business, are sufficient to overcome the suggestion of invalidity made by the defendant, but not generally urged.

The defense of non-infringement is more important and in my opinion must prevail.

This is a combination patent in which there are three elements, a conveyor for feeding loaded trays of fish to packing stations located at intervals along the side of the apparatus, a refuse conveyor at a lower level, and a means for delivering waste from the bed of the feeding conveyor to the refuse conveyor on the lower level. In the second claim of the patent this means of delivering waste from the path of the feeding conveyor to the refuse conveyor on the lower level is described as consisting of chutes which run from the feeding table to the refuse conveyor.

The packing stations above referred to consist of tables at intervals along the side of the conveyor apparatus at which the operatives stand, take the fish from trays running by them on the feeding conveyor, place them in cans which the operatives take from a second level of the conveyor as it passes them, place the fish in the cans and scrape the refuse down a hole in the operating table where it is carried by a chute into the refuse conveyor.

In the claims originally filed by the

plaintiff this packing or operating table with a conveyor for bringing the fish to the operator, the refuse conveyor, and "chutes for delivering refuse from the tables to the refuse conveyor," all in combination, were described in claim 6, but this claim was rejected by the Patent Office in view of a previous patent to Thomas, and abandoned by the plaintiff.

By agreement of counsel I have examined the apparatus of the defendant, alleged to be an infringement, and an apparatus installed by the plaintiff which he says, typifies his invention. It is apparent, both from the evidence and from an inspection of these apparatus, that they are practically alike, except in the matter of delivering the refuse from the bed or path of the feeding conveyor down to the refuse conveyor at the lower level.

In the patent as described, and in the apparatus typifying the patent, this waste is carried by chutes running from apertures at intervals in the conveyor bed above, outside of the various levels of the conveyor, down to the refuse conveyor at the low level.

In the defendant's apparatus there is no such arrangement at all. The chutes are entirely lacking; the angle iron at the side of the conveyor bed is raised an inch and a half, so that the refuse from that bed in which runs the feeding conveyor can be swept out, and it is in practice swept on to the floor.

It may be that some of this refuse in being swept out falls on the packing tables and thence finds its way down the chutes leading from that table to the refuse conveyor; but this is incidental only, as the waste is swept indiscriminately on the floor or wherever it may fall.

It is urged by the plaintiff that the raising of this lip on the side of the feeding conveyor, leaving an aperture all along the side through which waste can be swept, together with the opportunity of sweeping it towards central points and thence on to the packing tables by which it could be sent down the packing table chute to the refuse conveyor, constitute "means located at intervals along the path of the loaded trays for delivering refuse from said path to the refuse conveyor."

It is not done so in practice, but doubtless could be done with sufficient effort, but if done would simply be using the chute from the packing table to the refuse conveyor, which chute is no part of the patent, having been eliminated by the Patent Office.

In other words, the "means" in the defendant's apparatus for delivering refuse to the refuse conveyor is simply means for delivering refuse from the conveyor table on to the floor from which it cannot find its way into the refuse conveyor (except by being shoveled up and placed in); with a possible opportunity by scraping the refuse in the conveyor bed into central points and then sweeping it on to the packing tables to be carried thence into the refuse conveyor. But, if done in this cumbersome way, it would be outside of this patent.

### A Combination Patent.

This being a combination patent, its combined elements in every ingredient must have been used by the defendants to sustain the charge of infringement. Dry Hand Mop Co. vs. Squeez-Ezy Mop Co. 17 Fed. (2nd) 465. As stated in Walker on Patents:

"Omission of one element or ingredient of a combination covered by any claim of a patent averts any charge of infringement based on that claim, whether or not the omitted ingredient was essential to the combination of the patent, and whether or not it was necessary to the operativeness of the machine."

It is true, of course, that in the case of the withdrawal of one ingredient in a patented combination and the substitution of another, if the ingredient substituted performs substantially the same function, such a substitution cannot avoid the charge of infringement; but here the plaintiff claims equivalency based upon an element that he has been required by the Patent Office to abandon in order to secure his patent. This he cannot do. Smith v. American Electric Rabbit Racing Association, 21 Fed. (2d) 366, at page 370, and cases cited.

The plaintiff must show that the defendant's substitution of another device for his method of carrying refuse from one level to another performs substantially the same function in substantially the same way as the omitted element, in order to maintain his charge of infringement.

It is perfectly clear that the arrangement of the defendant, viz, elevating one side of the conveyor bed for the sweeping out of refuse on the floor, is very far from performing the same function as chutes at intervals carrying all the refuse from the conveyor bed to the refuse conveyor, and that the same result is not achieved at all, because in the plaintiff's apparatus the waste is delivered from the conveyor bed into

the refuse conveyor, and in the defendant's apparatus it is delivered from the conveyor bed on to the floor in actual operation, with simply a possibility by manual labor of gathering it and placing it on the packing tables and delivering it thence from the chute to the refuse conveyor, of which latter operation the plaintiff is precluded from having any monopoly.

It follows that the defendant's apparatus lacks one element of the plaintiff's invention, and that there is no substitution of an equivalent element, as equivalency is regarded in the law.

Judgment should be rendered for the defendant with costs.

January 24, 1929.

# *Ignition Switch Locking Device*

EX PARTE MOORHOUSE. APPEAL NO. 1591, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1701584 was issued February 12, 1929, to Alfred Moorhouse for Motor Vehicles, on application No. 642447, filed May 31, 1923.

The examiner's rejection of claims 15 and 18 for a locking arrangement for automobiles, involving ignition control, as being for aggregations, was affirmed.

As to claim 15, the Board found that each of the two ignition control switches set forth, just as a switch, was independent in structure and operation from the other, this being distinguished in action from the action involved in an interlocking switching system used in railways, etc.

Claim 18, it was stated, involved the same question together with the further association of a gasoline valve and a gear shift latch, and was not considered allowable in that the elements were not dependent.

Milton Tibbetts for applicant.

The full text of the decision of the Board of Appeals (First Assistant Commissioner Kinnan, Examiners-in-Chief Redrow and Landers) follows:

This is an appeal from the rejection of two claims for a locking arrangement for automobiles.

The object of applicant's mechanism is to prevent the accidental or negligent leaving of the key in the lock when the machine is parked and the driver leaves it.

This is accomplished by so arranging a lock in association with the switch handle that the key must be inserted and removed before the switch handle can be moved to the "on" position. This temporary insertion of the key unlocks the lock and so sets it that it stands unlocked, permitting the switch handle to be moved to the "on" position but automatically relocks without the use of the key when the switch handle is returned to the "off" position in stopping the engine.

Sixteen claims directed to the above feature in various combinations and scope have been allowed.

An issue which is the subject of this appeal has arisen as to the association of additional elements with the above lock and switch. The principal contention relates to the association of another switch in series with the above mentioned lock switch.

The two claims appealed are:

"15. In a motor vehicle, the combination with the wiring of the ignition system of a switch in said wiring, means for locking said switch and requiring removal of the key for unlocking it, and a second switch in said wiring adapted to control the ignition when the first switch is in 'on' position.

"18. In a motor vehicle, the combination with the gear shifting mechanism, the fuel line, and the ignition system, of a device adapted to control said transmission mechanism, said fuel line and said ignition system, means for locking said device and preventing the turning thereof until the key has been turned and removed from the lock, and a manually operable switch arranged in series in the wiring of said ignition system."

The ground of rejection is aggregation.

In the above claim 15 the first switch referred to is switch 25 and corresponds to the usual switch in the ignition circuit while the "second" or "manually operated" switch 31 is merely another simple switch with no locking means, to be opened and closed at will and provided for the convenience of garage workmen. The function of this second switch is to serve as a time saving means to open or close the ignition circuit when the engine is being "tuned up" and where the other lock switch, involving as it does several distinct acts

and a key to manipulate it each time would be too slow and troublesome for the numerous throwings on and off.

In this case while the workman uses the second switch the first or lock switch must of course be left in the closed or "on" position and while the driver is using the car and the first switch, the second switch must likewise be constantly closed or "on." The two switches are to this extent dependent on each other, as long as both are in the circuit. But considering the question of patentable combination, the same would be equally true if there were three, a hundred, or any number of switches all in series in the same circuit, and it would be true regardless of the type of each. Many types might be used together. This is not such cooperation as to make each switch dependent on one or more of the others in the sense used in the patent law.

The question presented is whether the operation of one of the switches requires the presence of another switch at all in the same circuit in order that it may work, or work better. This can be answered in the negative. Each switch, just as a switch, is independent in structure and operation from each of the others. Appellant's two switches can be distinguished in action from the action involved in interlocking switching systems of railways, electric power and telephone plants where various switches, mechanical or electrical, are so interconnected that when one throws in or out, one or more others automatically move to a different position from that in which they stood. That can be classed as a system, but here each switch is simply closed and merely forms so much inert section of circuit as a piece of wire, and could as well as such so far as any active cooperation is concerned. The fact that the two switches involved here are positioned closely together does not raise any possible doubt because they could as well be widely separated. The knife switch could be placed on the wall of the garage if desired and still function as fully and completely as though on the back of the instrument panel of the machine. It seems very clear that there is not that mutual dependence and active cooperation between the two switches here that amounts to a true patentable combination. The situation is identical with the use of a socket switch and a wall switch usually used in ordinary house wiring of eletcric lights. Such pair of switches clearly is not a proper combination in the patent sense.

The action of the examiner is therefore affirmed as to this point.

Claim 18 involves the same question together with the further association of a gasoline valve and a gear shift latch operate din addition to and by the same switch arm that operates the ignition switch, and which are consequently locked and unlocked simultaneouly with it.

**Adds to Aggregation.**

We are positively of opinion that the association of these additional features to the features of claim 15 only adds to the aggregation there involved. It cannot be understood how in any sense the gasoline valve affects the operation of the ignition switch or vice versa, likewise the gear lock, or how any one of the three depends on one or both of the others in true combination sense. It is admitted that the ignition and the gas and gear shift must all be "on" when the car is in operation, but that it not sufficient to form them into a dependent and patentable combination. It is also true that the crank shaft, the ventilating fan, the water and oil pumps, the generator, speedometer and other attachments of the machine should be in simultaneous operation. These might each or all be similarly connected up in a lockable group, but it is most clear that they would not thus enter into a true combination in the patentable sense. The gas line and gear shift and ignition are no more directly dependent than any of the above.

The examiner is affirmed as to his conclusions as to this claim also.

Two claims, 19 and 20, were proposed after final rejection but have been withdrawn by applicant, page 3 of the brief. They are therefore not discussed. It may be noted, however, in this connection, that the patent to Lucier cited by the examiner as relevant to those claims fully discloses and anticipates any claim for alleged combination along the line of two switches in series and further with a third element to be locked, in that case the hood of the machine.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

## MARCH 8

# *Infringement of the "Cracking" Process for Refining Petroleum*

SKELLY OIL COMPANY, DEFENDANT-APPELLANT, v. UNIVERSAL OIL PRODUCTS COMPANY, PLAINTIFF-APPELLEE. No. 3781, CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

PROCESS claim 2 and apparatus claim 4 of Patent 1281884, relating to that branch of the art of refining petroleum oils known as "cracking," were held to be valid and infringed.

The court stated that the invention resided not in the cycle movement of oil in a closed system or structure, which was old in the art, but in drawing objectionable foreign matter out of the system by continuously discharging or drawing off a portion of the degraded oil as it circulates with the foreign matter in suspension and continuously feeding back an equal amount of fresh oil whereby the bulk of the oil in the system shall be kept constant in quantity, and the period of a run of a cycle system with its attendant advantages could be materially lengthened.

This device or arrangement the court found not to be anticipated by two systems described in prior patents, in one of which valves were provided for drawing off some of the oil loaded with impurities and in the other of which provision was made to replenish the bulk, but the combination of the two systems to permit a continuous recirculation of old and new oil was not disclosed.

**Continuous "Feed and Bleed."**

Defendant's device, differing from the patent structure in the character of boiler or heater employed, which was in itself old in the art, and using a larger bulk of charging stock, but resembling the patent device in the addition of a continuous "feed and bleed" in a measure that maintains the charge in constant volume as it revolves in a closed ring, of which the boiler is only a part, was held to constitute an infringement.

Appeal from the District Court for the District of Delaware.

John W. Davis, William H. Davis and W. P. Z. German for defendant-appellant, Thomas G. Haight, William F. Hall, Frank L. Belknap, Charles M. Thomas of counsel, and Ward, Gray & Ward, solicitors for appellee.

Before Buffington, Woolley, and Davis, Circuit Judges. The full text of the opinion of the court, delivered by Judge Woolley, follows:

Speaking of the parties as they stood in the trial court, the plaintiff, owner of Letters Patent No. 1281884, issued in 1918 to M. J. Trumble, brought this action against the defendant (Skelly Oil Company) for infringement of claims 1, 2, 3 and 4. Against the defenses of want of invention, anticipation and non-infringement the trial court found the four claims in suit valid and process claim 2 and apparatus claim 4 infringed. 23 Fed. (2d) 111. The defendant took this appeal which is directed, and limited, to validity and infringement of the latter two claims under the same defenses.

The Trumble patent relates to the art of refining petroleum oils and purports to provide a process and apparatus by which petroleum oils of high specific gravity (heavy oils) may be converted into oils of low specific gravity (light oils) at a saving of cost. More particularly, the invention relates to that branch of the art of refining petroleum oils known as "cracking." The art is old and as Trumble's invention is an improvement upon one of its late developments it will be necessary to state the art in outline in order to understand what Trumble did in an inventive way and what he accomplished.

**Recovery by "Cracking."**

Crude petroleum consists of a complex mixture of hydrocarbons differing in specific gravity. Stated according to the range of their specific gravity from low to high, they are incondensible gases, gasoline, kerosene, gas oil and lubricating oil, leaving fuel oil, tar, pitch, asphalt or coke as a residue. These closely combined mixtures may be physically separated and recovered at atmospheric pressure by progressive vaporization at their respective boiling points through the familiar process of fractional distillation practiced in many arts. Air Reduction Co. v. Carbon-Oxygen Co., 17 Fed. (2d) 138; 19 Fed. (2d) 1014; Southern Electro-Chemical Co. v. du Pont Company, 20 Fed. (2d) 97, 101. So, also, they may be recovered by cracking. But cracking is an operation wholly different from fractional distilla-

tion. It involves a chemical reaction and effects a partical conversion, or breaking up, of the complex hydrocarbon molecules of the heavier constituents of the mixutures, by the application of heat and pressure, into the molecular structure of the desired lighter distillates, for instance, gasoline, the one now greatly demanded of the industry and chiefly concerned in this litigation. An unavoidable incident of the cracking process, however, is that the rearrangement of moleclues yields free carbon and heavier oil and expels some incondensible gases which are not desired because of little value and mainly because they add to the cost and danger of producing the valuable light distillates, particularly of producing gasoline, which requires more heat (about 750 degrees F.) and higher pressure (about 75 pounds) than in producing kerosene, the heavier distillate, whereby these unwelcome by-products are increased correspondingly.

Tar, coke and foreign matter, inevitably produced in some degree in every cracking operation, are more than undesirable; they are highly objectionable for two reasons; one, they accumulate on the heating surface of the still and thus retard the transfer of heat to the oil and, what is more serious, they cause overheating of the still walls with consequent danger of leaks, blow-outs and fire; and the other as the operation must from time to time be stopped and the still, thus idle, be cleaned out, they determine the length of the run or time the still may remain "on steam," that is, the time the still is in operation and earning money. To meet these problems the art progressed on lines and developed oil cracking devices and procedures differently stated by the opposing parties. These differences can, by some elaboration, be reconciled.

The defendant divides devices and procedure of the art before Trumble into two classes:

(a) Bulk-oil cracking in boiler stills;

(b) Stream-oil cracking in coil stills;

cleaning that its practice is within the former and Trumble's within the latter and, in view of the latter, lacks invention.

The plaintiff divides the devices and procedures of the art prior to Trumble into three classes:

(a) The directly fired shell or batch still;

(b) The once through still or system;

(c) The cycle still or system;

and claims that Trumble's method and apparatus are improvements upon the last; that, in view of what had gone before, they involve invention; and that the defendant's practice also comes within the last as improved by Trumble, and infringes.

The essential features of a directly fired, or batch, still are shown in the late Burton still (Patent No. 1049667 issued in 1913). It comprises a cylindrical shell or boiler, charged about one-half full with oil, the heating flames playing directly on the bottom sheets. The generated gases arise in the vapor space above the oil. The heavier vapors are condensed and return to the still while the lighter vapors pass to a cell condenser, whence, after condensation into liquid, they are conducted to a receiver and there recovered.

### Cost and Operative Loss.

It is important to note that in the operation of a batch still no residue is taken off during the run; that a still of this type can remain on stream only about 36 hours; that it must then be shut down, the tar, coke and foreign matter removed and the bottom scraped; that it takes about 24 hours to clean out the still, and that this involves substantial cost and operative loss. Antecedent variations of the set-up of the Burton batch still may be found in Letters Patent No. 419931 to Dewar and Redwood, 1890; No. 28246 to Atwood, 1860; and No. 52151 to Fales, 1866.

Next, the art thought that sedimentation of foreign matter upon the walls of a still with its consequent physical and financial disadvantages could be avoided, or at least lessened, if the oil were moved over the heating surface so rapidly that there would not be time for the matter to settle. So there developed the "once through" still, which takes its name from what happens in the still. Of this type patents No. 342564 and 342565 to Benton in 1886 are fair disclosures. Briefly described, this set-up comprises a furnace with a pipe positioned above the flames and extending throughout and beyond the furnace length. Oil is fed into the pipe at one end, through an opening in the pipe intermediate the two ends lighter vapors flow into a releaser and then are conveyed into a condenser and what is left of the oil is discharged from the other end of the pipe. It should be observed that oil passes through the heating medium once, hence the term "once through." It is therefore heated only once, and then in transit. There were several infirmities in this system; one, the loss of heat attendant upon the single passage of the oil through the pipe; the other, incomplete cracking in one passage with consequent

loss of the residue or cost of retreatment.

Systems of this type are described in one of the set-ups in the Russian patent No. 4782 to Schuchow and Gavrilow, 1891; patent No. 27842 to Stombs and Brace, 1860; showing a battery of directly fired shell batch stills with a continuous bulk-oil feed flow and discharge, circulation increased by patent No. 340878 to Henderson, 1886; No. 477153 to Pielsticker, 1892, as to one phase.

Whether or not the once through system was an advance step in the art, clearly it was a step away from the batch still, and it is to be credited with the kernel of a new and, later, very useful conception. As the feed and discharge of the once through system are continuous and vaporization likewise is continuous, it became one of two systems embodying the idea of continuous operation, the other being the cycle system.

The cycle type of still, like that of the once through type, derived its name from what happens inside. In the process of being cracked, oil moves in a cycle and the organization of the still is adapted to produce such a movement. The apparatus disclosed in connection with the method patent to Clark, No. 1119496, an improvement on Burton, issued in 1914, is a simple illustration. There, oil in an elevated reservoir located away from the furnace descends to a pump whence it is forced through a pipe to a coil within a furnace; ascending, it returns heated to the reservoir from which it started and continues on and on in this cycle while the resultant vapors pass from the top of the reservoir through a pipe to a condenser and finally to a drum for receiving the distillate. No residuum is taken off during the on-stream operation. The Clark-Burton set-up seems to be a commercial adaptation of the Clark invention. Here, too, no residuum is drawn off when on stream. While an improvement on the batch and once through systems, the cycle also must be shut down for cleaning certain of its parts, in this instance after a run of approximately 48 hours, an increase of 12 hours over the batch still run.

### Improving the Cycle System.

The Russian patent, supra, will be discussed in some detail under another issue. It will be enough to say now that its second set-up discloses a cycle movement of oil with the usual drawing off of vapors but no drawing off of the residuum during a run.

It was just here that Trumble appeared and proposed an improvement upon the cycle system by recirculating the heavy uncracked oil and doing it in a way to draw off in large measures the objectionable free carbon, tar and other foreign matter. What he did, and apparently all he did, was to take a typical cycle system with furnace, heating coils, condenser, pump, etc., and after suitably arranging them, disclose a practice and suggest a means continuously to draw off a small portion of the revolving residuum (loaded with the objectionable matter) in each of its cycles through the closed system and replenish the bulk with an equal amount of new oil stock and thereby maintain the bulk constant in volume. That was all. What was the result? An increase in a run from 48 hours to 17 days. For this he was awarded the patent in suit, claims 2 and 4, in issue, reading as follows:

"2. The process of converting a heavy petroleum oil into a light one which consists in circulating the heavy oil through a closed ring, continuously heating a portion of the ring, maintaining a pressure on the portion of the ring so heated, continuously taking off light vapors from the ring, continuously relieving the ring of a small amount of heavy oil, and continuously supplying fresh oil in sufficient quantities to maintain constant the volume of oil in the closed ring."

"4. An apparatus for converting heavy petroleum mixtures into light petroleum oils, comprising a heating means; a vapor releaser; means for conducting the heated mixture from the primary heating means to the vapor releaser; means for withdrawing light vapors from the vapor releaser; means for continuously withdrawing a portion of the mixture; means for forcing the residuum from the vapor releaser through the primary heating means; and means for injecting sufficient fresh heavy oil into said residuum to maintain the volume of oil in the apparatus approximately constant."

Trumble's invention resides not in the cycle movement of oil in a closed system or structure, for that was old, but in drawing objectionable foreign matter out of the system by continuously discharging or drawing off a portion of the degraded oil as it circulates with the foreign matter in suspension and continuously feeding back an equal amount of fresh oil whereby the bulk of oil in the system, thus continuously changing in quality, shall all the while be kept constant in quantity as it goes around and around in the closed system, which Trumble called "a closed ring." Trumble's

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closed ring as described in the patent comprises a feed pipe constantly changing fresh oil into a heated coil located in a furnace above the flames where the oil is heated to cracking temperature; a pipe leading from the coil and conveying the heated oil and vapors to a releaser from which the vapors are drawn off and through which the residue of heavy oil descends to another pipe having an outlet through which a portion of the heavy oil is drawn out of the system and the balance is returned to the heating coils, where it joins the main body of oil refreshed by new oil from the feed pipe and then proceeds on another cycle; circulation of the always changing bulk being effected at a determined speed by a pump. If this is not a mere variation of what already existed in the art, but is new in that it is something abruptly different from what existed before, then, utility being evident, the patent is not invalid for want of invention in view of the art. The plaintiff declares, again and again, that no process or apparatus in the prior art operating on the cycle system used or embodied these elements, and that Trumble was the first to realize that the period of a run of a cycle system, with its attendant advantages, could be materially lengthened by continuously withdrawing from the ring an appropriate amount of tar and coke bearing oil and providing a continuous supply of fresh charging stock. The defendant has not successfully met, nor have we found anything in the evidence, that contradicts these assertions. Therefore we find invention and, on the record before us, hold the claims of the patent which are in suit valid in view of the art—unless, as the defendant next urges, they are invalid because anticipated by the art.

### Anticipation of Claims.

The defendant says that the claims of the Trumble patent, as the District Court interpreted them to include its practice, are directly anticipated by United States patents No. 340878 granted to Henderson in 1886; No. 1170884 granted to Edwards in 1916, after the date of Trumble's application on an application filed May 8, 1915, which was before Trumble's application on July 19 of the same year; No. 1239424 granted to Smith September 4, 1917, on an application filed April 28, 1915; No. 836732 granted to Barbet in 1906, and a corresponding French patent granted to him in 1902; and finally the Russian patent (No. 175) granted to Schuchow and Gavrilow in 1891.

The Barbet patents disclose a directly fired shell batch still having a continuous feed of charging stock and a continuous drawoff of residuum actuated by a "stirrer" mounted in the shells. They do not disclose oil of changing quality circulated through a closed ring or anything that told the art precisely or substantially what Trumble told it. These references do not meet the evidentiary rule of anticipation.

The Edwards and Smith patents are held not to anticipate on a finding that, if covering the same subject matter, their earliest dates of invention were later than Trumble's.

Henderson added to the Stombs and Brace continuously operated battery of directly fired batch stills a means "to promote circulation" in the form of revolving blades, dishes, or buckets hinged to the side walls of the stills. Although the patent deals with "circulation" we fail to find a true cycle system disclosed. While the dishes or buckets may reduce sedimentation and aid circulation in the sense of promoting the oil movement, their operation more nearly resembles agitation than circulation.

The defendant places its main reliance for proof of anticipation on the Russian patent to Schuchow and Gavrilow. Primarily, and according to the patent title and disclosure, the system is a "continuous" one; but, as noted before, a continuous system may be either a cycle or a once through system. The patent discloses both. Each acts independently of the other and for different purposes according to the will of the operator.

However read, the patent discloses alternate systems. The oil comes in from a pump at B, passes through the pipe C, thence up through helical heating coils into a cylinder A, from which, after the light vapors have been drawn off through the pipe E, it descends as reflux condensate through the pipe D at whose bottom it may be drawn off at the valve P. That, falling a little short of a single cycle or revolution, is a once through system. Or valve P may be closed and the oil shot back through valve R to the pipe B whence, continuing through pipe C, the oil may be re-circulated through the system indefinitely. That is a cycle system. As to these two systems the applicable words of the patent are: "In accordance with the speed of circulation of the oil in the pipes, and depending on the purpose of the distillation, the liquid oil which has settled in the cylinder A is discharged by the pipe D and through the valve P, without be-

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ing subjected to further distillation, or by valve Q enters the pump once more, where it is mixed with a new supply of oil running towards the pump, and resumes circulation through the coiled tubes." If, in the second set-up, the "new supply of oil running towards the pump" be a "continuous feed," we find no reference to a corresponding continuous through the former a portion of the degraded oil will be drawn off and through the latter the remainder (refreshed by new stock) will be carried through the system and recirculated. Looking at the diagram submitted as an illustration, this would seem to be possible, but we find no such conception or use disclosed by the patentees. The defendant emphasizes these words of the patent: "In this manner, by means of the valves P and Q, a greater or less degree of a repeated process of circulation is obtained, as also of the distillation or cracking of the oil." The "manner" there referred to is the alternative manner of operation described in the sentence last quoted and immediately preceding this sentence. We think the two sentences, being placed together, should be read together and when so read they do not suggest a third system.

This third system proposed by the defendant is really a composite of the two systems described by the patent. It is only by combining these alternative systems, with their alternating valves P and Q, that the defendant produces Trumble's continued bleed and feed.

### Disclosures of Patent.

As there is no evidence of the use of the invention of the Russian patent in the practical art, we are limited for information to the disclosures of the patent itself. Does the patent disclose this third practice? We find nothing to that effect. Does it teach that both valves P and Q should be opened simultaneously, one to draw off some of the oil loaded with impurities and the other to replenish the bulk, and together permit a continuous recirculation of old and new? We cannot find that it does. Nor does the patent state the practicability or desirability of the third practice. Apparently it never occurred to the patentees. The defendant's conception of the third method is only an inference from the specification. Inferences as distinguished from disclosures, especially when drawn in the light of after events, cannot be accepted as a basis of anticipation.

A patent relied upon as an anticipation must itself speak. Its specification must give in substance the same knowledge and the same directions as the specification of the patent in suit. Otto vs. Linford, 46 L. T., N. S. 35, 44. It is not enough to prove that a method or apparatus described in an earlier specification can be made to produce this or that result. Flour Oxydizing Co. vs. Carr & Co., 35 R. P. C. 457. A singularly sensible test of the rule of anticipation is given in British Thomson-Houston Co. vs. Metropolitan Vickers Electrical Co., 45 R. P. C. 22, by asking the question: "Would a man who was grappling with the problem solved by he patent attacked, and having no knowledge of that patent, if he had had the alleged anticipation in his hand, have said: "That gives me what I wish.'" The Pope Alliance Corporation vs. The Spanish River Pulp & Paper Mills, Ltd. (Privy Council Appeals No. 33 of 1928). On the evidence in this case, read in the light of the rules of law applicable to anticipation, we do not find the invention of the patent in suit anticipated.

It is difficult to state the issue of infringement without repeating the evidence and reproducing the diagrams of the contesting apparatus. Omitting details, the defendant's set-up comprises the usual elements of furnace, heating means, dephlegmator, connecting pipes and pump. In place of either coiled tubes or shell still as a heating means the defendant uses a modern high pressure Babcock & Wilcox boiler with its familiar bank of inclined tubes in which is heated and cracked a very large volume of oil. The Trumble patent discloses a long coiled pipe as a heating means in which the volume of oil is not large. Since the form and size of the heating element of the invention are not claimed by the patent as novel and as they have nothing to do with the essence of the invention, the defendant's substitution of one kind of heater for that preferably or incidentally disclosed by the patent falls out of the issue of infringement.

### System of Feeding Oil.

Oil is fed to the defendant's system through a pipe leading into the dephlegmator through which, gathering heat in transit, it descends to the boiler, or rather to a drum on one side of the boiler, whence by force of a propeller pump it ascends through the battery of

inclined tubes, subjected to flames from the furnace, to another drum on the other side, then ascends to the open space in the upper part of the boiler and thereafter revolves around and around within the boiler at a very rapid speed. The vapors arising from the surface of the bulk of oil in the upper part of the boiler, away from the flames, ascend through a pipe to the dephlegmator from which they are drawn off and the unsuccessfully cracked residuum is returned, as in other cycle systems, to the boiler and there, joining the rapidly moving bulk of oil, it is again subjected to the oil cracking temperature. Except as to the type of heater, the defendant's set-up thus bleed. There is of course a continuous diminution of the bulk by evaporation.

It would seem that the patent thus discloses only two methods of operation, alternate and optional with the operator. But the defendant says that the apparatus is capable of a third method, namely; the simultaneous opening of both valves P and Q a little bit whereby far described discloses the main characteristics of the Burton batch still and Clark's cycle improvement upon it. If the defendant had stopped there it would have not infringed Trumble. But to the operative essentials of Burton and Clark, or, speaking generally, to the essentials found in prior systems, the defendant made at least one very important addition. This was an outlet from the second drum through which it continuously drew of a quantity of degraded oil equal to fresh oil which it injected continuously through the inlet in another part of the system. This addition to the defendant's otherwise unoffending set-up manifestly constituted a drawoff of bleed closely akin to that of Trumble. Even so, the defendant, while admitting a continuous circulation of oil coupled with continuous feed of fresh oil and continuous drawoff of heavy residuum, centers its position on the cycle within the boiler and maintains that its system retains the characteristics of bulk-oil process in boiler stills and is not a true cycle within the sense of Trumble's closed ring because the circulation is through the battery of heated tubes and the vapor releaser part of the boiler where alone, it says, heating and cracking occur, and because its cycle is only a cycle of movement while in Trumble's system the oil is subjected to a cycle of varied process steps. We have not been able to follow this line of reasoning for, as it seems to us, there are in the defendant's set-up really two cycles, one within the other; each, if considered apart from the other, having a continuous drawoff and feed in a closed system. One cycle is within the boiler or heater itself, on which the defendant lays stress as a bulk-oil process in a boiler still, for it is there the bulk of the oil is circulated and cracked and there it receives all the heat it ever receives; but over and beyond the cycle movement of oil in bulk within the boiler there is another cycle movement of oil and vapors under different conditions of heat and undergoing different treatment. This cycle is the movement from the boiler to the dephlegmator, and, after the vapors have there been withdrawn, the movement of the residuum back to and through the boiler for retreatment.

**Finding of Infringement.**

As the defendant's system is not restricted to the boiler but extends to and embraces the other elements, it appears to be a true cycle system differing from other such systems in the character of boiler or heater employed and distinguished from others mainly by the larger bulk of charging stock, but resembling Trumble in the addition of a continuous feed and bleed in a measure that maintains the charge in constant volume as it revolves in a closed ring, of which the boiler is only a part. True, the defendant feeds and withdraws a larger quantity of oil than Trumble suggests in his specification, but as the claims contain no limitation upon the quantity, that will not avoid infringement. We are constrained to find that by its practice and set-up the defendant has infringed process claim 2 and apparatus claim 4 of the petent.

The decree of the District Court is affirmed.

February, 1929.

# Apparatus to Obtain Pulverized Coal

EX PARTE MURRAY. APPEAL NO. 354, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1702055 was issued February 12, 1929, to Thomas E. Murray for apparatus and method for obtaining pulverized coal, on application No. 644838, filed June 12, 1923.

Claim 1, directed to an apparatus for obtaining pulverized coal and including a casting containing upper and lower crushing mechanisms spaced from each other and so constructed as to crush coarse and finer lumps in separate stages, was found to be anticipated by a patent disclosing a process and apparatus for treating coffee, taken in connection with another reference illustrating a conveyor, the Board decided, constituted an anticipation of claim 2.

A device in which it was required that air should be admitted below the second crushing mechanism and withdrawn between the two crushing mechanisms to permit recovery of the fine products of both crushing mechanisms, a feature not present in the prior art, was considered novel. The rejection of claim 3 was accordingly reversed.

D. Anthony Usina for applicant.

The full text of the opinion of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Henry and Ide) follows:

This is an appeal from a final rejection of claims 1, 2 and 3. Claims 1 and 3 are reproduced for illustrative purposes:

"1. An apparatus for obtaining pulverized coal comprising in combination a pair of crushing mechanisms arranged to crush comparatively coarse and finer lumps in separate stages, a casing enclosing said crushing mechanisms having an outlet port located between said crushing mechanisms and means for withdrawing a current of air through said port to recover part of the finer pulverized fuel before it passes to the second stage crushing mechanism.

"3. An apparatus for obtaining pulverized coal comprising in combination a pair of crushing mechanisms and means for admitting air below the second crushing mechanism and withdrawing it between the two crushing mechanisms to recover the fine product from the second crushing mechanism and also from the first."

The references relied upon are: Huntington, 302256, July 22, 1884; Baker, 736346, August 18, 1903.

The invention claimed is an apparatus for obtaining pulverized coal and includes a casing containing upper and lower crushing mechanisms spaced from each other and so constructed as to crush coarse and finer lumps in separate stages. The casing has an outlet port located between the crushing mechanisms and means is provided for withdrawing air through the port carrying with it the finer pulverized coal before it passes through the second crushing mechanism. A conveyor transfers the coarse material from the space below the second crushing mechanism back to the first crushing mechanism.

An air admission port is located below the second crushing mechanism so that an air current is created which will carry the fine pulverized coal produced by the second crushing mechanism through the outlet port heretofore mentioned.

The Huntington patent is for an ore pulverizer and separator and discloses three sets of crushing rolls located in the upper portion of the casing with an outlet port and withdrawing means located below the lower set of rolls. A conveyor is provided for bringing back to the second set of rolls the material needing further crushing.

The Baker patent discloses a process and apparatus for treating coffee to crush it and remove dust, chaff and other impurities. The disclosed apparatus of Baker has spaced pairs of upper and lower rolls with outlets in the casing located between the pairs of rolls and below the lower pair through which the dust, chaff and other impurities may be withdrawn.

Claim 1 distinguishes from the Huntington patent by the inclusion of an outlet port located between the crushing mechanisms with air withdrawing means acting through said port. We are not satisfied that it would be an obvious thing to change the location of the air withdrawing means of the Huntington patent even in view of the teachings of the Baker patent. However, claim 1 is met by the Baker patent alone save for the reference to pulverized coal. We think this is not a patentable distinction.

Claim 2 adds to claim 1 a conveyor for transferring the material from the casing to the first stage crushing mechanism. It it were desired to subject

the material crushed by the second pair of rolls of the Baker patent to an additional crushing action, invention would not be required in providing the Baker apparatus with a conveyor in view of the teachings of the Hunington patent.

**Admission of Air.**

Claim 3 requires that air shall be admitted below the second crushing mechanism and withdrawn between the two crushing mechanisms to recover the fine products of both crushing mechanisms. In the Baker construction while air is admitted below the lower crushing mechanism it is also withdrawn below that crushing mechanism. A separate withdrawing means is provided for the upper crushing mechanism. We think claim 3 may be allowed.

The brief on appeal contains an additional claim numbered 4 for a method of obtaining pulverized coal. We are asked to approve the admission of this claim.

We are not certain that the search on the finally rejected claims would cover the new claim. Moreover, as pointed out in Ex parte Moore, 1923 C. D. 13; 307 O. G. 4, it is desirable that all claims presented on appeal should be passed upon by the primary examiner in the first instance in order that the Board of Appeals may have the benefit of the judgment of the office expert on the particular invention involved in the appeal. Accordingly, we decline to approve the admission of the proposed additional claim.

The decision of the Examiner is affirmed as to claims 1 and 2 and reversed as to claim 3.

## MARCH 9

# *A Cash Register With a Plurality of Totalizers and a Single Control*

EX PARTE BRAND. APPEAL NO. 518, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1702861 was issued February 19, 1929, to Samuel Brand for cash registers, on application No. 630956, filed April 9, 1923.

Appellant's claims 1, 4, 16, 22 and 23, for a cash register having a plurality of totalizers provided with a single controlling toggle member, were held patentable over the basic prior patents in which a plurality of controlling toggles were used, on the ground that there was no teaching reference pointing out how the structures of the basic patents could be modified to produce a structure responding to the appealed claims.

Carl Beust and Ralph S. Warfield for the applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Henry and Landers) follows:

**Simplified Construction.**

This is an appeal from a final rejection of claims 1, 4, 16, 22 and 23. Claim 1 is reproduced for illustrative purposes.

"1. In a cash register, the combination of a plurality of lines of totalizers, a plurality of differentially movable members cooperating with all of said lines for resetting said totalizers to zero, and a single member one for each denominational order of the totalizers having integral portions adjacent said totalizer lines for controlling the movement of said differentially movable member on resetting operations."

The references relied on in the final rejection are: Fuller, 1242170, Oct. 9, 1917; Fuller, 1394256, Oct. 18, 1921.

In the statement on appeal, the patent to Chryst, No. 1230864, June 26, 1917, is added on the theory that it illustrates more clearly certain mechanism disclosed in the Fuller patent, No. 1242170. The actual disclosures of the Chryst patent and the patent to Fuller noted so far as applicable to the appealed claims, are the same.

The invention claimed in the claims on appeal relates to a mechanism resetting the totalizer of a cash register of the type illustrated in the patents cited in the statement on appeal. These patents are acknowledged in the preamble to the specification as is a patent to Shipley No. 1619796, March 1, 1927. This Shipley patent is not relied on by the examiner in the rejection of the appealed claims but is discussed in the brief on appeal. Broadly stated it is a purpose of the invention claimed here to simplify the construction of the Fuller and Shipley patents.

Appellant discloses a plurality of lines

of totalizers, specifically three, equally spaced around what may be termed a central axis. In connection with these lines of totalizers and as a part of the resetting mechanism thereof a single member 90 one for each order of the totalizers having arms 91, 92 is provided one of the arms being connected to a radially movable plate, one plate for each denominational order of the totalizers. Certain differentially movable members are associated with the totalizers and the movement of these members is stopped by the radially movable plates during a resettting operation.

The connection between an arm of the member 90 and the radially movable plate includes a normally inoperative toggle. According to the brief on appeal the distinctive feature of the claims under consideration is: "a single, universal zero-resetting control member for each denominational order, which single control member is common to the like denominational wheels of each line of totalzers, notwithstanding the multiplicity of totalizer lines."

This single control member is included in some form or other in each of the appealed claims.

None of the appealed claims is anticipated by any of the references. The rejection, so far as the prior art is concerned, must be based on lack of invention over the prior art.

It will not be necessary to discuss the Fuller patent No. 1242170 since admittedly it is no better as a reference than the Chryst patent. The latter patent shows two lines of totalizers and the Fuller patent No. 1394256 three lines. In this respect it is broadly similar to appellant's construction. The examiner states, see page 5 of statement on appeal:

"The common thought in all three patents and this application is a latch control and a plurality of totalizer operated means spaced around the 360 degree cycle to operate the latch control. By changing the intrinsic character of the latch control means, applicant has not in any way altered the conception of cyclic spacing for totalizer control."

But it seems to us that the matter just quoted does not fairly state the inventive idea covered by the appealed claims. As we interpret them they have nothing to do particularly with a 360-degree cycle but call for a simplified construction of latch control mechanism not disclosed by any of the references. This ordinarily constitutes a patentable invention. The examiner in the statement on appeal goes on to say:

"Applicant urges that because the shifting of the toggle set to the latch breaking position and the latch breaking element to the totalizer position, he has only to make one toggle set instead of a plurality as in the patents. That is true. The examiner freely admits it. But the shifting in position does not require that a plurality of totalizer lines be used any more than in the patents. In the patents the same coordination between the latch breaking and the totalizer would take place if only one totalizer were used."

We fail to follow the reasoning of the examiner in the matter just quoted. Each of the appealed claims calls for a plurality of totalizers or a plurality of lines of totalizers hence the statement as to what might take place if a single totalizer were employed seems to have no bearing on the patentability of the claims on appeal. The examiner admits that appellant's construction secures a useful result by the use of a single toggle whereas in the prior art a plurality of toggles are necessary. Ordinarily, to effect a desired result by a single element, whereas in the prior art a plurality of elements was necessary, constitutes invention.

The difficulty which we have in reaching a conclusion that the examiner should be affirmed in the rejection of the claims, so far as the prior art is concerned, resides primarily in the fact that so far as we can discover there is no teaching reference which points out how the structures of the basic patents could be modified to produce a structure responding to the appealed claims.

It is true that the Fuller patent No. 1394256 discloses three totalizer lines spaced equidistantly through a 360-degree cycle, in that respect being similar to the spacing of totalizer lines disclosed in the application. But Fuller in going from the two totalizer line construction of his earlier patent or the Chryst construction did not employ the single controlling member 90 of appellant's construction but retained the separate trains of operating connections to the three lines of totalizers. The examiner states at the bottom of page 5 and top of page 6:

"The prior patents which are the property of the assignee of the instant case teach that if another totalizer line is desired, all that is needed is another element 91 at a circumferential distance of 120 degrees."

But 91 is a part of appellant's construction and we are not informed what

element of prior art devices would be modified by the addition of element 91. As previously noted Fuller patent No. 1394256 has three totalizer lines just as appellant has and if it were an obvious thing to modify the early Fuller construction or that of Chryst, such modification should have appeared in the Fuller patent No. 1394256. Instead of doing this Fuller in the later patent retained the same multiplied trains of connections as in the earlier patents. The same is true of the still later patent to Shipley discussed in appellant's brief. Our conclusion with respect to the rejection of the appealed claims for lack of invention over the prior art is that the rejection should not be sustained.

### Citing an Extreme Case.

Claims 1, 16 and 23 have been further rejected under the doctrine announced in Electric Accumulator Co. 2. Julien Electric Co. 38 F 117. That case was a suit for infringement of a patent having to do with secondary or storage battery cells provided with two electrodes. Each electrode was of special construction and that construction was particularly described in claim 1 of the patent. Claim 4 criticized in the decision called for a series of cells having a pair of electrodes embodying the special construction. The court held that the claim if construed to cover the defendant's structure was void for want of novelty but was capable of a limited interpretation which would render it valid.

Broadly stated it seems to be the view of the examiner that the cited decision is authority for a holding that claims 1, 16 and 23 call merely for a duplication of elements adequately covered in other claims. Reference is made to claims 18, 19 and 20. Admittedly claims 1, 16 and 23 are not the same as claims 18, 19 and 20. They do not merely duplicate elements claimed in claims 18, 19 and 20 and we think they are allowable over the other claims mentioned. The cited decision is rather an extreme case and any rejection based thereon would be a technical one not warranted by the character of invention and claims involved here.

The decision of the examiner is reversed.

# *Excavating Device Operating as Hoe*

KEYSTONE DRILLER COMPANY V. THE BYERS MACHINE COMPANY, ET AL. EQUITY NO. 2084, DISTRICT COURT FOR THE NORTHERN DISTRICT OF OHIO.

CLAIM 4 of Clutter Patent 1317431, claims 5, 6, 7 and 9 of Wagner Patent 1476121 and all claims of Downie Patents 1511114 and 1543250 were held valid and infringed.

Plaintiff's patented device, the court finds, relates to an excavator that is distinguished from the ordinary steam shovel in that it digs inwardly toward the operating machine, as a pick or hoe, rather than away from the machine, as a shovel, and is of advantage in that the ditch or trench is cut the width of the bucket only and the machine always remains on solid ground as the excavation progresses, rather than astride the wall of the ditch. The court further states plaintiff's device accomplished old results in a new and useful manner as well as new and better results by reason of a novel combination of some old elements.

### Full Text of Opinion.

The full text of the opinion of the court, delivered by Judge Jones, follows:

This cause was tried and submitted to the Hon. D. C. Westenhaver in September, 1927. Due to his sickness and subsequent death, it was not decided. By written stipulation of counsel for the parties it was agreed that the matter should be submitted without retrial to one of the judges of this court; and upon oral argument had January 9, 1929, the matter was submitted on the record and briefs.

This is a patent-infringement suit involving pull-stroke ditchers or excavating scoops and machines. They are distinguished from the ordinary steam shovel in that they dig inwardly, toward the operating machine, as a pick or hoe, rather than away from the machine, as a shovel. The pull-stroke or inwardly digging shovel has an outstanding advantage over the ordinary steam shovel, in that the ditch or trench is cut the width of the bucket only, and the machine always remains on solid ground as the excavation progresses, rather than astride or over the wall of the ditch or trench. Another advantage urged for this type of machine is its interchangeable character—that is, construction for other uses may be applied to the same operating machinery. The patents claimed to be infringed are, generally

speaking, combinations of old elements producing improvements and advantages over prior conceptions and embodying many of the functional elements of earlier invention. Plaintiffs contend that Claim 4 of Clutter patent No. 1317431; Claims 5, 6, 7, and 9 of Wagner, No. 1476121, and all claims of the two Downie patents, Nos. 1511114 and 1543250, are infringed by the defendants' constructions. It is the plaintiff's claim that the infringing use of these inventions is disclosed by plaintiff's Exhibits 16, 17, and 18, which are to be found in the defendants' advertising catalogues and referred to as "Byers' Bear Cat."

**Advantages are Set Forth.**

One of the chief advantages claimed for the plaintiff's machine is its ability to break through, with a hammer-like blow, rock, shale, sandstone, and the like, found near the ground surface, thus doing away with considerable blasting. Another advantage being its control by two lines, or two control members; and, further, that it has the advantage of exact spotting in a wide area or range for the discharge of the spoil or contents of the scoop, having the falling bottom which may be closed by momentum produced by manipulation of the scoop, thus accomplishing, perhaps, old results in a new and useful manner, as well as obtaining new and better results by reason of a novel combination of some old elements. Such a result has been repeatedly held to require inventive faculty and produce invention.

Without going into detail or discussing technical means, I think the plaintiff's patents have initiated and accomplished, in a practical, commercial, and economical way, an advance in the field of mechanical digging, and that through its efforts and development have produced a better and, in substantial respects, a new result out of old elements in the art of trenching and ditching.

**Plaintiff Developed Prior Art.**

It is not thought necessary here to review the extensive reference to the prior art, since from an examination thereof nothing suggests or anticipates the novel operative control and other commercial advantages found in the claims in suit. It seems to me that the plaintiff, through the successive steps of Clutter, Wagner, and Downie, has developed the art over the earlier disclosures. I am satisfied, from a reading of the transcript of the testimony and the evidence in the case, that the defendants' construction was the result of the study of plaintiff's conceptions, Clutter, Wagner, and Downie, and the copying of the plaintiff's construction and mechanism.

The parts of the defendant's machine are combined and function in precisely the same way as the plaintiff's commercal machine. The defendant has taken substantally the plaintiff's patents. I find no substantial variation in the construction of the defendant's machine which is not within the scope of the claims relied upon or the result of mechanical suggestion and change. One of the most important accomplishments claimed by the plaintiff for its commercial machine, that of the two-member control, appears to have been stressed in the "Byers' Bear Cat" catalog by the legend appearing in plaintiff's Exhibit 17, "The All-Purpose One-Man Crane," and as appears in plaintiff's Exhibit 18, "The All-Purpose One-Man Crane-Shovel."

**Held to Embody Same Idea.**

Defendants' machine, as appear in plaintiff's Exhibits 16 and 17 (defendants' catologs), though functionally differing in respect of the link or pivotal means, would seem to substantially embody the construction found in Claim 4 of Clutter, 1317431. It is the defendants' third construction, as illustrated by plaintiffs' Exhibit 18 (defendants' catolog), which it is contended infringes Wagner, 1476121. Any difference in positioning or attaching the hauling line to the ditcher stick, rather than to the open end of the scoop, is not, as I see it, a distinction sufficient to avoid infringement; no more than the difference with respect to the scoop attachment or mounting being centrally pivoted in the plaintiff's machine and flexibly mounted in the defendants.' They appear to me to embody substantially the same idea and to serve the same purpose. While the liberal treatment accorded the many claims of the Downie patents might not be extended to the various elements as units, yet the combination of admittedly old elements perform additional functions and accomplish additional results. Any weakness in that respect, it seems to me, is overcome by their novel and useful combination and commercial success.

Some questions as to notice was also raised, but I find no ommission in that respect to warrant a finding of failure or neglect upon which to base a denial of relief to the plaintiff.

The patents are valid and infringed as to the claims relied upon. A decree may be entered for the plaintiff, with injunction and accounting.

January 23, 1929.

## MARCH 11

# *Claim for Golfing Tee Providing Elimination of Ball's 'Back-spin'*

THE NIEBLO MANUFACTURING CO., INC., V. PRESTON ET AL. EQUITY NO. 103, DISTRICT COURT FOR THE DISTRICT OF VERMONT.

PATENT 1493687 for a golfing tee was held not to be infringed. The question of infringement turning on the interpretation of the single claim in the case, as ascertained from the patent file and drawings, the Court found that, since the claim had been limited during prosecution so as to cover a golf tee having a cavity, every portion of the surface of which was adapted to contact with the ball, and provided with a marginal ball retaining and supporting rim, features not present in defendants' device, that the charge of infringement could not be sustained.

The Court also stated that where an inventor is entitled to a broader claim than that to which he limits himself the law presumes abandonment of the residue. In this instance, however, the conclusion was reached that, in view of the prior art, if a construction broad enough to read on defendants' device be placed on the claim it must be held void.

Ambrose L. O'Shea, of New York City, for plaintiff; Henry M. Weidner, of Boston, Mass., for defendants.

The full text of the opinion of the Court, delivered by Judge Thomas, follows:

This suit involves the alleged infringement of Lowell patent No. 1493687 for a golfing tee, granted to the plaintiff on May 13, 1924, on an application filed May 5, 1922.

The defenses are noninfringement and invalidity by reason of anticipation by, and lack of invention over prior patents and the prior art.

The single claim of the patent in suit reads as follows:

"A golfing tee, formed of a single piece of material comprising a cone-shaped shank having a pointed end so as to be readily pressed into the ground, and a disc-shaped member connected with and carried by said shank, said member being dished or concaved in its upper surface to conform to the surface of the ball and surrounded by a marginal ball-retaining and supporting rim, said shank being centrally disposed with relation to the said dished ball-supporting member."

In the specification the inventor says that this invention "has for its principal object to provide a novel and simply constructed" golfing tee which is:

"Formed of a single piece of material comprising a cone-shaped shank having a pointed end so as to be readily forced into the ground, and having a disc-shaped member connected with and carried by said shank, said member being dished or concaved in its upper surface to conform to the surface of the golf-ball and being surrounded by a marginal ball-retaining and supporting rim, and said shank being centrally disposed with relation to the said ball-supporting member."

It is thus apparent that the claim in suit follows the exact words of the specification as to the main object of the invention. Other objects of the invention, as appear from the specifications, are to provide a neat and cheap teeing device which can be carried in the pockets of the players and which will cost so little to manufacture that the loss of such a device to the player will be practically nil and if struck and broken by contact with the club may be readily replaced by another, or if not struck may even be left in the green and another device used upon the next tee. This device is generally made of wood, but it may be made of material which will disintegrate and act as a fertilizer if left on the green.

### A Hazard for Caddies.

The patentee asserts that prior to his invention golfing tees were made either of a plurality of component parts, or, if consisting of a single element only, they were made of metal. The last mentioned construction is objectionable because when left on the golf course it is liable to cut the feet of bare-footed caddies or penetrate the rubber of rubber-soled shoes as well as nick and dull the blades of lawn mowers used in cutting the grass. It is further asserted that the tees used prior to the patentee's invention were either ineffective or too expensive.

Plaintiff lays great stress on the ex-

tensive sales and commercial success of its golfing tees manufactured under the patent in suit. There is no question in my mind but that at least one form of the devices manufactured and sold by the defendants, as shown by plaintiff's Exhibit 1, is a Chinese copy of the device manufactured by the plaintiff.

Defendants contend that the golfing tees manufactured by them do not come within the terms of the claim of the patent in suit because the plaintiff's patent must be limited to the exact construction shown in the patent drawings, not only in view of the prior art, but by reason of the self-imposed limitations put therein by the patentee during the prosecution in the Patent Office of the application which eventuated in the patent as issued.

The patented golfing tee comprises a main body member or shank, which may be either cone-shaped, as shown in the drawings, or it may taper at one end so as to provide a driving point in order to readily force or press the shank into the ground. Connected with the opposite end portion of the shank is a disc-shaped portion which is dished out or concaved in its upper surface conforming to the curved surface of the golf ball and which is surrounded by a marginal rim, all for the mounting and properly placing of the golf ball upon said disc-shaped portion after the device has been pressed into the ground, as is clearly shown from an inspection of the patent drawings. This golfing tee is usually turned out of wood. If made of celluloid, rubber, or other pliable material, it may be pressed into the desired shape by means of suitable molds.

The whole controversy turns upon the interpretation or construction to be given the following phrase of the claim of the patent, to wit:

"said member (disc-shaped member) being dished or concaved in its upper surface to conform to the surface of the ball and surrounded by a marginal ball-retaining and supporting rim."

The plaintiff maintains that, in the light of the specification, "conforming to the surface of the ball" means that the upper surface of the disc-shaped member conforms to the surface of the ball to the extent that may be necessary in order to permit the ball to rest in the concavity, or, to put it in another way, the conformity need only be a general conformity, and that "surrounded by a marginal ball-retaining and supporting rim" merely refers to the periphery of the concaved surface of the head and does not call for any substantial breadth.

On the other hand, the defendants contend that the patentee means by the words "to conform to the surface of the golf ball" that the concavity is so formed that every portion of its surface can contact with the golf ball, or a concavity having the same radius of curvature as the golf ball; and that "surrounded by a marginal ball-retaining and supporting rim" means that the disc member is surrounded by a flange or thickened portion in the nature of something more than a mere line or narrow edge on which the ball may rest.

When any doubt exists as to the meaning of a patent claim, or if it is susceptible of two interpretations, it is both right and proper that reference should be made to the drawings and specification, not for the purpose of changing or altering the claim, but to ascertain the true and proper interpretation to be given it. This is a universal rule.

Its application to the case at bar, however, does not shed any light on the question presented because the language of the specification is no clearer than the claim itself unless it is attempted to restrict the claim to the precise construction disclosed in the drawings. Of course a claim in a patent is a statutory requirement for the purpose of compelling a patentee to describe precisely what his invention is and it is unjust to the public, as well as an evasion of the law, to construe a claim in a manner different from the import of its terms.

When doubt arises as to the meaning of such terms the Court should place itself in the place of the patentee and the Patent Office Examiner at the time the claim was made and should read its terms in the light of the facts and circumstances which then surrounded them. These facts may, obviously, be ascertained from the file wrapper and contents of the application for the patent.

Having recourse to this, it is manifest that both the patentee and the Patent Office Examiner intended to limit the patented device to a golf tee with a concavity, every portion of the surface of which is adapted to contact with the golf ball, because the file wrapper shows that, as amended by the amendment filed on or about July 18, 1923, the application contained four

claims which stood rejected on United States Patent No. 638920 to Grant, and British patent to Matthew No. 14292 of 1897, both of which show the ball supported on a circular edge. Asking for reconsideration of this rejection, the applicant, by amendment dated July 16, 1923, argued with reference to the Grant and Matthew patents as follows:

"Referring to the patent to Grant, it will be noted that the golf tee shown therein is not provided with a dished disc-shaped member, for the proper support of the golf ball thereon. The device in practice being very small the tubular surface portion b' of the Grant patent is really too small to properly support a golf ball, and thereby renders this device impracticable.

"With reference to the device shown in the Matthews patent, the same statement is made, since in order to properly support the ball the device provided with pins A and the cup B must of necessity be made quite large."

### Full Contact With the Ball.

By office letter dated February 16, 1924, the Examiner replied to the argument and repeated the rejection, whereupon by amendment dated March 7, 1924, the applicant cancelled the rejected claims and substituted the single claim of the patent. At the same time the applicant amended the specification to read as follows:

"With a golfing tee of the charcter hereinbefore described it will be evident that every part of the supporting cup or dished ball-receiving member is in contact with the surface of the golf ball, and consequently the golfing tee is made in such a manner as to support the golf ball with a small minimum contact with the same, and it is due to this small contact with the surface of the golf ball that there is no resistance to the flight of the ball when the same is struck with the golf club; and, furthermore, when certain kinds of strokes are made there can be no objectionable 'back-spin' of the ball.

"Furthermore, the hereinbefore described golfing tee provides the supporting medium of a very small size, thus making it impossible when using the tee, to have the face of the club come in contact with the tee after the ball surface has been struck and the ball sent upon its way."

This is the description as set forth in the specification of the patent as issued and by it the patentee, it seems clear, limited himself to a dished or concaved supporting surface which conforms to the surface of the ball—meaning thereby a surface which contacts with the ball not on a physical line, but through an extended area. Now, whether this self-imposed limitation by the patentee was necessary, in view of the references cited by the Patent Office, we need not here argue. At this late day it is quite immaterial and we cannot consider that question here in our determination of the scope to be given the claim, because even if it is possible that the inventor was entitled to a broader claim than that to which he limited himself, the law presumes that he abandoned the residue to the public if he described and claimed only part of his invention. Deering v. Winona Harvester Works, 155 U. S. 286; McClain v. Ortmayer, 141 U. S. 419.

The construction of patents must be in conformity with the self-imposed limitations which are contained in the claims. Groth et al. v. International Postal Supply Co., 61 Fed. 284. If the patentee is now of the opinion that his patent is defective and needs correction he has recourse to the provisions of the statutes which provide for a correction of defective patents by means of reissue. But a court of equity has no power in a suit for infringement to enlarge the scope of the claim of a patent even if by mistake it was issued in terms too narrow to cover the invention, however manifest the fact and extent of the mistake is shown to have been. United States Repair & Guaranty Co. v. Assyrian Asphalt Co., 100 Fed. 965.

As to the phrase, "surrounded by a marginal ball-retaining and supporting rim," it is unnecessary to refer to the file wrapper because its meaning can be clearly ascertained from the matter set forth within the four corners of the patent in suit. There is no doubt in my mind that this term limits the claim to a concaved supporting surface on the disc-shaped member, which surface is surrounded by a rim of substantial width to aid in retaining and supporting the golf ball. If plaintiff's contention is tenable, the claim would include twice the very same element because every concavity has a rim and consequently it would be unnecessary to specify this rim as an element of the claim. This and the fact that the "rim" is stated in the claim to be a ball-retaining and supporting element clearly indicates that it does not refer merely to the upper edge of the concavity, but to a rim or flange of substantial width.

When the claim is thus construed it must be held that the proofs do not exhibit anything sufficient to repel the ordinary presumption attending the grant of a patent. Some of the alleged anticipating patents were considered by the Patent Office, and the others are not more, but in fact less, pertinent.

If the claim of the patent in suit should receive the broad construction which plaintiff seeks to obtain, I should have no hesitation in holding it void for lack of novelty in view of the patents to Grant and Matthew, supra, and the British patent to Kirkwood, No. 253 of 1896, it being obvious that it would not amount to invention to make the composite golf tee of either Grant or Matthew of a single piece, in view of the disclosure in the Kirkwood patent.

The patent in suit is in no sense a pioneer patent, but is for an improvement. There is no room for the doctrine of equivalents in such a case, but the patent is limited to the precise construction and combination shown and claimed in his patent. He is limited in this instance to a disc-shaped member, dished or concaved in its upper surface to conform to the surface of the ball and surrounded by a marginal ball-retaining and supporting rim as construed herein to avoid anticipation.

The evidence adduced clearly proves that the concavities in the two forms of defendant's device do not conform to the surface of the ball nor are they surrounded by a ball-retaining and supporting rim. Consequently the defendant's golf tees do not infringe the claim of the patent in suit.

For these reasons the bill is dismissed, with costs to abide the event.

Decree accordingly.

February 18, 1929.

## MARCH 12

# *Infringement Element in Claims On Self-loading Vehicle Patent*

ATIA SALES CORPORATION, PLAINTIFF, v. W. S. HOWARD, J. J. WHITE, B. NICOLL & COMPANY, INCORPORATED, ET AL. EQUITY No. 46-325, DISTRICT COURT FOR THE DISTRICT OF NEW YORK.

REISSUE Patent No. 16356, covering a self-loading vehicle wherein the body in dumping must move in relation to the power shaft and the drive connection between the loader and the power shaft was made separable, was held not to be infringed by defendants' vehicle, which included a flexible connection between the loader and powershaft, plaintiff's contention that, while the claims specified a separable connection, the flexible connection constituted an equivalent, and therefore an infringement, not being sustained.

W. P. Preble solicitor for plaintiff; Emery, Booth, Janney & Varney solicitors for defendants (Lucius E. Varney, Manvel Whittemore and William R. Glisson, of counsel).

The full text of the opinion of the Court, delivered by Judge Coleman, follows:

Motion to dismiss bill on stipulation of facts. Action to restrain infringement of patent numbered Re. 16356, reissued May 25, 1926, covering a self-loading vehicle. No answer has yet been interposed, but the parties have stipulated the facts constituting the alleged infringement. Upon that stipulation defendants make this motion to dismiss the bill on the ground that, as a matter of law, the stipulated facts do not constitute an infringement. Counsel are to be commended for making this arrangement, which permits of a summary decision on a vital point in the case and obviates a trial if that point is decided in favor of defendants.

The claims declared on are numbered 1 to 4, inclusive, but both sides agree that the first may be considered as typical. It calls for a chassis, a tiltable cargo body, a mechanical loader on the body, and a power-shaft to supply power to the loader from the motor of the car. It is apparent that, since the body, with its loader attached, must in dumping move in relation to the power shaft, the connection between the loader and the power shaft had to be either separable or flexible.

The patentee chose the former method, and Claim 1 accordingly calls for "mechanism for driving the loader from said

power shaft comprising cooperative separable driving and driven members connected, respectively, with said shaft and with the tiltable body, and means for separating and reconnecting said members when the tiltable body is in normal position."

The specification shows a conical clutch between the power shaft and the loading mechanism, one member of which clutch remains stationary with reference to the power shaft, while the other is raised away from it when the body tilts in dumping, and is reunited when the body is lowered. An essential element of the claim is, therefore, a separability between the parts of the mechanism connecting the power shaft with the loader.

The defendants' device adopts a flexible rather than a separable connection between the power shaft and the loader. It consists of a universal joint located at the pivot on which the body turns in dumping, and at no time is the power shaft disconnected from the loader by the tilting of the body. It is undisputed that power could be transmitted from the power shaft through the universal joint to the loader just as readily while the body is tilted as when in normal position, though doing so might damage the loader because of the nature of its construction. It has, however, a hand clutch which is in no way related to the tilting of the body, and need not be considered.

### Device Is Not Equivalent.

Plaintiff contends that, while defendant's device does not come within the express terms of the claim, it is an equivalent. It, however, not only does not come within the express terms of the claim, but it is inconsistent with what both the specification and the claims show to be an absolutely essential element in the patent, namely, separability of the driving and driven members of the connecting mechanism when the body is tilted. Defendants' device has no separability, either spatial or functional, and is not an equivalent.

The motion to dismiss the bill is, therefore, granted. Settle decree on notice.

January 17, 1929.

## MARCH 13

# *Simplified Construction Marks Apparatus for Softening Water*

EX PARTE GREEN. APPEAL NO. 892, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1702256 was issued February 19, 1929, to Walter H. Green for water-softening apparatus, on application No. 700765, filed March 21, 1924.

The rejection of claims 2, 3, 6, 7, and 8, directed to a water-softening apparatus for removing such ingredients as are objectionable in that they cause the formation of scale in boilers and make the formation of suds with soap difficult in laundry and household use, was affirmed by the Board of Appeals. Claim 1, however, was found to present a simplified construction over what was disclosed in the prior cited art and was allowed.

Cromwell, Greist & Warden for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Ide and Landers) follows:

This is an appeal from the decision of the primary examiner finally rejecting all of the claims, numbered 1 to 9, inclusive, of which the following will serve as examples:

"1. In water treating apparatus, a treating receptacle comprising a storage portion, a sedimentation portion below the same and decreasing in cross sectional area downward, and a mixing portion below the sedimentation portion and forming an extension thereof, said mixing portion being of much smaller cross sectional area than the storage portion, and all of said portions being in unobstructed communication with one another, in combination with means for introducing raw water and treating material for reaction in the mixing portion and means for withdrawing water from the storage portion.

"2. In water treating apparatus, in combination, a mixing leg, a sedimentation cone extending upwardly from the top thereof and increasing in cross sectional area upwardly, and a storage receptacle above the sedimentation cone, and having a diameter more than twice that of the mixing leg, said members

being conjoined coaxially to form a treating receptacle, means for introducing raw water and treating material for mixture and reaction in the mixing leg, and means for withdrawing water from the storage receptacle.

"6. In water softening apparatus, in combination, a treating receptacle comprising a sedimentation portion and a mixing leg of smaller area below the sedimentation portion and arranged for the collection of sediment therefrom, an inlet for introducing raw water into the bottom of the mixing leg among sludge deposited therein, and an outlet for withdrawal of water at the upper portion of the receptacle.

"8. In water softening apparatus, in combination, a treating receptacle including a sedimentation portion, a mixing portion opening at its top into the sedimentation portion and arranged for collection of sludge deposits, an inlet arranged to introduce raw water into the mixing portion to pick up sludge collected therein, means for introducing treating material into the mixing portion, a storage portion above the sedimentation portion, and an outlet for withdrawal of treated water from the storage portion.

"9. In water treating apparatus, the combination with a tank having a vertically extending mixing leg of circular cross section, a sedimentation portion extending upwardly from the upper end of the mixing leg and flaring to a cross sectional area much greater than that of the mixing leg and a storage portion above the sedimentation, all of said parts being in unrestricted communication, of supply means arranged to deliver water into the mixing leg in a direction to set up rotary movement of water therein, means for supplying treating material into the mixing leg, and an outlet for withdrawing water from the storage portion, the arrangement being such as to induce a rotary movement of water in the tank, the velocity decreasing from the lower portion upwardly."

**Water Treating Apparatus.**

The references relied upon by the examiner are: Van Vloten, 1195537, August 22, 1916; Dervaux, 495313, April 11, 1893; Ladd et al., 1466053, August 28, 1923; Disclosure on Page 666 of Railway Review, Vol. 63, 1918; Bachman, 650216, May 22, 1900.

The claims are for a water treating apparatus for removing such ingredients as are objectionable in that they cause the formation of scale in boilers and make the formation of suds with soap difficult in laundry and household use.

The apparatus comprises a receptacle having an upper cylindrical storage portion, a conical portion tapering downwardly from the cylindrical portion constituting a sedimentation portion terminating in a cylindrical water receiving and mixing portion of relatively small diameter. The upper or storage portion is of about four times the diameter of the lower or mixing portion.

The untreated water containing the impurities is introduced into the mixing chamber tangentially so that a rotary motion will be imparted thereto. At the same time, lime-soda mixture is introduced perpendicularly across the path of the entering current of untreated water. The cross currents cause the thorough mixture of the water and lime-soda mixture. This mixture rises from the mixing portion of the apparatus into and through the conical sedimentation chamber and in passing through the sedimentation chamber the water loses velocity as it rises and will enable the sludge or precipitated particles to settle and contact with the slowly ascending water.

The appellant says the sludge or precipitate settles down through the conical chamber, and the particles gather the more closely together, the nearer they approach the mixing chamber. In this manner most of the suspended matter is removed before the water passes into the large upper storage chamber. Appellant also emphasizes that there is no agitation other than that in the mixing chamber to cause the mixing of the lime and soda and water and that the upwardly flowing water moves freely in the absence of obstructions in the form of baffles.

The patent to Van Vloten shows a water purifying apparatus comprising an upper cylindrical portion having a height greater than its diameter, an inverted conical chamber therebelow tapering to about one-fifth the diameter of the upper cylindrical portion, and a terminal spout 4 provided with an outlet valve 5. The cylindrical chamber is provided across the upper portion thereof with a filter. The purified water is drawn off by an outlet pipe above the filter.

The conical chamber is provided with two concentric baffles, the lower of which is of upright conical shape and spaced from the wall of the inverted conical chamber. The upper baffle is annular

and concaved downwardly and spaced from the chamber wall. This upper baffle divides the flow from the lower baffle into two parts as the water flows upwardly through the space between the lower baffle and the wall of the chamber. The patentee says:

**The Purpose of Baffles.**

"The baffles not only retain the water for a sufficient period to complete the precipitation process, but they serve to prevent a too sudden upward flow of water by the difference in temperature of the inflowing and outflowing liquids. The liquid entering the tank at a comparatively high temperature collects in the central baffle 10 in which the cooling process is continued with the result that when the liquid enters the body of water in the upper portion of the tank through the passages 14 and 15, it is evenly distributed and rises with the same at a uniform velocity. The formation of a rapidly rising current of water is thus prevented and all the water entering the sediment chamber is retained a period sufficient for the complete precipitation of its impurities by chemical reaction irrespective of the temperature at which it is supplied."

The patent to Dervaux discloses several modifications of a device for carrying forward a process of purifying water in which milk of lime is delivered into an inverted hollow cone or pyramid to meet the upward flow of unpurified water which enters the lower portion of the cone. The patentee says:

"This water passes upward and meets the milk of lime, then, as it rises into the upper part of the apparatus, which may be furnished with interrupting, or baffle partitions, or it may be simply enlarged. The water as it moves upward and clarifies, allowing the lime that it holds in suspension to fall to the contracted bottom of the reservoir, while the purified water passes off, in the state of lime water, by the exit pipe. * * * Then, by special application of suitable partitions for breaking up or interrupting the current, or simply by the greater diameter of the saturator B in its upper part, the upper stream clears up and flows off while the lime in suspension, by reason of there being no flat bottom to the vessel on which it can deposit, is constantly returned to the path of the water which enters at the bottom of the conical vessel B. * * * It will be understood, that, as the turbid liquid rises or bubbles up in the receptacle B, the solid matter mixes with or remains mixed with the alkaline solvent; but, above a certain indefinite point or line, located usually about one-third the height of the receptacle, the velocity of the ascending current and likewise the agitation due thereto are diminished, partly in consequence of the enlargement of the cross sectional area of the receptacle B, so that the intermingling of the solid matter with the solvent becomes less, and hence at this point decantation may begin."

Figs. 2, 4 and 6 of Dervaux show the upper portion of the apparatus in the form of a cylinder and the lower portion as conical, and the patentee says:

"I may employ a cylindrical or prismatic decanter A, with or without suitable partitions L, surmounting the cone B in which the saturation is effected."

Figs. 5 and 6 show a bottom cylinder T surmounted by a truncated cone or pyramid B and Fig. 6 shows the cone surmounted by an upper cylinder or prism A. Figs. 5 and 6 show a mixing device in the lower cylinder T for intimately mixing the water with the lime in the contracted bottom of the apparatus.

**Process in Mixing Chamber.**

The patent to Ladd discloses a combined water softener and storage tank comprising an upper cylinder of large diameter joined at the bottom to a cone which terminates at its lower end in a cylindrical settling basin of relatively small diameter. In the upper cylindrical part is suspended an open bottomed cylindrical mixing chamber which projects about half way down into the cone. An agitator is rotatably mounted in the mixing chamber. Below the settling basin is a sludge pit.

In the operation of Ladd's device, water and chemicals are admitted at the top of the mixing cylinder or chamber and are mixed therein by the agitator. The softening process takes place in the mixing chamber and the mixture flows out of the bottom of the mixing chamber into the cone. The sediment or sludge produced by the softening of the water within the mixing chamber falls out of the bottom thereof and settles into the cylindrical settling basin 15 below the cone and thence into the pit through a valve 91 from whence it escapes into a sewer. The steepness of the wall of the cone prevents the sludge or sediment from settling thereon. The softened water rises within the cone and the storage tank outside of the mixing cylinder above the outlet pipe 93 and be-

low the overflow 95. The patent specification says:

"Since the bottom of the cylinder 71 from which the sludge or sediment escapes is considerably below the top of the outlet pipe 93, no sediment or sludge will rise in the tank above such outlet. The water above the top of the outlet pipe will be found always to be pure."

The patent to Bachman shows in Figs. 3 and 5, means 28 and 29 curved to give a swirling motion to the water in which lime and soda are addded.

The article in the "Railway Review," page 666, shows in Figs. 11 and 12 an upper cylindrical storage reservoir with its vertical wall at the bottom curved to merge into the top of a downwardly tapering conical chamber. The lower end of the conical chamber opens into a second conical chamber having a more nearly vertical downwardly tapering wall. The lower chamber is closed at the bottom and serves as a sludge collecting chamber provided with a sludge draining opening at the bottom thereof. Arising from the bottom of the sludge chamber is a cylindrical tube or column which extends through the three chambers and is closed at the top.

Untreated water is admitted vertically upward into the bottom of the column. The purifying chemical is admitted from a downwardly extending pipe which opens into the column just above the water intake opening so that the two currents meet from opposite directions. The mixed water and chemical rises to the top of the column where it passes out through a pipe that extends down along the outside of the column to a point near the joining of the two conical chambers. The stream of mixed water and chemical flows into the top of the lower conical chamber and after filling the same rises through the upper conical chamber losing velocity as it does so and permitting the impurities to separate from the water and settle into the lower chamber. The water rises slowly from the bottom of the intermediate chamber unobstructedly into the storage reservoir above, giving up its impurities as it does so and the water that rises in the cylindrical storage reservoir is pure and is withdrawn therefrom from a point about mid depth thereof.

### Unpatentable Claims.

The claims are rejected as unpatentable over the disclosures in either Van Vloten, Dervaux or the publication in the Railway Review.

In reading claim 1 upon Van Vloten we find "a treating receptacle comprising a storage portion" in the cylindrical portion 2, "a sedimentation portion below the same and decreasing in cross-sectional area downward" in the upper portion of the cone 3, and "a mixing portion below the sedimentation portion and forming an extension thereof, said mixing portion being of much smaller cross sectional area than the storage portion." The claim calls for "all of said portions being in unobstructed communication with one another." The patent to Van Vloten shows baffle plates between the storage portion and the sedimentation portion and between the sedimentation portion and the mixing portion and so does not answer this part of the claim. The claim also calls for the "combination with means for introducing raw water and treating material for reaction in the mixing portion" shown in the pipes 25, 22 and 23 of Van Vloten. The claim further calls for "means for withdrawing water from the storage portion," as shown in the water outlet pipe 7.

The patent to Dervaux in Figs. 1 and 5 shows a single conical portion instead of the three distinct portions as called for in the claim and the lime is introduced downwardly through a vertical pipe which extends downwardly to a depth of about a third of the depth of the cone, so that the mixing of the lime and the water takes place at what may be regarded as the equivalent for the bottom of applicant's storage portion. Fig. 5 shows a stirring device at the bottom of the apparatus for stirring and intimately mixing the water with the lime in the contracted bottom of the apparatus, where it constantly falls, because there is no flat bottom on which it can deposit. No baffles or obstructions are used in the construction shown in Figs. 1 and 5. Figs. 2 and 6 of Dervaux show what may be regarded as the three portions of the apparatus as stated in applicant's claim, but the lime is introduced into the top of the sedimentation portion or bottom of the storage portion instead of into the mixing portion, as called for in the claim, and baffles are employed in the storage portion of Fig. 2 and in the sedimentation portion of Fig. 6.

The publication in the Railway Review discloses a construction upon which the claim fairly reads with the exception that the lower conical portion is a sludge collecting portion and not a mixing portion. The mixing is accomplished in the vertical column which delivers the mixed

water and lime into the top of the sludge collecting portion.

The patent to Ladd is not anticipatory of the claim for the same reason that the Railway Review publication is not.

We think claim 1 specifies a simplified construction over what is disclosed in the prior act cited and may properly be allowed.

### An Old Arrangement.

Claim 9 differs from claim 1 in specifying "supply means arranged to deliver water into the mixing leg in a direction to set up rotary movement of water therein, means for supplying treating material into the mixing leg, and an outlet for withdrawing water from the storage portion, the arrangement being such as to induce a rotary movement of water in the tank, the velocity decreasing from the lower portion upwardly." There appears to be some doubt as to whether Van Vloten shows this arrangement but in view of the fact that it is old to provide water swirling mechanism in apparatus for purifying water, as shown in Figs. 3 and 5 of Bachman, we do not regard claim 9 as patentably distinguishing from claim 1.

We regard claims 2, 3, 6, 7 and 8 as presenting nothing patentable over Van Vloten, Dervaux, Ladd and the publication in the Railway Review, and claims 4 and 5 as presenting nothing patentable over these references in view of Bachman.

The decision of the examiner is reversed as to claim 1. As to the remaining claims the decision of the examiner is affirmed.

Limit of appeal to Court of Appeals 40 days. Rule 149.

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# *Rejection of Claims On Unloading Device for Centrifugal Excavator*

EX PARTE WATKINS. APPEAL NO. 1126, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1702713 was issued February 19, 1929, to Frank M. Watkins for an unloading device for centrifugal extractors, on application No. 527182, filed January 5, 1922.

The rejection of claims 1 to 5 and 7, covering a centrifugal extractor of the type used in laundries, was reversed in view of the fact that the combination of three references did not meet that portion of the claims which states that the means for supplying fluid pressure for actuation of the pressure operating means is operated or controlled by the rotating means for the carrier.

Claims 8 and 9, in specifying that the arm for raising the load-carrying cage is adapted to be swung laterally, were considered patentable over a patent in which the arm was not only not adapted to be swung laterally but which was held from so swinging by a rod.

Brockett, Higley & Meyer for applicant.

The full text of the decision of the Board of Appeals (First Assistant Commissioner Kinnan, Examiners-in-Chief Ruckman and Landers) follows:

This is an appeal from the action of the examiner finally rejecting claims 1 to 9, inclusive. Claim 1 is illustrative and reads as follows:

"1. A centrifugal extractor, comprising a curb, a load-carrying member rotatably and vertically movable, therein, means for rotating said member, fluid pressure means for raising said member, and means operated by said member rotating means when the same rotates and arranged to supply fluid pressure for actuation of said pressure operating means."

The references relied upon are: Johnson et al., 220479, October 14, 1879; Seashole, 1054871, March 4, 1913; Manly, 1110450, September 15, 1914; Griffith, 1188932, June 27, 1916; Prestwich, 1414525, May 2, 1922.

The invention relates to a centrifugal extractor of the type used in laundries. Appellant's device comprises a curb and a load-carrying member mounted for rotation in the curb and for elevation out of the curb and swinging movement to one side thereof to permit the load to be removed from the carrier and another load to be placed therein. In order to accomplish the elevating movement an hydraulically operated plunger rod is mounted for vertical movement and its upper end is provided with a laterally extending arm adapted to be connected to the upper end of a central shaft on the load carrier.

The liquid for operating the plunger is forced from a container therefor beneath the plunger by means of compressed air in the upper portion of the

container. An air pump is driven from one of the pulleys over which the belt passing from the motor to the rotating means for the carrier extends. Consequently compressed air is stored in the container above the liquid during the rotation of the carrier. By means of manually operated valves and intervening pipe connections the apparatus may be adjusted to permit the compressed air to force the water beneath the elevating plunger thereby causing the load carrier to be eleveated. Also the pressure above the water in the container may be released permitting the plunger to descend and the water which has passed from the container to return thereto.

The examiner in rejecting the claims relies upon the patent to Prestwich as his basic reference. In this patent the load carrying member is mounted for rotation in a curb and for vertical movement into and out of the curb. The vertical movement is imparted by means of a vertical screw 38 which may be rotated in the desired direction by selection of the prorper gear 36. The examiner holds that there would be no invention in substituting for the elevating means shown in Prestwich the hydraulically operated plunger 14 shown in the patent to Seashole. He further holds that there would be no invention in operating the latter plunger by the hydropneumatic operating means disclosed in the patent to Johnson et al.

The combining of these three references does not meet that portion of the claims which states that the means for supplying fluid pressure for actuation of the pressure operating means is operated or controlled by the rotating means for the carrier. The examiner deems the equivalent of this limitation shown in the dumping wagons disclosed in the patents to Manly and Griffith in which pneumatic pressure is stored in tanks by operation of the engines employed for propelling the wagons.

We believe claims 1 to 5, inclusive, and 7 recite a specifically new organization not shown or suggested by the references taken singly or collectively. Appellant appears to be under the impression that claim 6 also requires the means for storing the impression that claim 6 also requires the means for storing gaseous fluid pressure to be controlled by the rotating means. This limitation is not included in claim 6 and we deem this claim unpatentable over Prestwich taken in connection with Johnson et al. Broadly there would be no invention in using the Johnson et al. elevating mechanism for elevating the arm 40 in Prestwich.

**Lateral Movement.**

Claims 8 and 9 state that the arm for raising the load-carrying cage is adapted to be swung laterally. In Prestwich the arm 40 is not only not adapted to be swung laterally but it is held from swinging movement by the rod 406 so that the elevating screw may properly function. We believe these claims define a construction which is patentable over any construction shown in the references.

The decision of the examiner is affirmed as to claim 6 and reversed as to claims 1 to 5, inclusive, and 7 to 9, inclusive.

Limit of Appeal to Court of Appeals 40 days.

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# *Transformers for Electric Currents*

EX PARTE SMITH. APPEAL NO 635, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1703408 was issued February 26, 1929, to Franklin S. Smith for Transformers, on application No. 410279, filed September 14, 1920.

Claim 7 of applicant's case, relating to a transformer and differing from the reference structure in specifying that the spark gap was a "fast" spark gap, was held anticipated on the ground that the term "fast" was merely a relative term.

For the reason that invention could not be predicated on the broad idea of placing a protective spark gap within a hermetically sealed transformer casing containing a gaseous dielectric under pressure, claims 7, 9, 11, 12 and 17 were also deemed unpatentable.

The rejection of claims 8 and 10 was reversed upon a finding that those claims were sufficiently specific to applicant's apparatus to be patentable.

Robert S. Blair for applicant.

The full text of the decision of the Board of Appeals (First Assistant Commissioner Kinnan, Examiners-in-Chief Ruckman and Landers) follows:

This is an appeal from the action of the examiner finally rejecting Claims 7 to 12, inclusive, 15, and 17. Claims 7 and 12 are illustrative of the finally rejected claims, and are as follows:

"7. In apparatus of the character described, in combination, a transformer adapted to operate at relatively high

voltage, means forming a circuit in shunt relation to the high-voltage winding of said transformer and having included therein electrode members separated by a self-restoring dielectric of invariable dielectric strength to form a fast spark gap across which spark-over is thereby effected at a fixed critical voltage.

"12. In apparatus of the character described, in combination, an electric transformer having primary and secondary windings related one to the other to provide a vertically directed passage therebetween, and a hermetically sealed casing having therein said transformer and filled with a gaseous insulating and cooling medium under pressure, the opposite sides and ends of said transformer being spaced from said casing to provide spaces adapted, with said vertically extending passage, for the free and unimpeded circulation of the insulating and cooling medium with relation to said windings and to said casing."

### References Reviewed.

The references relied upon are: Thomson, No. 428648, May 27, 1890; Moody, No. 783533, February 28, 1905; Frank, No. 833207, October 16, 1906; Ryan, No. 835367, November 6, 1906; Downing et al., No. 1278121, September 10, 1918; Lee, No. 1307867, June 24, 1919; Lindstrom, No. 1334041, March 16, 1920; Smith, No. 914981, March 9, 1909.

The invention relates to a transformer having a hermetically sealed casing containing a gaseous dielectric under pressure. The primary and secondary windings of the transformer, although concentrically mounted as usual, are spaced from each other to provide a passage therebetween through which the dielectric may circulate for cooling purposes. A solid dielectric occupies part of said space. It is placed between the said passage and the outer or high-potential winding. A spark gap is arranged between one terminal of the high-potential winding and the casing, and the other terminal of this winding is connected to the casing, the latter being grounded. Accordingly the spark gap is in shunt relation to the high-potential winding. The spark gap is within the casing, and is therefore filled with the gaseous dielectric.

Claim 7 is too broadly drawn to be allowable over the patent to Frank, taken alone. This claim does not locate the spark gap within the container. The spark gap shown at the top of Figure 1 of Frank is deemed to have substantially the characteristics of appellant's spark gap as defined in the claim. While appellant designates his gap as a "fast" spark gap, this is a relative term. Frank's protective spark gap, shown at the top of Figure 1, is a "fast" gap as compared with those shown in his body of oil. The distinction "without preceding corona" is not stated in the claim. The language of a claim must be read as broadly as its terms fairly permit. In this connection attention is directed to the discussion of the term "high" in the case of In re Levy, 1925 C. D., 180, 55 App. D. C. 137.

### Old Features Found.

It is old to provide transformers with protective spark gaps, as shown at the top of Figure 1 of Frank. It is also old to place spark gaps within transformer casings as shown in both of the patents to Frank and Lee, and these gaps in Frank are in shunt relation to the high potential winding. Furthermore, it is old to fill hermetically sealed transformer casings with a gaseous dielectric under pressure, as shown by the patent to Lindstrom. In view of the teachings of these references, it is not believed invention can be predicated on the broad idea of placing a protective spark gap within a hermetically sealed transformer casing containing a gaseous dielectric under pressure. For this reason claims 7, 9, 11, 12 and 17 are deemed unpatentable.

Claims 8 and 10 are considered sufficiently limited to appellant's specific apparatus to be patentable. Claim 8 defines the relation of the spark gap circuit with respect to a grounded container; and claim 10 defines a specific relative arrangement of the parts of the apparatus including a solid dielectric as well as a gaseous dielectric under pressure.

Claim 12 does not include appellant's protective spark gap. It defines the spaced relationship of the primary and secondary windings to provide a vertical passage therebetween. This feature is shown in the patent to Smith and this claim is deemed unpatentable over Lindstrom taken in connection with Smith.

The decision of the examiner is affirmed as to claims 7, 9, 11, 12, 15 and 17 and reversed as to claims 8 and 10.

Limit of Appeal to Court of Appeals 40 days. Rule 149.

MARCH 14

# *Novelty of Forceable Separation In Dispensing Nested Paper Cups*

EX PARTE REIFSNYDER. APPEAL NO 1472, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1703637 was issued February 26, 1929, to James D. Reifsnyder for Cup Dispensing Machines, on application No. 432377, filed December 2, 1920.

The appealed claims, covering apparatus for dispensing nested cups having a circular flange at the open end of the cup, the distinctive feature of the device residing in the provision of cam means to pry the flanges of the two lowermost cups apart and forcibly separate the lowermost cup from the next adjacent cup, were found patentable over a combination of two references neither of which contemplated the forcible separating action included in the appealed claims.

**Means for Separating Cups.**

One of the references showed means for forcibly separating the lowermost cup from the stack, but the opinion states that this was done by the pulling action on the body of the cup.

The decision of the examiner rejecting claims 1, 2, 4, 5, 12, 13, 15, 16, 17 was reversed.

S. Mortimer Ward, jr. for applicant.

Before Assistant Commissioner Moore Examiners-in-Chief Henry and Ide. The full text of the opinion of the Board follows:

This is an appeal from a final rejection of claims 1, 2, 4, 5, 12, 13, 15, 16 and 17. Claim 1 is reproduced as typical of the appealed claims:

"1. In a device of the character described, the combination of a container for a stack of nested cups, and means for dispensing the cups one by one comprising a horizontally swiveled device positioned to rotate toward the vertical axis of the stack of cups and having a part for normally engaging the lowermost cup of the stack to support it, and having a downwardly facing shoulder and a cooperating upwardly and rearwardly extending surface forming a cup-prying part adapted when the device is rotated, to enter between and engage the flange of said lowermost cup and that of the next adjacent cup to support said latter cup and produce a prying action to forcibly separate the lowermost cup therefrom, and through said next adjacent cup to support the stack until the return of the first mentioned cup-supporting part."

The references relied upon are: Conner, 673760, May 7, 1901; Erwin, 1095319, May 5, 1914.

The construction upon which the appealed claims are based is an apparatus for dispensing nested cups of the type having a circular bead or flange at the open end of the cup. When the cups are nested in a receptacle with the flanged open ends thereof at the lower open end of the receptacle, the cups are supported by cams located at opposite sides of the receptacle. The cams are peripherally notched, the flange of the lowermost cup resting in the notches of the cams. The upper portion of the notch of each cam constitutes a prying nose so that rotation of the cams causes the noses thereof to pry the flanges of the two lowermost cups apart and forcibly separate the lowermost cup from the next adjacent cup. Most of the claims on appeal include the cup prying part and all of them stress the prying action or the forcible separation of the flanges of the cups.

**The Erwin and Connor Patents.**

The examiner rejects each of the appealed claims on the Erwin patent in view of the patent to Connor. The examiner further holds that the claims are broad enough to read on Erwin alone. The construction of the Erwin patent relied on is that shown in Fig. 5 of the patent. In that figure nested flanged cups are supported by oppositely located toothed wheels. The lowermost cup is dispensed by taking hold of the body of the cup and pulling it away from the supporting wheels. There is no actuation of the wheels except in the sense that they are rotated by the pull on the lowermost cup and no forcible separation of one cup from another than the manual pulling of the lowermost cup from the stack. The Conner patent is a newspaper vending device. Metal frames are hinged on a supporting wire, each frame supporting a newspaper. The lowermost frame rests in a notch in a

wheel mounted on a shaft. The shaft may be rocked manually to carry the notch in the wheel away from the lowermost newspaper supporting frame thereby permitting the frame to drop by gravity and discharge its newspaper. While the shaft carrying the wheel is rocked manually there is no prying action by the wheel and no such action is necessary. The frames have no tendency to stick and are heavy enough to drop by gravity when permitted to do so by rotation of the shaft and wheel.

Touching the rejection of the claims on a combination of the Erwin and Conner patents it is the view of the examiner that there would be no invention in forming the wheels 15 of the Fig. 5 construction of the Erwin patent in the manner taught by the similarly designated wheel of the Conner patent. We think the rejection should not be sustained. Neither Erwin nor Conner contemplated the prying action or the forcible separating action included in the appealed claims. As previously noted the delivery action of the newspaper supporting frames of Conner is a gravity action. Also in the Erwin construction while there may be a forcible separation of the lowermost cup from the stack this separation is not due to any prying action of the teeth of the supporting wheels but is due to the pulling action on the body of the cup.

"Swiveled" or "Journaled."

So far as the rejection of the claims on the Erwin patent alone is concerned it is sufficient to say, as we have said before, that no prying action of the teeth of the supporting wheels on the flanges of the nested cups is disclosed in the reference and we think it is not inherent in the illustrated construction of Fig. 5 or any of the other figures.

The examiner criticizes the claims because of the employment therein of the term "swiveled" to describe the mounting of the cams. While the term "journaled" might be a better term to describe the mounting of the cams, the term employed does not seem to be misleading and no uncertainty exists as to the meaning of the claims. Claim 4 does not necessarily mean that the cup prying parts are carried on separate members from the cup supporting parts. No necessity exists for amending the claims as to the terms employed therein. We note that the term "swiveled" was employed in the claims as originally presented and is also employed in the allowed claims.

The action of the examiner is reversed.

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# *Paper Drinking Cup Innovations*

EX PARTE REIFSNYDER. APPEAL NO. 1498, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1703638 was issued February 26, 1929, to James D. Reifsnyder for Impregnated Individual Paper Drinking Cups, on application No. 526259, filed December 31, 1921.

A paper drinking cup with the inner wall alone impregnated with waterproof coating so that there was no visible coating on the outside or rim, the coating used having a high melting point to permit use of the cup for serving hot liquids, was held patentable over the prior art, the rejection of claims 6, 5 and 8 to 13 being reversed.

Claims 2, 3, 4 and 7, however, did not specify that the coating had a high melting point and were denied to applicant in view of the prior art disclosures.

Ward & Crosby for applicant.

The full text of the opinion of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Henry and Ide) follows:

This is an appeal from a final rejection of claims 1 to 13, inclusive, no claims being allowed. Claims 2, 5 and 10 are reproduced as typical of the appealed claims:

"2. As an article of manufacture, a paper drinking cup having a side wall portions of which comprise only a single layer of paper impregnated with a waterproofing material, and substantially odorless and tasteless when put to the lips, and having no visible coating of said material on the outer surface of the side walls.

"5. As an article of manufacture, a paper drinking cup impregnated with a waterproofing material of sufficiently high melting point to enable the cup to be used to serve liquid at at least about

150 degrees Fahrenheit, and having no visible coating of said material on the outer surface of the side walls said cup being substantially odorless and tasteless when put to the lips.

"10. As an article of manufacture, a paper drinking cup thoroughly impregnated with a mixture of paraffin and carnauba wax, the latter being present in proportion sufficient to materially raise the melting point of the mixture."

The references relied upon are: Davis, 229678, July 6, 1880; Claussen, 1069675, August 12, 1913; Bohlman, 1181963, May 2, 1916; Luellen, 1284728, November 12, 1918.

**Interior Wall Waterproofed.**

Appellant is claiming a paper drinking cup of the type disclosed in the patent to Hill No. 1310698, granted July 22, 1919, or the patent to Claussen, No. 1069675 cited by the examiner in the statement on appeal. What appellant is relying on to impart patentability to the claims is the impregnation of the walls of the cup with a waterproofing material so that there shall be no visible coating on the outside of the cup or on the flange or rim.

Specifically the waterproofing is applied only to the interior of the cup, the cup being of the type disclosed in the Claussen and Hill patents. The purpose of the coating of a cup in the manner described is to provide a paper cup which will not soil the gloves of one handling it and also to avoid objectionable taste or odor.

Further appellant employs a waterproofing material having a high melting point thereby permitting hot liquids to be placed in the cup. The special materials employed are paraffin and carnauba wax and these materials are employed in such proportions as to produce a waterproofing coating of the necessary heat resisting characteristics.

The appealed claims have been rejected on two grounds. The first rejection is based on the patent to Bohlman in view of Claussen. The claims were further rejected on Claussen in view of Luellen. Bohlman discloses a two-part paper cup having its outer surface sprayed with paraffin. The examiner notes that the specification of the patent states that a very thin coating or a coating of no appreciable thickness is applied to the cup.

Appellant points out and has filed an affidavit stating that it is not possible to spray a coating of paraffin on the exterior of a paper cup without producing a cup open to the objection noted herein. It is also pointed out that in the Bohlman patent the coating is applied to the exterior of the cup.

In the Claussen patent which shows a cup constructed as is appellant's cup there is a general reference to coating the cup with paraffin but no definite statement as to the character or degree of the coating. In view of appellant's argument and affidavit we think the rejection on a combination of the Claussen and Bohlman patents must fail.

However, we think some of the appealed claims are lacking in invention over a combination of the Claussen and Luellen patents. The latter reference shows a two-piece paper cup treated with a waterproofing substance which is not visible on either the interior or the exterior of the cup. The claims we have in mind are those numbered 2, 3, 4 and 7.

These claims do not bring out the idea of a coating having a high melting point and we think it would be uninventive to coat the interior only of the Claussen cup with a waterproofing material in view of the teachings of the Luellen reference.

Claims 5, 6 and 8 to 13, inclusive, bring out in some form or other the use in a paper drinking cup of a high melting point waterproof coating thereby permitting the cup to be used to serve hot liquids. This is a new idea in paper drinking cups. For this feature the examiner relies on the Davis patent which is for a paper pail having a waterproofing material of oil and sulphur. The Davis patent, we think, would not teach the use in a drinking cup of a waterproofing material such as that called for by the appealed claims last noted. Accordingly, we think claims 5, 6 and 8 to 13, inclusive, may be allowed.

Appellant does not insist on claim 1 and as to this claim the appeal will be dismissed. The action of the examiner rejecting claims 2, 3, 4 and 7 is affirmed. The action as to claims 5, 6 and 8 to 13, inclusive, is reversed.

Limit of Appeal to Court of Appeals 40 days. Rule 149.

March 12, 1928.

# Device to Stack Cakes and Cookies

EX PARTE HUNGERFORD. APPEAL NO. 45, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1702901 was issued February 19, 1929, to Warren H. Hungerford for biscuit facing and stacking machines, on Application No. 667187, filed October 8, 1923.

Appellant's invention, the decision states, relates to the feeding of articles, such as cookies, of such shape that the article, if resting on edge on a plane surface, is supported at one side of its center of mass, through a feeding mechanism in such manner that they will all be faced in the same direction on emerging, whereas the prior art discloses a patent structure comprising a chute mechanism designed to cause can lids to swing in one direction or another, depending upon which direction the heavier side is presented, so that they will all be faced in the same direction during their course down the chute.

**Special Features of Feeding.**

Claims 6, 12, and 13, covering special features of the feeding mechanism, were found patentable over the prior art. The rejection of Claims 7 to 11, however, on the reference mentioned above, was affirmed.

Parker & Carter for applicant.

The full text of the opinion of the Board of Appeals (First Assistant Commissioner Kinnan, Examiners-in-Chief Ide and Landers) follows:

This is an appeal from the action of the primary examiner finally rejecting claims 6 to 13, inclusive. Claim 6 is illustrative of the appealed claims and is as follows:

"6. The process of facing articles in which the point of support, when they are positioned on edge, lies to one side of the center of the mass of the article, which consists in constraining said articles to downward travel along a vertical path and plane, in dropping them in substantially vertical position on a substantially horizontal surface, and in conveying away the articles successively as they fall from said horizontal surface, with the same side of each article facing the same direction."

The reference relied upon is: Thom, 831905, September 25, 1906.

The invention relates to the feeding of articles, such as cookies, of such shape that the article if resting on edge on a plane surface is supported at one side of its center of mass. Advantage is taken of this shape of the article to cause it to turn one way or the other during its travel through the feeding mechanism so that all of the articles when coming from the feeding mechanism will be faced in the same direction. Some of the claims define the apparatus and others the method practiced in the use of the apparatus.

As shown in Figure 1 the articles are fed by means of a belt A6 from the hopper A8 to an elevated position from which they drop into a vertical chute. They pass downwardly from the chute and fall freely on edge on the plane surface C. They then tilt in a direction toward their rounded sides and continue down the inclined surface C, all faced in the same direction.

The patent to Thom, which is the sole reference relied upon by the examiner, discloses in Figures 4 and 5 a conveyor 92 for carrying can covers from the receptacle 86 to an elevated position from which they are dropped edgewise into a vertical chute 94. This chute has an inclined bottom 99 along which the can covers roll, as illustrated in Figure 5, until they strike the tapered edge of a member 102, Figure 11, which is shown in dotted lines in Figure 5. When they strike this member they are caused to swing in one direction or the other, depending upon the direction in which the heavier side is presented, so that they will all be faced in the same direction during their continued movement down the chute 100.

**Differences Are Found.**

Claim 6 states that the articles are constrained to downward travel along a vertical path and dropped in a substantially vertical position on a substantially horizontal surface. Claim 12 calls for a generally horizontal plane surfaced stop aligned beneath a generally vertical chute and spaced below it a distance exceeding the diameter of the articles. Claim 13 defines a method in which the articles are constrained to a substantially vertical plane and dropped substantially vertical while constrained to such plane upon a substantially plane generally horizontal receiving surface. It is believed these claims in the respects pointed out differentiate from the Thom disclosure in a patentable manner. In

the latter the articles roll along an inclined surface until they contact with an inclined stop member. They do not drop or freely fall onto the positioning element.

**Failure to Differentiate.**

The remaining claims on appeal however fail to clearly differentiate from Thon.. His articles are carried by the conveyor 92 up to a position in which they are turned into a substantially vertical plane and released and dropped onto the inclined support 99. From the point at which they are released by the conveyor 92 they are operated upon by gravity and they are faced in the same direction by engagement with the stop 102. While claims 9, 10 and 11 define the stop as having a plane-receiving surface it is believed the upper end of the stop 102 as shown in Figure 11 of Thom has substantial width and is a plane surface. In any event there would be no invention in providing it with a wider end portion than illustrated. The width could be increased considerably without destroying its function as a balancing member.

The decision of the Examiner is affirmed as to claims 7 to 11, inclusive, and reversed as to claims 6, 12 and 13.

Limit of appeal to Court of Appeals 40 days. Rule 149.

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# *Cleansing Air for Drilling Tools*

EX PARTE GARTIN. APPEAL NO. 738, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1703841 was issued February 26, 1929, to Elmer G. Gartin for Percussive Tools, on application No. 350450, filed January 9, 1920.

The rejection of claims 16, 17 and 19 on a combination of two references, the basic reference disclosing a drilling mechanism of the type set forth by appellant but differing therefrom in that it did not employ a valve controlled passage for supplying cleansing air to the cleansing tube, and the additional reference teaching the use of this additional cleansing air supply means, was affirmed.

Louis A. Maxson for the applicant.

Before First Assistant Commissioner Kinnan, Examiners-in-Chief Henry and Ide. The full text of the decision of the Board of Appeals follows:

This is an appeal from a final rejection of claims 16, 17 and 19. Claim 16 is reproduced as typical of the appealed claims.

"16. In a drilling mechanism, a drilling motor having a rear head member having a socket, a single final cleansing fluid supply conduit extending from said head member forwardly within said motor for conducting fluid to a drilled hole, means for maintaining said conduit in said head member comprising a hollow gland plug disposed within said socket, an air supply for said conduit, a liquid supply for said conduit leading through said gland plug, a valve for controlling the air supply to said conduit, and a valve for controlling the liquid supply flowing to said gland plug, the operation of said latter valve being dependent upon the operation of said air control valve."

The references relied upon are: Gilman 1175745, March 14, 1916; Haight, 1350407, August 24, 1920.

Appellant is claiming a drilling mechanism of the type wherein cleansing fluid is supplied to the drilled hole through the drill actuating motor. A conduit for cleansing fluid extends from the rear head member of the mechanism through the motor and to the extremity of the drill. Both cleansing air and cleansing liquid are supplied to the conduit in proper sequence, the supply being controlled by a main air valve and a second valve, the latter valve being actuated by the main air valve. The second valve controls the supply of cleansing liquid. In the rear head member of the drilling apparatus there is a socket receiving a hollow gland plug which supports the rear end of the conduit for cleansing fluid.

The Haight patent is the basic reference in the rejection of the appealed claims. It discloses a main air valve for controlling the supply of air to the motor of a drilling apparatus. This main air valve carries a cam for actuating a valve controlling the supply of cleansing liquid to a drilled hole. The cleansing liquid is supplied through a nipple communicating through a cavity in the head with a passage leading to the front end of a tool or to a water tube provided in the tool extending from the back head of the apparatus to the drill steel chuck. This water tube construction is generally the same as appellant's construction. It will be noted

that Haight does not employ air for cleansing the drill or drill hole but only employs a cleansing liquid. Gilman, however, employs both liquid or air as cleansing agents and supplies them to the drill or drill hole by means of a tube supported in the manner claimed in the appealed claims.

**A Question of Inventiin.**

The question presented by the rejection of claims 16 and 19 is whether or not it involved invention to add to the Haight construction a valve controlled passage for supplying cleansing air to the cleansing tube which the Haight patent says may be used. We think the Gilman patent would teach not only the use of this additional cleansing air supply means but would also teach the special supporting means for the rear end of the cleansing conduit called for by claim 16. We refer particularly to Fig. 3 of the Gilman patent and the tube 33 shown therein.

Claim 17 is broader than claims 16 and 19 in that it is not limited to means for supplying cleansing air to the conduit. The claim is broad enough to cover merely an air supply to the motor and liquid to the drill hole. As pointed out in the discussion of claims 16 and 19, the Gilman patent is a good teaching reference for the specific conduit supporting means included in the claim.

The action of the Examiner is affirmed.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

## MARCH 15

# *Implied License of an Employer On a Device Owned by Employe*

ANTON I. SANBO v. BEAR MANUFACTURING COMPANY. EQUITY No. 275, DISTRICT COURT FOR THE SOUTHERN DISTRICT OF ILLINOIS.

THE Court granted plaintiff an injunction prohibiting defendant from further manufacturing and selling plaintiff's device and from further infringing Patent No. 1477450, covering a flat bar type wheel alignment indicator.

The defense of statute of frauds, that the alleged contract of plaintiff was not to be performed within one year and was therefore void, was not sustained for the reason that both parties entered into the performance of the contract, and so far as performed, it was valid.

**Agreement in Royalties.**

The Court ruled that defendant's contention that it was entitled to an implied license in plaintiff's invention by virtue of having been an employer of the plaintiff at the time he made the invention, could not be allowed since the preponderance of the evidence showed the agreement was that plaintiff was to have a royalty for each indicator equal to twice the cost of the materials entering into the completed device, that there were to be frequent statements and accountings, and that any moneys advanced to plaintiff were to be deducted from the royalties.

The following is a full text of the memorandum giving the opinion of the Court:

It is shown by the record that plaintiff, at a time when he was not connected with defendant as an employe in any capacity, invented two types of wheel alignment indicators, the tubular type and flat bar type; that through an arrangement between the parties pending an application for patents, plaintiff went into defendant's shop and perfected defendant's machinery for the purpose of manufacturing the inventions.

The first alignment indicators manufactured were of the tubular type, which, after experiments, were found to be too expensive for the trade and further manufacture thereof abandoned. Later, plaintiff sought to and did perfect, as a manufacturing proposition, the flat bar type indicator, which he had invented at the same time as the tubular type, and, when finally perfected as a manufacturing proposition, sought an agreement with defendant as to royalties.

The Court finds that the great weight of the testimony sustains the contention of plaintiff that he was to enter defendant's shop, perfect the manufacturing of the wheel indicators so that they might be made for the market, to be sold by defendant, upon satisfactory royalties, to be agreed upon between the parties when the cost of manufacture could be ascertained; that the payment of $35

per week to the plaintiff was but a temporary allowance to meet ordinary living expenses while the manufacturing proposition was being developed.

Sanbo's contention in this regard is sustained by the fact that defendant furnished the materials to be used with its machinery, advised its bookkeeper to pay any account that was okeyed by Sanbo and sent to the office; that the royalty agreed upon of twice the value of the material entering into the manufacture of the device was apparently reasonable and fair, and the evidence upon the particular point of agreement preponderates in favor of plaintiff's contention.

### A Clear Understanding.

All of the physical facts and circumstances surrounding the parties tend to disprove defendant's contention that defendant had employed plaintiff to work for it as a superintendent of its machine shop and was to have the right to manufacture any of his inventions by reason of that fact. The Court is persuaded that there was a clear understanding between the parties as to their rights.

One of the defenses interposed to plaintiff's claim is the statute of frauds; that is, that the alleged contract of plaintiff was not to be performed within one year and was therefore void. This defense cannot be sustained for the reason that it is very clear that both parties entered into the performance of the contract and so far as it is performed, of course, it is valid and binding upon both parties.

As to the alleged shop right. A shop right in defendant would be entirely consistent with the contention of plaintiff, but upon his terms. He undoubtedly intended to give defendant the right to manufacture and sell his wheel alignment indicator, but upon condition that he be paid a reasonable royalty therefor.

As to the implied license. The facts in this case are not sufficient to warrant the Court to imply a right in defendant to manufacture and sell plaintiff's flat bar wheel indicator in limitation of the rights of the plaintiff.

The law applicable to the rights of an inventor to his invention has long been thoroughly established. The language used by Mr. Justice Brewer, in Solomons v. United States, 137 U. S. 342, 11 S. C. 88, has been approved many times and is undoubtedly the law governing the rights of the parties in this case, so far as the ownership and control of plaintiff's patent is concerned:

"The case presented by the foregoing facts is one not free from difficulties. The Government has used the invention of Mr. Clark, and has profited by such use. It was an invention of value. The claimant and appellant is the owner of such patent, and has never consented to its use by the Government. From these facts, standing alone, an obligation on the part of the Government to pay naturally arises. The Government has no more power to appropriate a man's property invested in a patent that it has to take his property invested in real estate; nor does the mere fact that an inventor is, at the time of his invention, in the employ of the Government transfer to it any title to or interest therein. An employe, performing all of the duties assigned to him in his department of service, may exercise his inventive faculties in any direction he chooses, with the assurance that whatever invention he may thus conceive and perfect is his individual property. There is no difference between the Government and any other employer in this respect. But this general rule is subject to these limitations: If one is employed to devise or perfect an instrument, or a means for accomplishing a prescribed result, he cannot, after successfully accomplishing the work for which he was employed, plead title thereto as against his employer. That which he has been employed and paid to accomplish becomes, when accomplished, the property of his employer. Whatever rights as an individual he may have had in and to his inventive powers, and that which they are able to accomplish, he has sold in advance to his employer."

### The Right of the Employer.

It must be borne in mind that the device of plaintiff here involved was invented at a time when he was not in the employ of defendant; that at least one had been manufactured for exposition and demonstration, and it is this device, so invented by plaintiff, in which defendant claims an implied license for the full period of the patent.

The exceptions to the general rule, as announced by Mr. Justice Brewer, do not include a state of facts such as is shown by the record in this case.

It is admitted by defendant that its rights practically rest upon its connection that it is the owner of an implied license to manufacture and sell plaintiff's patented flat bar type wheel alignment indicator.

"The right of the employer to the invention or discovery of the employe depends, not upon the terms of the original contract of hiring, but upon the nature of the services which the employe is en-

gaged at the time he makes the discovery or invention, and arises, not out of the terms of the contract of hiring, but out of the duty which the employe owes to the employer with respect to the service to which he is engaged." Houghton v. United States, 23 Fed. (2d) 386-390.

It is admitted by defendant that plaintiff's flat bar type wheel alignment indicator was invented at a time when plaintiff was not in the employ of defendant in any capacity, and it is also admitted that defendant is still manufacturing Sanbo's invention which is covered by his Letters Patent No. 1477450, upon the claim that he was employed at a salary of $35 per week to superintend defendant's factory and incidentally to manufacture in defendant's shop wheel alignment indicators of his own invention, as well as other things; that because defendant furnished the shop, tools and materials, and while Sanbo was in its employ he used other employes to assist in his work, that, therefore, it gained the implied license to manufacture and sell the patented device for the full period of the patent. If the facts were established as claimed by defendant, there might be some merit in defendant's contention in this regard. However, the evidence does not sustain this view.

Plaintiff was born in Norway; came to the United States when a young man; was a mechanic with an inventive turn of mind; had invented a number of desirable articles; his education was limited. He appeared as a witness upon the trial of this cause. He had previously invented an automatic starter and organized the Sanbo Starter Company to manufacture it.

### Intercession Through Son.

Later, in 1916 or 1917, the Sanbo Starter Company was taken over by defendant; plaintiff was given stock in the defendant company for his stock in the Sanbo Starter Company; he was elected director, and a resolution was adopted fixing his salary as director and superintendent of the factory at $5,000 per year; this arrangement proved unsatisfactory and in 1920 he "quit his job," left the company and started out for himself; he began experimenting and upon the suggestion of his son that if he could devise a wheel alignment indicator there would be a good market for it, he pursued and developed the suggestion.

Early in 1921, he made his drawings for both the tubular and flat bar types. He had manufactured one of the tubular type indicators. He had been approached by officers of defendant to let it sell this device; there was hesitation; finally, a consent that defendant might sell it; a start was made to manufacture the invention by Sanbo, when he was persuaded to go into defendant's shop to put it in a position to manufacture; that royalties were frequently discussed between Sanbo and his son, whom he wanted to have a share in the profits because of his suggestion.

Defendant's officers interceded with plaintiff's son to persuade his father to come into their factory to manufacture; finally, Sanbo consented to do so. Defendant agreed to advance him $35 a week, to furnish all the materials and tools, with the understanding, certainly on the part of Sanbo, that when the cost of manufacture was ascertained, a reasonable royalty would be agreed upon. Sanbo's version of the understanding between the parties is corroborated by the other facts in the case—that the $35 a week was an advancement by the fact that the bookkeeper was directed not only to pay him the weekly allowance, but to pay any other bills okeyed by him.

After the tubular type had been tried and found too expensive as a sales proposition, Sanbo then put defendant's factory in shape to manufacture the flat bar type. When that was done, he and his son went to the secretary of the company for an understanding as to royalties. The preponderence of the evidence shows that the agreement was that Sanbo was to have a royalty for each indicator equal to twice the cost of the materials entering into the completed device; that there were to be frequent statements and accountings; that any moneys advanced to Sanbo were to be deducted from the royalties. After the experience of a few months without an accounting as to royalties, Sanbo again "quit his job" and organized his own manufacturing company. When these facts are considered, it must be held that defendant's contention that it owns an implied license in plaintiff's patented invention is not sustained.

After Sanbo left defendant, he notified defendant to stop manufacturing and selling his device. It is true, the evidence in this case is far from satisfactory on both sides, due to the fact that neither party seemed to be especially skilled in matters of the character involved, particularly plaintiff.

### A Defensive Proposition.

Some time after plaintiff had left the last time, defendant learned of Snyder Patent No. 1206476, made a contract for

its purchase and, later, purchased it, and has since claimed to be manufacturing under the Snyder patent, and charges plaintiff with infringement. However, the evidence shows that defendant never manufactured under the Snyder patent, but continued to manufacture plaintiff's device.

The use of calipers, gauges, apparatus for indicating the displacement of rotary bodies, trammel-gauges for vehicle wheels, and practically every element in the Snyder device was old in the art and, yet, the Patent Office saw fit to grant a patent upon it as a combination of novelty and utility. Six claims were allowed by the Patent Office. Each of the first five claims referred to "a device of the character described," thereby reading into each claim the particular disclosure. In claim 6 the language is slightly different and refers to "a device for gauging the position of vehicle wheels," etc. Claim 6 is so general that the Patent Office undoubtedly read it in the light of the specifications and drawings illustrating the disclosure.

The Patent Office undoubtedly had the Snyder patent before it when it granted to Sanbo the patent of December 11, 1923, No. 1477450, and the patent granted November 25, 1924, No. 1516549. The latter patent, being for the telescoping tubular type and being somewhat similar to Snyder, was granted after a very careful consideration of the Snyder patent, and we feel the Patent Office was justified in granting it in the light of the limited interpretation which must have been placed upon the claims of Snyder. In fact, when the patents, being combinations, are considered in the light of their several disclosures and limited by them, there is no conflict. And while defendant had a perfect right to acquire the Snyder patent for whatever it is worth, it has the appearance of having been a defensive proposition.

Defendant moves to dismiss because plaintiff stated in his application that he was a citizen of the United States. It appears that at the time of making his application for his patents involved in this suit, plaintiff stated he was a citizen of the United States, when in truth and in fact he was a citizen of Norway. It is established that after he had been in this country a few years, just prior to an election, he was taken to some court in Minnesota, where he made a declaration of intention and then voted, believing he was a citizen of the United States, and continued thereafter to believe he was such until after this suit was commenced, voting frequently and exercising the rights of citizenship.

A misstatement in an oath that applicant was a citizen of the United States when he in fact was an alien is immaterial. Tondeur v. Chamber, 37 Fed. 337; Van Heusen Products Co. v. Earl & Wilson, 300 Fed. 952.

It is very earnestly contended that because Sanbo was apparently a stockholder and a director of defendant corporation, that therefore his invention belonged to the corporation. It is undoubtedly the law that where an officer of a corporation, in the exercise of his official duties conceives an improvement on a machine or device used by the corporation and takes out a patent thereon in his own name, holds it as the trustee for the benefit of the corporation, as was held in Dowse v. Federal Rubber Co., 254 Fed. 308.

**A Decree in Harmony.**

There the controversy involved the ownership of a patent which had been taken out in Dowse's name, at the expense of the company. The Court said (p. 315):

"Had the invention affected only a detail or unimportant part of the corporate business, it is probable that plaintiff would be regarded as its owner, both legal and equitable, as in American Stoker Co. v. Underfeed Stoker Co., 182 Fed. 642; Id., 188 Fed. 314. Here the patent involved the very life of the corporation. * * * Under the circumstances it would be grossly inequitable for plaintiff to retain title and the rule of Hapgood v. Hewitt and the cases following its rule does not apply."

The mere fact that one is a stockholder, director or officer of a corporation does not give the corporation any property right in the invention of such person unless there are substantially the same relations existing between the person and the corporation as would give the corporation right to the patent, because he was an employe. American Stoker Co. v. Underfeed Stoker Co., supra; Detroit Testing Laboratory v. Robinson, 191 N. W. 218.

A decree may be prepared in harmony with the prayer of plaintiff's bill, enjoining defendant from further manufacturing and selling plaintiff's device, and from further infringing upon Sanbo Patent No. 1477450; referring the cause to the Master to state the account between the parties, taking into account any damages accruing to defendant by reason of any unfair competition on the part of plaintiff.

January 29, 1929.

# Car Roof With Interlock Feature

EX PARTE JOUGHINS ET AL. FIRST ASSISTANT COMMISSIONER OF PATENTS.

PATENT No. 1703149 was issued February 26, 1929, to George R. Joughins and Eva Maude Joughins for Freight Car roofs, on application No. 501505, filed September 17, 1921.

The rejection of claims 3 to 6 was reversed. Appellant's device, which consisted of a car roof in which there was provided a combined ridge pole and ridge cover, which was riveted to the carlines and to which the running board was fastened, the combined member having curved ends which served as interlocks with the roof plates so as to permit longitudinal movement thereof but to prevent their vertical movement, was found patentable over a basic reference which showed all but the interlock feature, taken in connection with another reference disclosing an interlock between adjacent roof plates but in which the roof plates were not longitudinally movable and there was no suggestion of the modification of the basic structure.

### Disclosures in Application.

George R. Joughins and Eva Maude Joughins for themselves.

Appeal from Examiners-in-Chief.

The full text of the decision of First Assistant Commissioner Kinnan follows:

The applicant has appealed from the decision of the Examiners-in-Chief affirming that of the primary Examiner denying patentability to claims 3, 4, 5, 6 and 8. Claim 3 will serve for illustrative purposes and is as follows:

"3. In a flexible metal plate-car-roof, the combination of a skeleton roof-frame including side and end plates, carlines and purlins, of longitudinally disposed roofing plates, means for weatherproofing them at the ridge and eaves and having portions of said plates tucked in underneath portions of the purlins to prevent vertical displacement of said plates with reference to the purlins but allow relative flexibility thereto in a horizontal direction."

The references are: McCarthy, 1067535, July 15, 1913; Kane, 1260391, March 26, 1918; Mullett, 168277, September 28, 1875.

The application discloses a car roof in which there is provided a combined ridge pole and ridge cover, which is riveted to the carlines as shown in Fig. 4 and to which the running board is fastened. This member has inwardly curved ends which interlock with the roof plates 2 and 3, as shown in Figure 1. The other end of the plate 2 interlocks with the eaves strip 7. The other end of the plate 3 interlocks with a similar plate 4, which extends to the eaves and interlocks with the strip, and also with a member extending from the purlin 6. The effect of this is to allow longitudinal movement of the roof plates, but to prevent any vertical movement, since the interlocking of the two plates 3 and 4 is under the extension E of the purlin, as is shown clearly in Figure 5.

The basic reference relied upon is the patent to McCarthy. This patent does not show a combined ridge pole and ridge cover, since the member 30 is the ridge pole and the cover 36 is one of the roof plates extending from the purlin 24 on the right of Figure 12 to the purlin 24 on the left thereof. The roof plates 46 are interlocked with the central member 36 and with the side members 49, which extend over and are fastened to the eaves, but do not interlock with an eaves strip. Bolts 50 are provided, which extend through slots in the overhanging portion of the members 49. By reason of this slot and bolt connection there is a certain longitudinal movement of the plates 49. There is no extension, however, of the purlin, which extends over the interlocking portions of the roof plates.

The tribunals below have held that in view of the construction in the patent to Mullett there would be no invention in providing such an interlocking member on the purlins of McCarthy.

The patent to Mullett discloses a roof, obviously not a car roof, having cleats embedded in concrete, which cleats have members extending into the interlock between adjacent roof plates. There was obviously no reason for any longitudinal movement of these roof plates in this roof structure and it is not seen that these would suggest modification of the structure of the McCarthy patent.

### Ridge Pole and Cover.

In view of the above statement, it would seem that claims 3, 4 and 5 are allowable.

Claims 6 and 8 relate to the combination ridge pole and ridge cover.

The Examiner and the Examiners-in-Chief, held that claim 6 was anticipated by McCarthy on the ground the member 36 is the so-called combination ridge pole

and ridge cover. It would appear, however, that the ridge pole in the McCarthy structure is the member 30 and that the member 36 does not perform the function of the applicant's member 1; also, that applicant has a simpler structure and one not suggested by the McCarthy patent. It is believed claim 6 is patentable.

Claim 8 would seem to be not patentable over the art, since it depends for its patentability merely upon the fact that projecting studs are provided in the ridge pole and ridge cover, as shown in Figure 4, to which the brackets for the attachment of the running board are fastened.

The decision of the Examiners-in-Chief is affirmed as to claim 8 and reversed as to claims 3, 4, 5 and 6.

# *Patent Not Voided by Improvement*

EX PARTE CLAWSON. APPEAL NO. 1439, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1702892 was issued February 19, 1929, to Albert E. Clawson for a recording and controlling mechanism, on application No. 25253, filed April 15, 1925.

The rejection of claims 1 to 3, for a temperature recording apparatus, was reversed by the Board of Appeals.

The decision states appellant was the common assignee of two cases which were filed in the Patent Office on the same day, an improvement patent had been taken out on one of the applications and the other application had been rejected on the issued case as prior art.

**Temperature Recording Apparatus.**

The Board stated that the granting of a patent for the improvement could not deprive appellant of adequate protection for his other invention. This case is distinguished from Ex parte Dunbar, 1922 C. D. 105, in which the same invention was claimed in both applications.

Alfred Burger for appellant.

The full text of the opinion of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Ruckman and Landers) follows:

This is an appeal from the action of the Examiner finally rejecting claims 1 and 3. Claim 1 is illustrative and is as follows:

"1. In recording apparatus having a record chart holder, a motor for rotating the chart holder and a casing enclosing the same, the combination of an element movable through the casing and means disposed on the record chart holder for cooperation with said element to effect movement thereof."

The references relied upon are: Pineau, 1262976, April 16, 1918; Olson, 1634205, June 28, 1927.

Appellant's device comprises a temperature recording apparatus having a record chart holder in the form of a disc. This holder is enclosed in a casing and it is rotated by a time mechanism or clock. The peripheral edge of the holder is provided with cam members which engage and operate valve opening plungers extending through the casing.

The claims stand rejected on the patent to Olson. Olson's device is of the same general character as appellant's. It is specifically different however and the claims therein are drawn to the features peculiar to Olson's construction. The Olson application and the instant application were filed on the same day.

Since both were owned by the same assignee the Examiner deems Olson a reference for the reason that the claims on appeal are readable on Olson and that by taking out the Olson patent with the more limited claims the assignee has forfeited his right to the broad subject matter. In support of this position the Examiner relies on the decisions In re Dunbar, 1922 C. D. 105, and Haight v. Nell, 1927 C. D. 4.

We believe the Examiner's position cannot be sustained. In the Dunbar case both Dyson and Dunbar were claiming the same invention. The assignee took out the Dyson patent with claims readable on Dunbar and then attempted to secure broader claims to the same subject matter in the Dunbar application. In Haight v. Nell certain claims were held unpatentable in the Ditson application because they sought to cover the same subject matter which Ditson and another, Peters, had already patented.

**Restriction of Claims.**

In the instant case Olson has restricted his claims to the specific improvement made by him. Not being the inventor of the broad subject matter he was not entitled to the claims on appeal. We fail to see how the granting of a patent to Olson for his improvement can de-

prive appellant of adequate protection for the invention which he has made.

The claims have also been rejected on the patent to Pineau. This patent discloses a valve operating rod extending through a casing and a lever and cam within the casing for operating the rod. It does not disclose, however, a record chart holder nor the combination of such holder with cam elements. We believe Pineau is not pertinent to the claims on appeal.

The decision of the Examiner is reversed.

# Court Ruling on Failure to Disclaim

BANKERS UTILITIES COMPANY, INC., ET AL. V. INTERSTATE TRUST COMPANY. EQUITY NO. 45-376, DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK.

THE defendant's motion to dismiss the suit based upon plaintiff's failure to enter a disclaimer in his patent as to certain claims in view of the decision of the Circuit Court of Appeals sustaining the validity of claim 6, and stating that "in so far as the other claims may be construed to be of broader scope they are held to be void," was denied on the ground that the quoted statement did not constitute a judicial determination that the claims were invalid.

The court stated that had that decision finally adjudicated the invalidity of the claims other than claim 6, plaintiff's delay in filing a disclaimer would have defeated this suit.

### An Irregular Procedure.

Single & Single, attorneys for plaintiffs (William T. Rutherford, of counsel). Hays, Hershfield & Wolf, attorneys for defendant (Harold P. Seligson, of counsel).

The full text of the decision of the court, delivered by Judge Thacher, follows:

The defense of unreasonable neglect and delay to enter a disclaimer as required by Sec. 4922 R. S. does not arise upon the face of the bill. No answer to the bill has yet been filed. Defendant has appended to its motion to dismiss a statement of facts signed by counsel. These facts are largely a matter of record and are disclosed by reported decisions, of which the Court may take judicial notice, and by the file wrapper and contents of which a certified copy has been submitted without objection in support of this motion.

Although the procedure followed is irregular and no authority is to be found for it in the rules (see Supreme Court Rule 29), inasmuch as the parties are in agreement on the facts and the plaintiff has not objected to the propriety of the motion but has argued the merits, the Court is, I think, justified in determining the question presented as if the motion were in fact an answer and the question had been called up for hearing separately under Equity Rule 29. (See Ensten v. Rich-Sampliner Co., 13 Fed. 2d 132.)

The defense rests upon failure to disclaim after decision of the Circuit Court of Appeals of the Ninth Circuit in Bankers Utilities Co., Inc., v. Pacific National Bank, 10 Fed. 2d. 16, where the Court sustained the validity of Claim 6, and added: "In so far as the other claims may be construed to be of broader scope they are held to be void." If this decision could be regarded as having finally adjudicated the invalidity of the claims other than Claim 6, I should have no doubt that plaintiff's delay in filing a disclaimer would defeat this suit (Minerals Separation v. Butte & Mining Co., 250 U. S. 336, 364).

The decision cannot be given this effect because the Court did not construe the claims other than Claim 6, and subsequently in the same case refused to pass on the question whether these other claims were by its decision held to be totally void or void only in part (Bankers Utilities Co. Inc. v. 22 Fed. 2d. 680).

### Responsibility for Delay.

Until there has been a judicial determination that the claims are invalid the plaintiff is entitled to rely upon the presumption of their validity arising upon issue of the patent and is not chargeable with unreasonable neglect or delay in entering a disclaimer (O'Reilly v. Morse, 15 How. 62, 121; Seymour v. McCormick, 19 How. 96, 106; Gage v. Herring, 107 U. S. 640, 646; Page Mach. Co. v. Dow, Jones & Co., 168 Fed. 703, C. C. A. 2d).

Accordingly the motion to dismiss the bill is denied.

February 18, 1929.

## MARCH 16

# *Combination of Old Principles Promoting Catalytic Reactions*

THE BARRETT COMPANY v. THE SELDEN COMPANY. EQUITY No. 1781, DISTRICT COURT FOR THE WESTERN DISTRICT OF PENNSYLVANIA.

PATENTEE'S apparatus for promoting catalytic reactions, having for an object the creation of phthalic anhydride by partial oxidation of naphthalene in the presence of a catalyst, and the distinctive feature of the apparatus residing in control for the temperatures of the catalytic reactions, which are required to be high and to be confined with very narrow limits to make the process a success, was held not to be anticipated by the prior art.

### A New and Valuable Result.

Upon a finding that the patentee used materials and principles well known to those versed in chemical reactions, but that he combined them in such a way that a new and valuable result was obtained, as evidenced by the fact that the apparatus was completed only after numerous experiments and long pursuits of the basic ideas, and that defendant replaced his apparatus with the type of device covered by the patent, the court ruled that the validity of the patent was established, and that since defendant's converter embodied the essential ideas of plaintiff's patent it constituted an infringement.

Patent No. 1604739, including 31 claims, the court held to be valid and infringed.

The full text of the opinion of the court, delivered by Judge Gibson, follows:

Plaintiff's bill charges the defendant with infringement of a certain patent owned by plaintiff, and prays injunctive relief and an accounting.

The patent in question was No. 1804739, for an improvement in apparatus for promoting catalytic reactions, which had been issued to Charles R. Downs on October 26, 1926. The application therefor had been filed on December 5, 1921.

The main object of the patentee was, by means of his device, to keep under control the temperatures of catalytic reactions, such as the creation of phthalic anhydride by the partial oxidation of naphthalene in the peresence of a catalyst. Reactions of this nature occur only when the catalyst and organic substance passed over or through it are heated to a high degree, and are successful only if the temperatures of the reactions are confined within very narrow limits.

If the catalyst and contact material are insufficiently heated, the reaction either does not take place at all or the product is inferior. On the other hand, if the materials are of the temperature favorable to a proper reaction, great care must be taken to dissipate the surplus heat created in the process itself, as otherwise the catalyst will be fused, and the material passing over it will be entirely destroyed instead of being partially oxidized, as desired. The patented converter was designed to solve this problem in commercial manufacture.

By the patent drawings and specifications is disclosed, among other forms, a vessel similar in shape to the ordinary steam boiler. From the bottom of an entrance chamber for the materials of the reaction, at the top of the vessel, to the top of the cone-shaped bottom, a large number of ¾ inch square tubes are placed, the tubes being open at top and bottom. At the lower end a wire screen is placed, its function being to hold the catalyst which is placed in, but only partly fills, the tubes.

### The Soul of the Device.

Each of these tubes is separated from each of its immediate neighbors by a very small space. Surrounding them, to a height just a little greater than that of the catalyst, is a bath of mercury, or similar liquid. Connected with the boiler-shaped part of the device is an air-pressure system by which the normal atmospheric pressure upon the mercury may be either raised or lowered, thus enabling the normal boiling point of the surrounding liquid to be either raised or lowered. Attached to the boiler part of the device, also, is a reflux condenser. An external heater has been provided for the purpose of heating the liquid to the reactive temperature at the start of the operation.

The soul of the device is the well known physical fact that liquids absorb latent heat without change in temperature after they have reached the boiling

point. At the time the problem of the patentee was in process of solution, he was chiefly interested in improving the method of manufacturing phthalic anhydride, and his invention, as presented in the patent application, is most specifically applicable to the production of that article, and its workings are well shown in its manufacture.

The temperature at which the phthalic reaction takes place is slightly higher than 357 degrees C., the boiling point of mercury. Mercury was therefore adopted in its manufacture as the liquid surrounding the catalyst tubes. After the liquid bath has been heated to the boiling temperature, and the catalyst also, a mixture of vaporized naphthalene and air, prepared outside the converter, is introduced under pressure into the entrance chamber at the top of the converter. The pressure upon the mixture forces it uniformly through the catalyzer tubes.

The vapor has been heated somewhat prior to introduction into the converter, and in its passage through the tubes is further heated by the mercury vapor and is of the temperature of the reaction when it reaches the catalyst (a substance which, for some unknown reason, upon contact, initiates the reaction without entering into its result or losing its own form in any material respect.) As the vapor is forced through the catalyst at the proper temperature, a great quantity of heat is created, but, owing to the intimate heat-interchanging relation between the catalyst and the mercury, the boiling mercury absorbs the excess heat without raising its temperature, and the naphthalene mixture, passing through the catalyst, is oxidized to the extent desired and is deposited in the conical bottom part of the converter in the form of phthalic anhydride crystals.

### Grouping the Claims.

The mecury vapor, which rose from the boiling mercury and heated the entering reaction material, rising to the reflux condenser, is condensed and is returned to the body of the bath at practically the same temperature as the boiling mercury. After the bath has been heated to the proper temperature, the reaction is practically continuous and automatic. To get the best results, particularly after the catalyst has been in use for some time, increase of the boiling point of the mercury by pressure is necessary.

The 31 claims of the patent may be divided into four groups: First, those broad claims which set out a two-phase liquid-vapor system for regulating the temperature in a catalytic chamber, and which do not specify the liquid to be used nor any means for varying its boiling point by pressure or vacuum; second, those claims which include, in addition to the features just mentioned, a change in the normal boiling point of the liquid by means of pressure upon the liquid; third, those which specify mercury as the liquid to be used; and fourth, that one claim which sets forth a specific proportion between the cubic bulk of the catalyst and the surface of the surrounding liquid. It will be noted, also, that some of the claims set forth means for condensing the vapor from the boiling liquid and returning it so condensed to the body of the boiling liquid, while other claims do not assert the use of such means.

We quote one claim from each group:

"2. A catalytic apparatus comprising a catalytic chamber and a two-phase liquid-vapor temperature regulating system for regulating the temperature in said catalytic chamber whereby the desired chemical reactions may be promoted, and means for condensing and returning liquid vaporized in said system."

"7. A catalytic apparatus comprising a catalytic chamber, a two-phase liquid-vapor temperature regulating system for regulating the temperature in said catalytic chamber of the apparatus whereby the desired chemical reactions may be promoted, means for condensing and returning the liquid vaporized in said system, and means for regulating the pressure and thereby the boiling point of the liquid in said system."

"23. A catalytic apparatus for carrying out exothermic gas phase catalytic oxidation reactions of organic compounds, comprising a catalyzer chamber or compartment containing a catalyst adapted for such oxidation reactions, a temperature regulating system having a liquid-containing compartment in heat interchanging relation with the catalyst in the catalyzer chamber whereby the desired chemical reactions may be promoted, and a definite quantity of liquid mercury circulating in a closed circuit in such system, whereby the heat of the exothermic action is absorbed by the boiling of the mercury at a temperature approximating that of the catalytic reaction."

"20. A catalytic apparatus comprising a catalyzer chamber or compartment, a two-phase liquid-vapor temperature regulating system with its liquid-phase in heat interchanging relation with the catalyst in said chamber, and such sys-

tem being so distributed with respect to the catalyst that all of the parts of the catalyst are subjected to the temperature regulating influence of the same, and the ratio of the surface of the liquid-phase of the system to catalyst bulk being such that more than three square inches of surface are represented for each cubic inch of catalyst bulk."

The evidence of the instant case plainly shows that defendant's converter, in use at the institution of the action, is exactly covered by the claims of the Downs patent. An examination of the drawing of its converter submitted by defendant, in connection with the patent drawings, will disclose that the two converters are substantially identical. As a matter of fact, the testimony shows, defendant's construction was copied from that of the plaintiff.

When plaintiff's converter was first built and operated in the plant of the plaintiff company, Frank A. Canon, a chemical engineer, was in its employ and had full knowledge of the plan and operation of its new converter. In the latter part of 1921 the plaintiff reduced the number of its employes in its Research Department, and, among others, allowed Mr. Canon to go. He sought employment from several chemical manufacturers, and was employed by the defendant company about November 10, 1921, about 10 days after he ceased to be employed by plaintiff.

He immediately began to draw a plan for a converter, based upon his knowledge of the Barrett Company construction. About the only change made was from a square to a round boiler form, which latter form, however, is shown in the patent drawings, and has been also adopted by plaintiff in building its later converters. The defendant proceeded to build a number of converters in accordance with Mr. Canon's plans. It is fair to the plaintiff and Mr. Canon to state that the application for the patent in suit was not filed for more than a month after Canon left the plaintiff's employ, and that when he so left he had the impression, obtained from some of his superiors, that no application would be made; and the testimony does not disclose any knowledge of the patent on the part of defendant until notice of infringement was given it shortly prior to suit.

Defendant operated the converters built under Canon's direction until shortly after the beginning of this action, when it made several modifications. It now uses an alloy of mercury which boils at a somewhat higher temperature than mercury, and finds it unnecessary to use air pressure upon the boiling liquid. In its later converters it has inserted round catalyst tubes of the same size instead of square tubes. It was enabled to do this by reason of its alloy bath being much cheaper than mercury. The only function of the square tubes, as compared to round, was in the fact that their use lessened the amount of expensive mercury which was necessary. The essential ideas of plaintiff's patent have all been included in defendant's converter.

### The Question of Validity.

Infringement of plaintiff's patent by defendant's converter may be determined without difficulty; but quite different is the solution of the vexed question as to the validity of the patent. Examination of the prior related art, as it appears in defendant's evidence, seems to make it plain that in no one feature of plaintiff's patented device is anything new presented. All the physical and chemical principles involved were well known prior to the application for the patent.

No claim has been made, or could have been, to the discovery of the method of producing phthalic anhydride by the partial oxidation of naphthalene vapor in the presence of a catalyst. That liquids absorb latent heat without change in temperature after they have reached the boiling point, was long known. The regulation of heat and maintenance of a constant temperature by means of a boiling bath was far from new; and the utility of mercury as the liquid to be so used was recognized.

It was long known, too, that the boiling point of the liquid bath could be considerably raised or lowered by increasing or decreasing the air pressure upon the bath. And just as well known was the function of the condenser-attachment to plaintiff's converter. The attenuated catalyst tubes of the plaintiff's converter present a feature essential to its effectiveness, but no claim of invention has been, or well could be, based upon this feature.

One claim of the patent (No. 20) specifies that for each cubic inch of catalyst the liquid bath shall present more than three square inches of surface. This provision would require either attenuated tubes or a large bath surface. If we consider those narrow claims of the patent which specify mercury as the liquid of the boiling bath, the items of weight and expense would necessitate small tubes for the catalyst.

Even though we should read the element of tube size into the patent claim,

however, it would present nothing undisclosed in the prior art. In the Lane British and French patents (offered as throwing light upon the prior art) which describe a boiling bath converter for use in catalytic reactions, the patentee specifies catalyst tubes "not exceeding 2-in. in diameter," and as a reason for this limitation, states that heat cannot accumulate in the attenuated catalyst tubes to any injurious extent.

In several of the claims, No. 10, for example, the patentee has stressed the use of the vapor from the boiling liquid to heat the entering reaction mixture to the temperature of the reaction. This feature is new, at least to the extent that no prior inventor has mentioned it as an important part of his device but we may be pardoned, we trust, for speculating as to just how much of invention is found in such use. The entering gas, before it reaches the catalyst, in exothermic reactions, is heated, in large part, by the heat thrown off by the catalyst.

### The Status of the Prior Art.

Several patentees, prior to Downs, have only partly filled their catalyst tubes, to make use of such heat; and if additional heat were required, an increase in the height of the liquid bath would produce the same result as the rising vapor. However, this increase in the height of the bath would doubtless be impracticable where the liquid used was boiling mercury or other like molten material.

Each of the individual features of the Downs patent appears in the prior art. Certain patents or printed articles disclose devices which combine several of such features. The defendant has pleaded, as anticipations of the Downs converter patent, Conover Patent No. 1324443, an article in book by Franz Wilhelm Henle, Edition of 1909, and French Patent No. 520464, granted to Georges Claude, on February 15, 1921. The Conover, Henle and Claude devices, the plaintiff contends, each set forth all the essential features of the Downs construction.

The Claude Patent was rejected by the Court upon trial on the ground that it could not be considered an anticipation, as the Downs converter had been in actual commercial use long prior to the publication of the Claude patent. It provides a liquid bath of a high boiling point, in common with the Downs device, but is designed for the production of very small quantities of the reaction product, and except for its bath has little resemblance to the Downs patent.

The Conover Patent, No. 1324443, for which application was made on April 30, 1919, upon merely casual examination, seems to present the basic ideas applied in plaintiff's structure. It presents a number of horizontal catalyst chambers, entrance to which by the material of the reaction is through an entrance chamber. The reaction chambers are surrounded by liquid-containing chambers which belong to a circulating system in which are condensers and cooling reservoirs. The liquid, passing through its chambers, is heated and, upon boiling, gives off vapors which pass to the condenser, and thereupon are returned, as cooled liquid, to the liquid jackets surrounding the reaction chamber.

From a merely verbal description of Conover's patented device, it would seem that it was designed to operate along very similar lines to those of the Downs converter, with the exception that no means is provided to raise or lower the boiling point of the circulating liquid. An examination of the drawings of the Conover patent, and a careful reading of the specifications, will make it plain that Conover did not have in mind the features which made Downs' converter a success.

### Narrow Limits of Temperature.

Downs desired to maintain the temperature, without change, within the narrow limits necessary for the success of the continuous reaction. He brought this about by absorbing the heat of the catalyst in the boiling liquid, while heating the incoming reaction material with the vapor thrown off, and then condensing the vapor and returning it to the bath in the form of liquid at its approximate boiling point. Conover appears to have had in mind only the cooling of the catalyst, and not the automatic confinement of the temperature within the narrow limits necessary to the success of the reaction, as did Downs. He contemplated a circulation of the liquid by which the hot liquid and vapor in the liquid chamber were replaced by the cooled liquid.

In other words, Conover had in mind the limitation of the maximum temperature, while Downs regulated both the maximum and the minimum. Conover's conception was entirely mental, and never has been put upon trial by any attempt to follow out his idea by the construction of a commercial converter based thereon. We are therefore confined to the specifica-

tions of his patent both for our conception of the scope of the patentee's idea, and our impressions as to the practicability of his proposed construction.

The patent plainly does not disclose the automatic heat regulation of the Downs converter. The drawings make it quite plain that the inventor did not contemplate the use of mercury, or like material, as the liquid surrounding the catalyst chamber, and without some such material, having a boiling point close to the temperature of the reaction, the results of the Downs converter, at least so far as the production of phthalic anhydride is concerned, are not attainable.

The Conover patent does not, we think, set forth all of the essential features of the Downs patent, or an operative invention; but even if we should have reached a contrary conclusion, we should feel compelled to reject it as an anticipation. The application of Conover was filed on April 30, 1919, and the Downs application not until December 5, 1921, but the testimony establishes the fact that Downs had conceived the essential features of his invention prior to Conover's application and constructive reduction to practice of his converter. On January 31, 1919, he dictated a description of his proposed converter which contains all the essential ideas of his ultimate construction. In his mental conception, however, he contemplated putting mercury grids at intervals throughout the catalyst—that is, the catalyst surrounded the mercury tubes, as in the patent construction.

### Unsatisfactory Results.

Some phthalic anhydride was made from converters made pursuant to this original idea, but the results were not entirely satisfactory, and continuous labor and experiment finally resulted in the present form of converter, which, despite the transposition of the mercury and the catalyst, is the direct and natural outgrowth of the original conception dictated in January, 1919.

The Henle article, cited as an anticipation, discloses a laboratory apparatus wherein a reaction mixture is passed through a single catalyst cartridge, the resultant product of the operation described being hexahydrobenzol. The cartridge is placed in a Volhard petroleum furnace, a small copper cylindrical boiler, wherein was a copper tube which contained an iron tube that, in turn, contained the glass tube which held the catalyst. The copper boiler contained an oil bath, which, in the experiment described, was heated to a temperature of 195 degrees. The apparatus was supplied with condenser tubes. The boiler was continuously heated by a gas flame during the reaction.

The Henle article, describing the production of a small quantity of hexahydrobenzol, makes no mention of the absorption of any excess heat. We may possibly assume that the reaction was exothermic by reason of the use of condenser tubes, although the function of such tubes may have been to preserve the amount of boiling kerosene in the boiler rather than dissipate the heat. The latter theory is supported by the fact that the Henle apparatus disclosed no means for the rapid transmission of heat from the catalyst to the kerosene bath.

The catalyst was in a glass tube which was contained in another tube of iron. An air space separated the iron tube from one of copper, which was in contact with the kerosene bath. Under such an arrangement, the heat would be very slowly transmitted from the catalyst to the bath, and this fact would seem to indicate that the heated kerosene bath was used only to supply needed heat to the reaction.

Whatever the purpose, it is plain that Henle, in his single laboratory tube, did not have the problem which confronted Downs in his manufacture of phthalic acid in commercial quantities. In the first place, Henle's reaction, if exothermic to any extent, was not accompanied by the high temperatures incident to the contact of naphthalene vapor with the catalyst, nor did Henle have Downs' problem of maintaining within narrow limits the high temperature of the reaction by absorbing the very great heat thrown off by a thousand catalyst tubes and at the same time heating the naphthalene vapor on its way to the catalyst.

True, the multiplication of the elements of an apparatus, each complete in itself, ordinarily does not constitute invention; but the multiplication in the Downs converter was necessary to commercial success, and presented a problem in temperature regulation quite different from that which faces the constructor of a mere laboratory device.

### The Points of Difference.

Passing over the distinction between laboratory and commercial structure, however, the Henle apparatus has little in common with the Downs converter It is a device used in a continuing catalytic reaction, as is the Downs structure, but the operation is made continuous in the Henle apparatus by the continued application to the boiler of the

heat which first raised the kerosene bath to the temperature of the reaction, while in the Downs converter, after the mercury and catalyst have been raised to the temperature of the reaction, the heat created by the reaction itself keeps the mercury at its boiling point and automatically continues the operation, wherein the boiling mercury acts both as a heating and cooling means.

The heating of the reaction mixture prior to contact with the catalyst—an important feature of the Downs patent—is missing in the Henle apparatus. Not to continue the enumeration of points of difference, in our judgment, no chemical engineer in 1909 (the approximate date of the Henle article), without the exercise of invention, would have been able to construct any commercial apparatus for highly exothermic catalytic reactions which was based upon the principles of the Downs converter.

As previously stated, no individual feature of the patent in suit represents a discovery in physics or chemistry. It does not follow, however, that because the designer of the patented converter has used materials and principles well known to those versed in chemical reactions, his construction is devoid of invention. Old elements may be combined in such a way that a new and valuable result is obtained.

The patentee in the instant suit made no startling discovery in chemistry, but he did produce a converter which was new, and which vastly increased the ability to manufacture phthalic anhydride. The facts established by the testimony are sufficient, it would seem, to overcome defendant's contention that the plaintiff's device was the result of only ordinary chemical engineering skill. The patentee, Downs, was an experienced chemical engineer engaged in research work. He completed his converter only after numerous experiments and long pursuit of his basic ideas. The defendant had in its organization able chemical engineers, one of them Mr. Conover, the inventor of a converter which is alleged to have anticipated Downs. These engineers had not been able to build a converter which compared in efficiency with that of Downs prior to the time when the latter put his device into actual use.

### Valuable in the Art.

At least, prior to Downs, the defendant used a form of converter by which it produced 70 to 75 pounds of phthalic acid per day from each converter; and upon becoming acquainted with Downs form, it promptly replaced its type of converter with the new form, and thereafter was able to produce 750 to 800 pounds of greatly improved quality. In view of defendant's adoption of plaintiff's device, and the results of that action, seemingly it is not in a position to deny that Dr. Downs produced a converter that was both novel and valuable in the art.

We find the plaintiffs' patent to be valid, and infringed. Let a decree be drawn in accordance to such finding.

February, 1929.

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# *A New Assembly of Carbon Sheets*

EX PARTE LENTZ. FIRST ASSISTANT COMMISSIONER OF PATENTS.

PATENT No. 1702834 was issued February 19, 1929, to Laurence E. Lentz for carbon sets or piles, on application No. 114273, filed June 7, 1926.

Upon a finding that a roll of carbon papers with coatings of graduated relative hardness, whereby the transferring capacity of the sheets increases relatively through the assembly, consituted an article of manufacture, claims 18 and 19, covering such an article, were indicated as allowable.

The appeal as to claims 2 to 17, rejected as not comprising proper subject matter for a patent in that they were neither for an art, machine, manufacture, or composition of matter, was dismissed.

L. G. Julihn for applicant.

Appeal from Examiners-in-Chief.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

The applicant has appealed from the decision of the examiners-in-chief, affirming that of the primary examiner, denying patentability to claims 2 to 17, inclusive.

In a supplementary brief filed September 8, 1927, the applicant proposes to substitute for all of the appealed claims, two claims which are numbered 18 and 19, and they will be considered in view of those which were before the tribunals below.

These substitute claims are as follows:

"18. As an article of manufacture, a manifolding assembly of carbon sheets, the carbon coatings of which are of

graduated relative hardness, whereby the transferring capacity of the sheets increases relatively through the assembly.

"19. As an article of manufacture, a manifolding assembly of carbon sheets of graduated weights having carbon coatings of correspondingly graduated hardness whereby the relative durability of the sheets and the relative transferring capacity thereof is oppositely graduated through the assembly."

The examiner has cited no references and states that there are none "relating to this idea." He further states that the claims are rejected as "being aggregative and further as not comprising proper subject matter for a patent." The examiner held the "applicant's device is neither an art, machine, manufacture, nor composition of matter, and therefore does not fall within the statutory class of invention."

The examiner notes that carbon sheets of varying weights of stock having varying hardness upon them are old in the art, and this is not denied by the applicant. In view of these facts, the examiner held that any person could obtain these articles and arrange them to suit any particular need. It is not shown, however, that any one has, prior to applicant's activities, ever obtained these carbon papers of varying weights of stock and varying hardness and assembled them in the manner set forth in the application.

The examiners-in-chief deemed claim 1, which sets forth the method of assembling the sheets, patentable. As to the other claims, that tribunal stated them to be "drawn to a set or pile of carbon sheets which we understand are to be made up by the operator in any desired manner at the time of use." It was further held that while it was "conceivable that stacks or piles of carbon sheets might be made up and sold as articles of commerce but we find no disclosure of this character in the specfication." Upon this interpretation of the specification, the examiners-in-chief held that these sheets, to be assembled in a described order as used, would not constitute a "manufacture" under the statute, and noted the holding in In re Campbell, 1872 C. D. 228, 2 O. G. 644.

If the conclusion of the examiners-in-chief as to the disclosure of the specification is correct, their view that these sheets do not constitute any articles of manufacture within the meaning of the patent statutes is proper. The drawing is somewhat misleading since it fails to show a complete article of manufacture. The specification, however, states that "the invention relates to improved carbon roll, set or pile and to the method for producing the same." The object of the invention is stated to be to increase "the average durability and manifolding qualities of the carbon sheets of a set, pile or roll of carbons to be used in manifolding." Another object is stated to be "to reduce the manufacture of a carbon set, regardless of form, to a comprehensive method of procedure." In the supplementary brief filed by counsel, it is urged that the specification was intended to describe the assembled set of carbon sheets in a commercial article which, as such, is sold ready for use in manifolding machines. Counsel states as to the carbon roll that "enough of them are sold by the applicant's assignee alone to equip in a single year several million dollars worth of manifolding machines."

While the disclosure could have been made clearer as to the production of a complete roll as a commercial product, yet it is believed it sustains the interpretation put upon it by counsel that the roll is to be sold as an article of manufacture. With this view, it would seem the two proposed claims should be allowed. In the absence of any references or other reasons than those of record, the examiner will allow these claims.

The appeal as to claims 2 to 17 is dismissed, and the two claims 18 and 19 are allowable, provided they are presented in a suitable amendment within 30 days from this decision.

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# *Locking Device on Mining Machines*

EX PARTE HOLMES. APPEAL NO. 593, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1702828 was issued February 19, 1929, to Morris P. Holmes for Mining Machines, on application No. 607536, filed December 18, 1922.

A square blade locking means used in a carpenter's square was held to be an anticipation of a locking device for a cutter bar in a mining machine, it being stated that a locking device is a feature which is useful in a great variety of arts and can not be said to belong either to the art of carpenter's squares or to that of mining machines. The rejection of claims 1 and 9 was affirmed.

Louis A. Maxson for applicant.

The full text of the opinion of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Skinner and Ruckman) follows:

This is an appeal from the final rejection of Claims 1 to 12, inclusive, and 21. Claims 1 and 9 are illustrative and read as follows:

"1. The combination with a mining machine having a frame and a swingable cutter bar thereon, of bar-locking means rotatable without longitudinal movement on an axis parallel to the axis of bar-swing to effect locking of the bar to said frame.

"9. The combination with a mining machine having a frame and a swingable cutter bar thereon, of bar-locking means including a locking pin rotatable on its longitudinal axis and having a cut-away portion and a body portion movable into locking engagement with said frame."

The references relied upon are: Lippis, No. 862832, August 6, 1907; Post, No. 870584, November 12, 1907.

The patent to Lippis discloses a cutter bar swinging on a vertical pivot and a locking device, 39, for engaging notches 40, 41, in the support to lock the cutter bar in different positions. The brief, at considerable length, points out the differences between the locking device of the reference and that of his own machine, but this is irrelevant, as the ground of rejection is that there is no invention in substituting the locking device of Post for that of Lippis.

The brief contends that a carpenters' square shown by Post is from a non-analogous art and that there is no suggestion of how Post's square blade-locking means could be applied to a mining machine without radical change in the Lippis structure and also the structure of Post. A locking device is a feature which is useful in a great variety of arts and cannot be said to belong either to the art of carpenters' squares or to that of mining machines. If it is of the same construction and operates in the same way, it is a pertinent reference. We see no difficulty in using the locking device of Post in the Lippis mining machine. The bolt will have to be enlarged to secure the necessary strength, and the only modification necessary in the mining machine would be to make the shape of the notches conform to that in the Post device.

The decision of the examiner is affirmed.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

# *Apparatus for Resurfacing Roads*

EX PARTE OWENS ET AL. APPEAL NO. 1056, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1702546 was issued February 19, 1929, to Peter J. Owens and George B. Maloney for a pavement resurfacer, on application No. 731340, filed August 11, 1924.

Appellant's device for heating the surface of asphalt roadways including a cover of relatively long and narrow dimensions so that when placed crosswise of the street its length covers the desired width of paving and when placed lengthwise on the vehicle it is easily carried through traffic, together with the means for positioning and handling it, was held to be patentable in that these features were not present in the prior art. The rejection of claims 2 and 3 was reversed.

Wright & Chunn and E. H. Bond for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Henry and Redrow) follows:

This is an appeal from the rejection of claims 2 and 3. Claim 3 is representative and reads as follows:

"3. The combination with a vehicle, of a pavement surface heater furnace, a fuel supply on the vehicle, a flexible fuel feed connection between the supply and furnace, said furnace being of greater length than the width of the vehicle, a cradle on the vehicle adapted to support the furnace when the latter is in a position extending lengthwise of the vehicle, a track supported by the vehicle and extending rearwardly thereof, a carriage movable back and forth on the track and means of connection between the carriage, furnace and vehicle providing for rotation of the furnace in a horizontal plane and for movement of the furnace from position of rest in engagement with the cradle and vice versa."

The references are:

Dawson et al., 526300, Sept. 18, 1894;

Hynes et al., 678621, July 16, 1901, Lamb, 851011, April 23, 1907; O'Neale, 939538, Nov. 9, 1909; Mattson, 1025287, May 7, 1912; Allen, 1166305, Dec. 28, 1915; Chausse, 1215343, Feb. 13, 1917; Hendrickson, 1235472, July 31, 1917; Reynolds, 1337667, April 20, 1920.

The present application discloses a heater for heating the surface of asphalt roadways, of the type where a blast of flame and hot gases are confined beneath an inverted pan-like cover structure. The cover is usually made large enough to cover a substantial area of the roadway and as ordinarily made is very troublesome to transport from place to place.

Applicants' plan is intended to facilitate the handling and transportation of the cover and truck as a whole. It involves first making a cover of relatively long and narrow dimensions so that when placed crosswise of the street its length covers the desired width of paving and when placed on the vehicle with which it is associated or by which it is operated, it can be stored endwise of the vehicle and easily carried through traffic, together with the means for so positioning and handling it.

Each claim is limited to at least the above mentioned features. We have carefully examined the patents cited and find that they do not disclose this broad fundamental idea involved in applicants' device. They disclose heaters which may be merely raised to inoperative position and lowered to operative position. It is our opinion that the means for raising and turning the heater or cover together with the relatively long shape of it and arrangement of the truck to receive it lengthwise as claimed in the two claims are sufficiently cooperative features to be properly combined and since they are novel in this relation, should be allowed. We do not believe sufficient combination of the main features in one patent have been shown in order to warrant a combination of the several references from independent arts.

The decision of the examiner is reversed.

## MARCH 18

# *Folding Top for Automobiles With Wide Range of Handling*

WOLFE v. BEDFORD-CHEVROLET SALES CORPORATION. EQUITY No. 3476, DISTRICT COURT FOR THE EASTERN DISTRICT OF NEW YORK.

PATENT No. 1493814, containing a single specific claim directed to a foldable vehicle, one-man top, was held to be invalid because of anticipation and lack of patentable novelty.

The patent structure, consisting of main front and intermediate bows so interconnected as to enable the top to be easily extended or folded by a single operator on either seat or either side of the vehicle without excessively elevating or depressing any part of the covering during these operations, was found to be readable on the prior art devices, one of which was not considered during Patent Office prosecution.

Leonard Day, attorney for plaintiff; William G. McKnight and Drury W. Cooper, of counsel for defendant.

The full text of the opinion of the Court, delivered by Judge Campbell, follows:

This is an action in equity for relief by injunction and damages because of the alleged infringement by the defendant of United States Patent No. 1493814, issued to George H. Higgins, assignor to James Thruston Wolfe, the plaintiff, for Folding Top for Vehicles, dated May 13, 1924, on an application filed August 22, 1914.

### The Single Claim.

The single claim of the patent reads as follows:

"A foldable vehicle top comprising a main bow, a front bow, two-part jointed side arms projecting said front bow forwardly from said main bow, an intermediate bow pivoted to and extending from the rear parts of the said side arms upwardly and forwardly to the cover line, supporting links extending from the upper portion of the intermediate bow downwardly and forwardly to the front parts of the side arms and fulcruming links pivoted to and extending from the

upper portion of the main bow to the lower portion of the intermediate bow and pivoted to said intermediate bow between its connections with the supporting links and its connections with the side arms; all of said connections permitting, in shelter position, pivotal action of the parts connected; the parts of each of the side arms being deflected upwardly to the joints which connect them and said joints being limited in upward movement; the front bow being provided with means for holding it in shelter position and fulcruming upon its supporting links and said links by the position of their connections with the intermediate bow, developing a substantial rearward thrust on the front parts of the side arms, to assist in holding the side-arm joints in their elevated position and against downward breaking."

**Absence of Evidence.**

No evidence was offered by defendant to carry the date of invention back of August 22, 1914, the filing date.

The patent was not granted until nearly 10 years after the application was filed.

The defendant does not manufacture but does sell automobiles equipped with the top alleged to infringe.

The defendant contends that the patent in suit is invalid; that it is anticipated and is void for lack of patentable novelty.

The alleged invention relates to what are commonly known as "one-man extension tops," for use on touring cars, motorboats, and other vehicles.

The main object, as stated by the patentee in his specification, "is to enable such top to be easily and quickly extended or folded by a single operator on either seat or either side of the vehicle, without excessively elevating or depressing any part of the covering during these operations."

"Another object is to assemble the front and intermediate bows in such manner that when the main supporting bow is raised from its folded or clashed position to or beyond a substantially vertical position, the front and intermediate bows are automatically swung by their own weight toward the front for partially extending the top, thereby permitting the extension to be completed by the operator * * *".

"A further object is to deflect the toggle joints some distance above the plane of the toggle sections and to provide said toggle joints with stop shoulders wholly above the lower edges of said sections when the top is distended, so as to reduce the liability of flexing these joints downwardly by vibration of the car or other accidental causes."

Fig. 1 shows "a portion of an automobile body A and a flexible cover a having its rear end fastened in the usual manner to the rear end of the body A and its remaining portions attached at intervals to rear bows 1 and 2, a main bow 3, and front and intermediate bows 4 and 5."

The main bow 3 is properly so-called because it carries the entire weight of the entire structure.

"The front bow sockets 4′ are connected by toggle joints 7 to suitable toggle arms 8 which are pivoted at their rear ends at 9 to the upper ends of the main sockets 3."

**Provides Link Construction.**

To sustain these side arms the patentee provides his link construction, as follows: "The intermediate bow sockets 5′ are pivoted at 12 to approximately the central portions of the rear toggle sections 8;" and as other sustainting means, "the sockets 5′ are connected below their centers by tie pieces or links 13 to suitable extensions 14 on the upper ends of the main sockets 3′ above the pivots 9," and "the front sockets 4′ are pivotally connected to the front ends of links or tie pieces 15 having their rear ends pivotally connected to the intermediate sockets 5′ above the centers thereof."

It is obvious that in attempting to fold the top, the moving of the front bow 4 upwards upon its joint 7 will cause a rearward and upward movement of the intermediate bow 5, due to the lever action of link 15, and the rearward movement of the bow 5 will result in a downward thrust of toggle arm 8 because of the fulcruming action of bow 5 upon the lower end of link 13, bringing the top to the position shown in dotted lines in Fig. 1, and the folding may be completed by a further movement to the rear.

Plaintiff on the trial stressed the importance of the arch construction, the side arms and the toggle joint as sustaining means, but that does not seem to have been the view of Higgins, who as appears by the specification considered the "link construction fulcruming link 13, intermediate bow 5, and supporting link 15, as the main self-sustaining means" for the two-part side arms (specification, p. 2, lines 53-60,

113; p. 3, line 1; and p. 2, lines 24-39) where he says:

"Deflecting the toggle joint some distance above the intersections of the planes of the sections 4′ and 8 is desirable to establish a toggle lock capable of retaining itself in its locked position against downward displacement under vibration of the machine or other accidental causes which might tend to depress said joint and thereby break the lock and allow the toggle sections to sag; and in some instances it may also be desirable to support the front bow upon the upper edge of a wind-shield or dash 11, as shown in Figures 1 and 5, but these features only give greater stability to the top and may be dispensed with, without affecting the merits of this invention."

### No Exact Information.

In any event, the patentee does not give any exact information as to the elevation of the toggle joint as the specification says, p. 1, lines 38-40: "to deflect the toggle joints some distance above the plane of the toggle sections;" p. 2, lines 5-8: "The toggle joints 7 lie above a direct line between the front end of the bow 4 and pivots 9 when the top is extended;" and p. 2, lines 56-57: "with the slight upward offset of the toggle herein illustrated."

Such broad statements and indefinite and general directions of the specification make it proper to look at the drawing Fig. 1 of the patent in suit for additional aid, if any. Measurements were made of the height of the joint, and for the sake of comparison with other parts of the structure, measurements were made of the distance between the pivot of the toggle joint and the pivot of the intermediate bow on rear side arm, from Green patent, Wolfe Model, defendant's device, defendant's actual device, and Higgins patent in suit, with the result that the ratio of the height of the joint to the effective length of arm is as follows: Green patent, 2:12; Wolfe Model, defendant's device, 2:12; defendant's actual device, 1 1/2:12; and Higgins patent in suit, 1:12.

The use of a toggle joint was old and well known, one of the most common illustrations being found in the folding two-foot rule, and I believe that it was common to this art.

The course of the patent in suit through the Patent Office was not smooth, but the single claim of the patent in suit was allowed by the First Assistant Commissioner on an appeal from the decision of the Examiners-in-Chief.

The First Assistant Commissioner, in his opinion, said in part:

"The Golde reference is the most pertinent and the claim here under review defines from the construction in two particulars; the link e of Golde is, in appellant's arrangement, attached to the intermediate bow nearer its pivot and between such pivot and the connection to the intermediate bow of the link f of Golde, and the ends of the parts c and c2 of the front bow of Golde are, in appellant's arrangement, turned upward so the line of thrust is above the line of the front bow."

Because he believed these features to be meritorious and not disclosed in the prior art, he allowed the claim.

The Golde Patent, Green British Patent, and Freeman British Patent, were cited as references in the Patent Office, and while I recognize that there is a presumption that the Patent Office was right in determining that there was invention over the prior art considered by it, such presumption is not conclusive but rebuttable. Westinghouse Co. v. Formica Co., 266 U. S. 342, 348; Reckendorfer v. Faber, 92 U. S. 347; De Lamar v. De Lamar Min. Co., 110 Fed. 538, 539.

### Pertinent Reference Cited.

In the instant suit, however, a much more pertinent reference than even the Golde patent was introduced, that is, the article published January 2, 1914, in "Motor," showing a top designated "Golde Patent One-Man Top," and the text stating that "the manufacturer, The Golde Patent Mfg. Company, are putting out this top, which is the latest addition to this company's line," and is their "type 66;" and as that publication was not before the Patent Office but is in evidence here, the presumption is unavailing, as it does not extend beyond the record before the examiner. Westinghouse Co. v. Toledo Co., 172 Fed. 371, 392.

United States Patent No. 1034899, issued to Traugott Golde, for folding top for vehicles, dated August 6, 1912.

Using the designating names of the members of the patent in suit with the letters of the Golde patent, it is apparent that they read on each other:

Main bow A, two part side arms c2 and C with joint at c3, rear section side arm c2 pivoted to main bow a at c′, intermediate bow d pivoted to rear section side arm c2, supporting link e pivoted at e′ to intermediate bow d and at e2

to main bow a and link f pivoted to intermediate bow d at f' and to front section side arm C at f3.

The joint c3 operates upon a pivot which is elevated above a straight line between the front bow c and the pivot c1 and the arms c and c2 are provided with abutting edges to prevent upward deflection of the joint.

The fulcruming link e, intermediate bow d, and supporting link f are the link construction of the Golde patent.

The claim does not specify the location of the pivot points on ancillary bow d for struts f and e, and they might be shifted as in the patent in suit are the pivot points on intermediate bow 5 of supporting link 15 and fulcruming link 13. Either arrangement would embody the same "self sustaining function" and "easy shifting function." There would be no difference in kind, only in degree.

Article published January 2, 1914, in "Motor," shows an illustration of a top designated as "Golde Patent One-Man Top," and states in the text that The Golde Patent Mfg. Company are putting out the Golde Patent One-Man Top.

**Disposition of Parts.**

The disposition of the parts is identical with that of the patent in suit.

The joint or hinge is raised as in the Golde patent, and even if, as contended by plaintiff, it is at the upper edge, it is above the plane which connects the centers of the two ends of the side arm, and the effect is the same.

In their attachment to ancillary bow d the struts e and f are reversed, so that they are identical with the attachment to intermediate bow 5 of fulcruming lug 13 and supporting link 15 of the patent in suit.

I can see no invention in elevating the joint or hinge between the two parts of the side arms, which is already above in the Golde patent and article in "Motor," as it would require but little mechanical skill to cause the manufacturer to elevate the joint a little higher above if he found that in use there was any slight downward deflection of the side arms due to vibration of the car, as such change would be only one of degree.

If there could be any invention over Golde in raising the joint higher above, then the distance should be given, and no such information is definitely given in the patent in suit.

British Patent No. 403 of 1913, issued to Edward Arthur Green, for improvements in or relating to hoods for road vehicles, the stipulated effective date being February, 1914.

The main bow carries all the bows and the mechanism for projecting the front end of the top forwardly.

There are two part side arms with a joint K, which is above the plane of the side arms. Links O and L are positioned precisely as are the corresponding parts 13 and 15 as shown in the patent in suit.

Complete specification, p. 3, line 16, says:

"The pivot K is located at a point higher than the pivots N and a in a known manner whereby, when the hood is extended as shown and the front of the hood is attached to the screen Q, the joint at K is self sustaining and will not bend downward, and thus no additional support is necessary at that point. The rods L, O and arm M, at the same time, tend to maintain the rigidity of the joint at K."

The arm G is not found in the patent in suit; it is attached to and is an extension from the side arm E. It makes the device still stronger and permits a readjusment of the parts to permit the hood to be fitted to vehicles of different lengths.

If the rod G were removed, the hood would still be self supporting.

British Patent No. 13546, issued to William Henry Freeman for improvements in cape cart hoods or cabriolet covers for motor cars, or similar vehicles, the stipulated effective date being June, 1913.

While it is undoubtedly true that reference being had to Fig. 6. the patent shows a bow which carries forwardly projecting parts comprising side arms C and C* joined at C2 by a joint just above the plane of the side arms and an intermediate bow D which is pivoted to the part C of the side arms and also the links E and F which are connected to the intermediate bow to the upright bow and to the side arms in a manner corresponding to the arrangement of corresponding members shown in the patent in suit.

It seems to me also to be true that Freeman did not rely upon the arch construction for the front bow arms to retain the top in shelter position, but relied upon a pillar i to secure it in supporting engagement with the arm projecting the front bow.

There is also an additional feature, the diagonal brace g which is used as a buggy brace is used, to give tension to the structure.

As has been shown, Green, Freeman, Golde, the patentee, and Golde, the manufacturer, all disclosed before Higgins, the patentee in suit, the desirability of a joint deflected above the plane of the arms, and each of the prior patents, Golde, Freeman, and Green show toggle joints as being provided with shoulders of abutting edges so that the joints may not be deflected upwardly.

The patent in suit is invalid for anticipation and lack of patentable novelty.

A decree may be entered in favor of the defendant dismissing the bill with costs against the plaintiff.

March 4, 1929.

# Indication of Motor Temperature

EX PARTE SCHLAICH. APPEAL NO. 1452, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1704488 was issued March 5, 1929, to Herman Schlaich for indicating devises, on application No. 478430, filed June 17, 1921.

Claims 13, 16 and 18, directed to a pressure operated visual danger signal in connection with the cooling system of an automobile, and covering certain features of appellant's system in such way as to clearly define it over the disclosure of the cited art, were found on appeal to be allowable.

The rejection by the Examiner of claims 5, 7, 9 to 12, 14, 15, 17 and 23 was affirmed on the ground that those claims were either indefinite or failed to distinguish from the claims indicated as allowable.

Moses & Nolte for applicant.

Before Assistant Commissioner Moore, Examiners-in-Chief Ide and Landers.

### Engine Heat Indicated.

The full text of the opinion of the Board of Appeals follows:

This is an appeal from the action of the Examiner finally rejecting claims 5 to 18, inclusive, and 23. Claims 5 and 13 are illustrative of the claims appealed, and are as follows:

"5. The combination of a cooling system of an internal combustion, vehicle propelling engine, said cooling system including a radiator, means for sealing the upper part of the radiator against egress of steam and water, and means normally maintaining the interior of the radiator at atmospheric pressure, but constructed to cause a rise of pressure when boiling occurs, and of means responsive to changes of pressure within the radiator, including signal means in view of the driver of the vehicle for giving to the driver of the vehicle a visual indication of the thermal condition of the engine.

"13. In a motor vehicle, the combination with a motor of a system for circulating a cooling liquid to control the temperature of the motor, said system being sealed against flowing of liquid or vapor from the top thereof and having an air space above the level of the cooling liquid, an open vent communicating with said space and normally maintaining the system at atmospheric pressure, a visual danger indicator in view of the operator, and pressure actuated means constructed and arranged to set the indicator at a warning position when super-atmospheric pressure occurs in the system."

The references relied upon are: Sandvoss, 841186, January 15, 1907; Bristol, 1106341, August 4, 1914; Duguet (French), 475916, June 24, 1915.

The appeal has been withdrawn as to claims 6 and 8. It will, accordingly, be dismissed as to these claims.

### Boiling Point Shown.

Appellant's device is a pressure operated, visual danger signal adapted to be placed on a radiator cap. It comprises a diaphragm which is flexed with steam pressure, is generated by the boiling of the water in the cooling system. Such deflection releases a catch and permits a spring to bias the signal device to a position which indicates to the driver of the automobile that the water in the cooling system is boiling.

The patent to Duguet is the principal reference relied upon by the Examiner to show the general organization. It discloses an audible danger signal in the form of a whistle or siren which is attached to a radiator cap and is sounded by steam pressure when the water in the radiator boils.

The patent to Sandvoss discloses an audible signal which is applied to a boiler. As shown in Figure 20 of this patent a diaphragm is deflected by pressure to move a switch element and thereby close certain contacts in an electric circuit, including a bell and a battery.

The patent to Bristol discloses a measuring instrument the pointer of which is moved by a diaphragm which is sub-

jected to the pressure to be measured.

While there are many claims on appeal they are directed substantially at the same thought of the broad use of a pressure operated visual danger signal in connection with the cooling system of an automobile. It is believed that such of the claims as clearly define appellant's system are patentable over the disclosure of the cited art.

Obviously enough, appellant's device is a marked improvement over that disclosed in the Duguet patent in which steam and water can pass through the whistle and be sprayed over the hood and perhaps the windshield. Sandvoss does not disclose a visual danger signal and the Bristol device is merely a measuring instrument, rather than a danger signal. Neither of these latter two patents discloses a device which is adapted to be attached to a radiator cap in lieu of the whistle of Duguet and function in the manner defined in the claims.

**Several of Claims Misleading.**

Several of the claims, however, are so worded as to be indefinite and misleading. For instance, Claim 5 states that "the upper part of the radiator is sealed against egress of steam and water." This is not strictly true in appellan't device, since steam and water may flow from the upper part of the radiator through the overflow pipe 10. On the other hand, Claim 15 more clearly brings out the fact that it is the filling opening in appellant's device which is sealed. Likewise, Claim 13 definitely calls for a vent communicating with the space in the top of the radiator and normally maintaining the system at atmospheric pressure.

It is believed Claims 13, 16 and 18 adequately cover the patentable subject matter contained in the claims on appeal. The remaining claims are either indefinite or fail to distinguish from the claims indicated as allowable, and in our opinion the Examiner's action as to them should be affirmed. In re Hawkins, 365 O. G. 236.

The appeal is dismissed as to claims 6 and 8.

The decision of the Examiner is affirmed as to claims 5, 7, 9 and 12, inclusive, 14, 15, 17 and 23, and is reversed as to claims 13, 16 and 18.

Limit of appeal to Court of Appeals 40 days. Rule 149.

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# *Failure to State Limitations On Operation of Automobile Lamp*

EX PARTE ENGLE. APPEAL NO. 843, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1704467 was issued March 5, 1929, to Frank G. Engle for Head Lamps, on application No. 759184, filed December 31, 1924.

The Board of Appeals held in this case that the claims appealed, covering a head lamp that was found to be operative with the reflector "terminating forwardly at substantially the focal plane," were broader than appellant's invention in that they did not contain the quoted structural limitation which was necessary to make the device operate as contemplated. The rejection of claims 1 to 7, and 9 and 10 was therefore affirmed.

D. G. Foster for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Skinner and Ruckman) follows:

This is an appeal from the rejection of claims 1 to 7, 9 and 10, of which the following is an example:

"1. In a head lamp, the combination with a reflector of substantially parabolic form, of an illuminating filament having an extended length located substantially in the focal plane of said reflector and extending around the focal point thereof."

The references relied upon are: Farkas, 1207886, December 12, 1916; Slater, 1229538, June 12, 1917; Ames, 1280626, October 8, 1918; Brown, 1359789, November 23, 1920; Bone, 1389291, August 30, 1921; Wood, 1535360, April 14, 1925.

**Automobile Lamps Involved.**

The invention relates to head lamps for automobiles that will illuminate a portion of the roadway while another portion forming the path of an automobile traveling in the opposite direction is substantially dark and free from the glare of the lamp. The specification describes the construction whereby this result is obtained as follows:

"The character of the beam of light is due to the parabolic reflector that terminates at the focal plane and the location of the filament substantially in

said plane, but having no part at all coincident with the focal point."

Originally all the claims, except 8, which covers another feature, included the limitation "reflector of a substantially parabolic form terminating at substantially the focal plane."

In amendment A filed after the first office action, appellant cancelled the limitation "terminating at substantially the focal plane," and stated for the first time that this limitation was not necessary.

**Operativeness Not Shown.**

The record shows that in his first action the Examiner questioned whether appellant's device will project a beam of light as shown in Figs. 3, 5 and 8; that subsequently a demonstration was made by appellant that satisfied the Examiner that it will do so when the reflector terminates at the focal plane, but the Examiner states (paper No. 6) that "it did not work with the full parabolic reflector." It appears from the brief of appellant that at his demonstration he pointed out that it was unnecessary for a successful operation to terminate the reflector at the focal plane and that at the Examiner's request to demonstrate this with a different type of parabolic reflector he did not succeed in demonstrating its operativeness.

It appears from the statements of both the Examiner and appellant that a termination of the parabolic reflector at exactly the focal plane is not necessary and that as the parabolic reflector is gradually extended beyond the focal plane there will be a gradual darkening of the light portion of Fig. 3 and a gradual illumination of the dark quadrant, and that for some undetermined distance of the terminus of the reflector beyond the focal plane the device will operate to produce the result to some extent, though less satisfactorily.

Because of this the Examiner has allowed appellant claims which call for the reflector "terminating forwardly at substantially the focal plane." Appellant, on the other hand, has eliminated from the original claims now on appeal all reference to the reflector terminating at the focal plane. Obviously these claims as now worded are broader than appellant's invention. They do not contain the structural limitation necessary to make appellant's device operate as contemplated, but also cover inoperative devices. This ground of rejection by the Examiner is believed well taken and in accord with Ex parte Horton 1923 C. D., 123, and Ex parte Niles 1923 C. D., 126.

In his statement the Examiner specifically holds that claim 9 is fully anticipated in Fig. 15 of Ames. As clearly stated in line 87, page 2 of the specification of Ames, a portion of the light source is not in focus. This rejection is also well taken.

**Rejection of Claims Affirmed.**

For the rejection on art of the remaining appealed claims the Examiner's statement refers to his action in paper No. 6. This action rejects the claims 1 to 7, 9 and 10 on Wood, Brown or Ames, also on Ames or Brown in view of Slater or Farkas.

Concerning these claims appellant contends that "invention resides in laying a filament lengthwise in a focal plane around the focal point" in view of the unexpected results obtained. But appellant omits from these claims the relation of the terminus of the parabolic reflector to the focal plane, necessary to obtain the unexpected result. It follows that no unexpected result will necessarily be produced by the structure called for in these claims. We consider the rejection of the claims, as worded, on this art to be sound.

The decision of the Examiner is affirmed.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

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# *Handsaw With Motor Power*

EX PARTE WEED. APPEAL NO. 690, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1704641 was issued March 5, 1929, to Frank Lesley Weed for a motorized hand saw, on Application No. 80767, filed January 12, 1926.

The rejection of claims 1 to 3, for a motorized hand saw, on a basic reference modified by the teachings of a supplemental reference, was not sustained since it appeared that the thought of making the modification came from the application on appeal rather than from the prior art. The Examiner's decision was reversed.

Munn & Company for the applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Henry and Ruckman) follows:

This is an appeal from a final rejection of claims 1 to 3, inclusive. Claim 1 is reproduced as illustrative of the appealed claims.

"1. A motorized hand saw including a motor cylinder, flanged heads at the ends of the motor cylinder and tie bars connecting the heads and disposed at the exterior of the cylinder, said tie bars projecting well beyond one end of the cylinder to constitute guides, a cross head reciprocating on the projecting ends of the tie bars and a saw carried by the cross head, said saw being operatively connected to a motor within the cylinder.

The references cited are: Kirk, 5040, March 27, 1847; Hill, 329544, November 3, 1885; Schumacher, 984112, February 14, 1911.

**Guiding Means Employed.**

The claimed construction relates to motor driven saws. Specifically, the claims are directed to the means employed for supporting and guiding the saw in its reciprocation. The motor cylinder for actuating the saw has flanged heads and these heads are connected by tie bars projecting beyond one of the cylinder heads. The saw actuating cross head is guided on the tie rods and a guide for the saw blade is carried by the outer ends of the tie rods. The housing for the motor valve mechanism and one of the tie bars is employed as a handle means for the saw.

The examiner selects the Schumacher patent as a basic reference and proposes to modify the structure thereof to meet the appealed claims in view of the teachings of each of the patents to Hill and to Kirk.

It is the view of the examiner that it would be uninventive to extend the tie rods of Fig. 3 of the Schumacher patent to guide and support the cross head to which the saw blade is connected under the teachings of the Hill patent, reference being had particularly to Hill's rods C, $C^1$, $C^1$. Further, the examiner holds that the Kirk patent teaches the guiding of a cross head as called for by the claims on appeal.

**Feature Not Suggested.**

We think the Hill patent would not teach the extension of the tie rods of Fig. 3 of the Schumacher patent. To us the obvious thing to do would be to attach the guide rods of Hill independently of the tie rods if it were attempted to modify the Schumacher device in view of Hill and that would not result in the construction claimed.

It seems to us that the thought of extending Schumacher's tie rods comes from the application on appeal rather than from the prior art. The limitation to extending tie rods is included in all of the appealed claims and in our opinion is not suggested by the prior art.

The decision of the examiner is reversed.

# *Treatment for Roofing Material*

EX PARTE OVERBURY. APPEAL NO. 47, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1704058 was issued March 5, 1929, to Frederick C. Overbury for a Method of Treating Roofing Material, on application No. 651097, filed July 12, 1923.

The appealed claims 1 to 3, covering a process for treating roofing material consisting of a single step which resides in bending the butt of a shingle sharply upward, were held to be unpatentable as being for a common method of forming a flange on any sheet material. The Board ruled that if there be anything inventive in the case it must lie in the article and not in the method of making it.

Wright, Brown, Quinby & May for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Skinner and Henry) follows:

This is an appeal from the final rejection of claims 1, 2, and 3, claim 1 being illustrative and reading as follows:

"1. That step in the preparation of roofing which comprises bending sharply upwardly of the general plane of the roofing as laid the marginal portions thereof which are exposed to the weather when the roof is laid.'

The reference relied upon is: MacInnes, 1432476, October 10, 1922.

The claims are drawn in the form of a process consisting of a single step which consists in bending the butt of a shingle sharply upward. The reference shows a shingle having its lower end bent sharply downward and then backward upon it-

self. The brief urges that the claims as patentable over the reference by reason of the following differences:

1. A marginal portion along the edge rather than a corner is bent;
2. A bend is made upwardly instead of downwardly;
3. A bend is made to an angle with the plane of the shingle rather than back upon a face of the shingle;
4. Instead of a concealed hook, an outwardly projecting rib is formed which is capable of anchoring and holding in shape a mass of plastic applied to one or both sides of the upwardly bent portion to form slab-like roofing elements.

All of these differences relate to the structure of the shingle rather than to the method step which is covered by the claims and consists of nothing more than forming a flange or rib by bending the material. So far as this step is concerned it is one of the most obvious and common methods of forming a flange on any sheet material and it is sufficiently shown in the reference cited. If there is anything inventive disclosed in this case it must, in our opinion, lie in the article and not in any method of making the same.

The specification, on page 1, lines 5 to 14, refers to another application, Serial No. 636853, in which a ridge is formed at the butt ends of shingles by running a trowel along the butt ends of the courses and it may be that the shingle is claimed in that application, which would account for the lack of an article claim in the present case. If this be so, then the supposed patentability of the appealed claim must lie in the formation of a flange or rib by bending instead of plastic molding. As we see it, there is nothing patentable in forming a flange in one way rather than in the other as both of them are well known methods of effecting the result.

The decision of the Examiner is affirmed.

Limit of appeal to the Court of Appeals, 40 days. Rule 149.

## MARCH 19

# *Preservation of Pistachio Nuts*

ZENOBIA COMPANY, INC., v. HABIB SHUDA. EQUITY 3326, DISTRICT COURT FOR THE EASTERN DISTRICT OF NEW YORK.

REISSUE patent 15902, covering plaintiff's method of preserving pistachio nuts and the preservative compound used was held to be valid over the prior art and claims 4, 5 and 6 of the patent held to be infringed by the defendant's method.

The methods of preserving pistachio nuts for shipment from Syria, consisting in placing the roasted nuts, still in the shells, in salt water, proved unsatisfactory, the court said herein, because the salt settled to the bottom of the can during shipment and the nuts which were thus partially deprived of salt were subject to worminess and sogginess.

The plaintiff's assignor corrected the defects in this method by first coating the shells with a white mucilaginous substance and then applying a salt compound, with the result that about 90 per cent of the salt adhered to the shell, the nuts were preserved satisfactorily, the white shells made attractive for window display, and the sales in the United States greatly increased.

Prior art methods of preserving consisting in applying preservative to the kernel of the nut, rather than to the shell, and in placing a composition on egg shells to preserve eggs, were found not to be anticipations as these methods functioned in a substantially different way and produced substantially different results.

### Not Anticipatory.

Defendant's method of applying the preservative to the pistachio nut shell, involving the use of starch as an adhesive, the court ruled, constituted an infringement of claims 5 and 6 which called for a mucilaginous substance as an adhesive. Claims 1 and 4, specifying the use of gum arabic, were also held infringed on the ground that this substance served as an equivalent of starch as an adhesive material.

Claims 2 and 3 were limited to definite amounts of gum arabic and other materials mixed together to form the compound and were found not infringed by defendant's coating compound.

Dean, Fairbank, Obreight & Hirsch, solicitors for plaintiff, George A. Ferris and Morris Hirsch, of counsel. Grauer & Rathkopf, solicitors for defendant, Charles A. Rathkopf, of counsel.

The full text of the opinion of the

court, delivered by Judge Campbell, follows.

This is an action in equity for the alleged infringement of Reissue Patent No. 15902, issued by the United States Patent Office to Salim F. Zaloom for preserving compound for pistachio nuts, dated August 26, 1924, original application, Serial No. 569972, filed June 21, 1922.

Title to the patent is vested in the plaintiff, together with the right to sue for and collect past damages.

The action is based upon the six claims of the patent in suit, which read as follows:

"1. A compound for treating pistachio nuts consisting of sodium chloride and gum arabic in aqueous solution.

"2. A compound for treating pistachio nuts which consists of 100 pounds of sodium chloride, two pounds gum arabic in an aqueous solution.

"3. A compound for application to pistachio nuts comprising the following ingredients in substantially the proportions specified, namely, 100 pounds sodium chloride, two pounds gum arabic and 40 gallons of water.

"4. The method of treating pistachio nuts which consists of spraying them with an aqueous solution of sodium chloride and gum arabic while the nuts are passing through a roaster.

"5. The method of treating nuts to give the shells thereof a whitish appearance which consists in covering the shells with an intimate mixture of salt and a mucilaginous substance.

"6. As a new article of food, a nut, the shell of which is coated with a uniform adhering layer of an intimate mixture of salt and a mucilaginous substance, whereby the shell is given a whitish appearance."

Defendant has interposed the two-fold answer of invalidity and noninfringement.

For ages pistachio nuts have been roasted and salted.

**Roasting Described.**

The old-style method of roasting, as practiced in Syria, the home of the pistachio nut, as well as in America, was to place the nuts, in the shells, in a large vat, which was placed over a fire and the nuts agitated with a stick to prevent scorching. When sufficiently roasted, the nuts, still in the shells, were removed and placed in a box, where a solution of salt and water was sprinkled over the nuts, and they were moved around so the salt water would apply on all of them and they would dry in the air.

They were shipped from Syria to America in 25-pound second-hand kerosene cans, and while in transit several pounds of salt would have dropped from the nut shells to the bottom of the can.

Due to the shaking off of the salt from the nuts roasted and salted by the old process, they were subject to worminess, webbiness, sogginess, and were unattractive.

Many efforts were made to correct these faults, but none was successful.

The use of salt as a food preservative has long been well known, and it performs the same function whether on fish or nuts. But although fish, which is well salted for preservation, is commonly soaked in water before preparation for eating, to remove the excess salt, that could not be done with nuts, which are commonly eaten as confections, because by such soaking process, even if otherwise feasible, the nut would be rendered soggy.

The problem which confronted the patentee was to preserve the nut with an ample quantity of salt, and at the same time to avoid rendering the kernel unpalatable by any excess thereof.

The solution to this problem was found by the patentee to be the securing of 90 per cent of the comparatively large quantity of salt upon the shell of the nut, but as the shell of the nut was smooth and glossy he found it necessary to coat the shell with an adhering layer of mucilaginous substance.

This not only held the salt on the shell where it acted as a preservative and preserved the kernel of the nut from worminess or bacterial spoilage, but also prevented the kernel from becoming soggy, and not only protected the kernel of the nut from excessive heating and spoilage when exposed to the sun, but also made the nuts attractive to the eye, especially for the purpose of window display in the stores in which they are sold.

**Shown by Evidence.**

That such results have been accomplished by the process of the patent in suit is amply sustained, and the explanation of the cause thereof is found in the testimony of the witness Herstein.

The complaints of spoilage which were frequently made with reference to nuts prepared according to the old style ceased with the production of the nut roasted and salted under the process of the patent in suit, and the sales of nuts roasted and salted in the old style has since then been substantially limited to Syrians, but the business of plaintiff in

nuts roasted and salted under the process of the patent in suit has increased from $15,000 in the old style in 1921 to $680,000 in new style in 1927.

Defendant offered in evidence, to show the prior state of the art, the old style of roasting and salting as practiced in Syria, which has been described, and I am convinced that the defendant Shuda was in error when he said that he used starch, flour and gum in Syria as an adhesive in preparing these nuts.

United States Patent No. 172677, issued to Abigail S. White for improvement in compositions for preserving eggs, dated January 25, 1876, and United States Patent No. 116976, issued to James Timmons McKim for improvement in compositions for preserving eggs, dated July 11, 1871, are not even for an analogous art, because the purpose of treating the shell of the egg with a composition is to seal up the pores and exclude the air, and not to improve or change the quality of the egg itself; and this clearly appears from the fact that the composition, if it was applied to the egg inside the shell, would make it inedible. Therefore, the teaching of such patents would not be available in the case of pistachio nuts, where it is the kernel itself which is sought to be preserved.

### Extent of Prior Art.

United States Patent No. 229042, issued to Gilbert F. Holland, for Compound for Preserving Food, dated June 22, 1880, is remote from the salting of pistachio nuts, because the patent discloses the use of substances applied to the surface of the article of food sought to be preserved, which may readily be removed therefrom by washing, while pistachio nuts would lose many of their valuable characteristics by washing.

United States Patent No. 175970, issued to Andrew J. Grauel, for Improvement in Compositions for Coating Coffee, dated April 11, 1876; United States Patent No. 131852, issued to John T. Cooke, for Improvement in Compounds for Coating Roasted Coffee, dated October 1, 1872; United States Patent No. 167383, issued to James H. Bell and John H. Conrad, for Improvement in Compositions for Glazing Roasted Coffee, dated September 7, 1875; and United States Patent No. 91870, dated June 29, 1869, issued to Edward E. Rinehart, for Improvement in the Manufacture of Roasted Coffee; are remote, because the purpose as expressed in such patents is to coat the bean itself, whereas in the pistachio nut, the purpose is to coat the outer shell and only admit sufficient salt to season the kernel of the nut.

Practical Pan Man's Guide, by Octave Grillon, April, 1911. This book contains recipes for the manufacture of Dragee. Jordan almonds are made of shelled almonds which, after drying in a stove or drying room, are gum-coated, engrossed, filled and finished.

The same process is followed in making Pistachio Dragees, sugar being used with the gum in both instances.

The product is in no sense the same as that produced by the process of the patent in suit, and the process differs. The Jordan almond is a hard sugar-coated nut, not a nut seasoned and preserved in its own shell.

American Candy Maker, by Charles C. Huling, 1902. This book teaches the art of producing salted almonds, salted peanuts and Jordan almonds.

The remoteness of Jordan almonds has already been pointed out, and the salted almond or peanut is still more remote. All of these are shelled nuts, not nuts preserved in the shell, and both the process and product differ from the patent in suit. There is no reference to pistachio nuts in this book.

### No Reference in Books.

Charles Apell, Up-To-Date Candy Teacher, 1921. This book teaches the art of salting peanuts and almonds. As in the prior publication, the nuts are shelled and not nuts preserved in the shell, as is the case in the patent in suit. Pistachio nuts are not mentioned in this book.

Friedman's Common-Sense Candy Teacher, by Jacob Friedman, Third Edition, 1915. This book teaches the art of salting pecans and peanuts, and also deals with shelled nuts and not nuts preserved in the shell, as does the patent in suit. Pistachio nuts are not mentioned in this book.

The processes of said patents and the recipes described in said publications have been put to practical use, but none of the patents or publications offered by the defendant anticipate or limit the patent in suit.

The defendant also offered to show anticipation by the following alleged prior uses.

The alleged prior use by the defendant. This is not supported by convincing evidence.

The alleged prior use in a foreign country was not shown to my satisfaction, and if it was, it would not be a defense.

The alleged use of a similar process by the defendant after coming to this country was not proved to my satisfaction, as the testimony of the defendant and his relative and former partner, Halwany, that he produced a white product, was contradicted by the testimony of the witness Kassouf, who purchased the nuts.

The witness Shalhout, called on behalf of the defendant, failed to corroborate the defendant, as he admitted on cross-examination that the nuts he bought from defendant in 1919 were not as white as exhibits 9 and 10.

The bills in Arabic, offered as documentary proof, fail to corroborate, as all that they show are sales of pistachio nuts by defendant to Shalhout, but not that they were white coated.

Both Halwany and defendant are compelled to rely entirely on their recollection as they do not read.

### Old-style Method.

The alleged use by Abaid needs no extended consideration, as I am convinced that he used the old-style method and did not make white coated nuts. The alleged use by Malouf is negatived by his experiments with plaster of Paris and attempts to ascertain Zaloom's process. If the witness Malouf used gum arabic for coating imported raw nuts in 1908, he could have been corroborated by calling his brother, who he says did the coating, or customers who bought them.

The witness Walsh, called by plaintiff, testified that he bought pistachio nuts from T. K. Malouf, and Abaid and Samaha, in 1916 and 1917, but that they were of the old-style. If the witness Malouf is not in error, it seems almost impossible that he would have given up the large opportunity offered to him, and limited himself to the small Syrian trade.

The alleged use by Caputo hardly needs extended consideration.

He is entirely uncorroborated and testified that in 1919 he worked one week for a man now dead, whose name he forgets, and that although he had no previous experience, he worked at coating about 30 pounds of pistachio nuts with gum arabic, starch, salt, and water.

The witnesses Walsh, Ertz, Everson and Cash testified that they never saw anything like the white coated pistachio nuts in question until they were brought to their attention by the Zaloom concern in 1921.

The contention of the defendant that the presumption of validity of the patent in suit is weakened, if not entirely removed, because it was granted without any citation or consideration of the most relevant art, is without merit because none of the art offered in evidence by the defendant is relevant.

No one had taught the use of an adhesive for retaining a preservative on the shell of the nut, and at the same time preserving and seasoning the kernel of the nut, and no earlier process of which proof was given in this case performed the same function in substantially the same way and produced substantially the same result as that of the process of the patent in suit.

### Novelty and Invention.

There is novelty and invention in the patent in suit. Brodgex Co. v. American Fruit Growers, Inc., 21 Fed. (2d) 110, Karesh v. Shell-on Sol-ted Peanut Co., 17 Fed. (2d) 496, P. E. Sharpless Co. v. Crawford Farms, 287 Fed. 655, Cochrane v. Deener, 94 U. S. 780, Crowell v. Harlow, 1 Fed. 140, Davey Tree Expert Co. v. Van Billard, 261 Fed. 996, and the process is sufficiently described to enable one learned in the art to successfully practice it.

The defendant did not teach the patentee, for the simple reason that the defendant did not know or use the process of the patent in suit before the patentee invented it.

None of the alleged prior uses were proven to my satisfaction beyond a reasonable doubt and while there is no fixed rule, and much depends on the peculiar circumstances of each case, yet in none of the instances of alleged prior use was there documentary corroboration or even satisfactory oral corroboration, therefore none of them anticipate. Eibel Co. v. Paper Co., 261 U. S. 45, 60; 43 S. Ct. 322; Kalamazoo Loose Leaf Binder Co. v. Wilson Jones L. L. Co., 286 Fed. 715 717; Pyrene Mfg. Co. v. Boyce, 292 Fed. 480, 485.

The necessity of corroboration is especially true where the alleged public use is in defendant's own plant. Deering v. Winona Harvester Works, 155 U. S. 286, Adamson v. Gilliland, 242 U. S. 350, Symington Co. v. National Casting Co., 250 U. S. 383.

There has been acquiescence in the validity of the patent, and it has to a very large extent displaced the prior art process and product, in fact defendant pays it the flattery of imitation.

The patent is valid.

### Patent Not Confined.

On the subject of infringement, there is no doubt in mind as to claims 5 and 6.

Starch is a mucilaginous substance, and that was admittedly used by the defend-

ant. While the specification mentions as an adhesive gum arabic, it is referred to as preferably used, and the patent is not confined to gum arabic but to an adhesive.

The chief merit of the patent is not the whiteness of the shells nor their attractiveness when whitened, and the defendant could use any method of whitening the shells which did not include the use of an admixture of salt and a mucilaginous substance on the shell.

While the patent in suit is not a pioneer patent and thus entitled to a broad range of equivalents, it is still entitled to such a range of equivalents as will protect the invention of the patent in suit which is to provide a preserving compound of salt and an adhesive, which will adhere to the shells of pistachio nuts, give them a whitish appearance, and in addition make the nuts, by reason of the salt which reaches the kernel, more delectable as an article of food; and I find that starch is an equivalent of gum arabic for the purposes of practicing the invention of the patent in suit.

There is no evidence on which I can find that starch and gum arabic in the same quantities, when used separately, will produce the same result; therefore, although I find that starch is an equivalent of gum arabic, as hereinbefore stated, I cannot find that claims 2 and 3, which recite specific quantities of gum arabic, are infringed.

Claim 1 is infringed as starch is the equivalent of gum arabic, and claim 4 is likewise infringed, as the nuts are sprayed with a mixture of salt and an adhesive, starch, which is the equivalent of gum arabic, while the nuts are passing through the roaster in the process practiced by the defendant.

The patent is valid, and claims 1, 4, 5 and 6 are infringed.

A decree may be entered in favor of the plaintiff against the defendant, for an injunction, with costs and with the usual order of reference as to damages.

February 25, 1929.

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# Deadening Automobile Roof Sound

EX PARTE MCCULLEY ET AL. APPEAL NO. 96, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1703118 was issued February 26, 1929, to Claude McCulley and Louis E. Ruehlmann for automobile body construction, on Application No. 590783, filed September 27, 1922.

Claims for an automobile roof construction, including a receptacle designed particularly for sound deadening purposes, were denied as being unpatentable over a prior art device consisting of a double roof comprising a receptacle inherently adapted for use for sound deadening purposes, although patentee did not specify that his roof would so function. The examiner's rejection of claims 6 and 11 was affirmed. Samuel E. Darby and John P. Tarbox for applicants.

The full text of the opinion of the Board of Appeals (First Assistant Commissioner Kinnan, Examiners-in-Chief Henry and Redrow), follows:

This is an appeal from the rejection of claims 1 to 8.

### Appeal Amended.

In an amendment filed with the brief the appeal as to claims 1 through 5 and 8 is withdrawn. The appeal is therefore dismissed as to these claims. The same amendment also modifies claim 6 in a slight and obviously immaterial detail apparently to make line 3 agree with line 1 in the matter of antecedent. Also it substitutes claim 11 for claim 7. The new claim is considered the same in substance as claim 7 but of better form. The amendment is therefore considered to be desirable as a matter of form and will be treated as entered.

The claims then to be considered are, amended claim 6 and new claim numbered 11 as follows:

"6. In a roof structure for closed body vehicles, a roof panel inherently subject to audible vibration by the operation of the vehicle, and sound deadening means at the forward end only of said roof panel.

"11. A roof structure for closed body vehicle inherently subject to audible vibration by the operation of the vehicle, and provision at the forward end of such structure only for estopping the transmission of audible vibrations from the front end toward the rear end of said structure."

The references relied on by the examiner are: Smith, No. 439085, October 21, 1890; Reimuller, No. 632205, August 29, 1899; Bauer, No. 931719, August 24, 1909; McQuilkin, No. 1400890, December

20, 1921; Hamlin et al., No. 1485029, February 26, 1924.

**Double Top Employed.**

The subject of this application is a sound-deadening structure formed at the forward portion of the top of an automobile, especially those of the closed type, as sedans and coupes. The essential idea involved is to provide a double top, comprising a panel under the regular top, thereby forming a space between, which may be left empty or filled with loose packing, which latter is alleged to help decrease the drumming sound due to vibration of the car. The above claims are not limited to use of the filler, but cover broadly any means as the double top.

Claim 6 stands rejected on Reimuller and on Hamlin. This claim includes a "roof panel" of a vehicle and "sound-deadening means at the forward end only of said roof panel." Hamlin especially shows a structure upon which the claim reads directly. He discloses a metallic top for an automobile which, together with detachable rigid window and door members, makes a closed body which would be subject to the same drumming effect as the car body shown by applicant, and he also shows the same double structure of the top at the forward end only of the roof panel. It is formed by the panel 54.

Hamlin states that the panel 54 is for the purpose of forming a receptacle to carry articles.

**Prior Patent Covers Claim.**

We note applicant's contention that Hamlin's receptacle formed by the double roof was intended to carry "tools and the like." Hamlin does not suggest carrying "tools," and it is not thought likely that any driver would attempt to carry tools there, as they would obviously be tossed about and create a very disagreeable noise. He would be apt to use that space for coats or blankets, or other textile articles.

It is observed that Hamlin does not suggest any advantages of his receptacle as a sound-deadening device. We are unable to see, however, why it would not unavoidably accomplish this if applicants' similar structure in the same location does. No reason is apparent, and applicants have shown none. They merely allege that Hamlin's space is not provided to produce applicants' results, nor is it disposed with a view to secure these results. This is too brief and indefinite to show why it would not produce the same result whether so intended or not.

It is considered clear that Claim 6, reading directly and fully on Hamlin's structure, cannot be allowed, where, as we believe, his structure must function to the same extent as applicant's as a sound-deadening means.

The claim also fails to avoid Reimuller in terms.

**Broad Claims Disallowed.**

Claim 11 is the same as Claim 6, in substance. It contains a more extended statement of the sound-deadening or anti-drumming properties, but the same conclusions apply as in Claim 6. In the particular situation here the same results are considered unavoidably present in the reference as in applicants' case.

Broad claims depending on indefinite alleged differences in function or results over such reference, but yet reading directly upon it in structure, cannot be allowed.

The examiner's opinion is affirmed.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

August 2, 1928.

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# *Electric Heater and Thermostat*

EX PARTE KERCHER ET AL. APPEAL NO. 575, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1704479 was issued March 5, 1929, to Arthur J. Kercher et al for an electric air heater, on application No. 60174, filed October 3, 1925.

The examiner's rejection of claims 1 to 4 and 6 to 10 on the theory that, since the references disclosed the combination of an electric heater and a thermostat, appellant was not entitled to a combination claim including these two elements, was reversed, the Board stating that a patentable combination may be effected by combining old elements in a new manner to produce a new result.

Earle D. Crammond and White & Prost for applicants.

**Electric Heater Claimed.**

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Henry and Landers) follows:

This is an appeal from a final rejection of Claims 1 to 10, inclusive. Claims

1 and 6 are reproduced as illustrative of the appealed claims.

"1. In an electric heater, a housing for the heater arranged to be accommodated in a wall recess, electrical heating means in said housing, means within said housing forming a flue for convection currents entering and leaving the housing, and a switch for controlling the current supplied to the heating means mounted on the exterior of the housing immediately adjacent the flue and in such a position that it can be accommodated in the recess.

"6. In combination, an electrical heater, means for circulating air into and out of said heater, and means responsive to the temperature of the air entering said heater for controlling the current supplied to said heater."

The references cited are: Lofquist, No. 1012669, December 26, 1911; Russell, No. 1029230, June 11, 1912; Harrison, No. 1054409, February 25, 1913; Smith, No. 1217229, February 27, 1917; Kercher et al., 1534221, April 21, 1925.

The appeal has been withdrawn as to Claim 5. Accordingly it will be dismissed as to this claim.

**Controlled by Thermostat.**

The invention relates to an electric heater adapted to be accommodated in a wall recess and used for heating a room. The operation of the heater is controlled by a thermostat which is mounted in the lower part of the heater casing at a point where the air from the room enters the casing and which is shielded from the heat generated by the heater. The upper portion of the casing is given a tapered form, and a manually operated switch is designed to fit in the recess provided by this taper.

Appellant has provided a unitary structure containing all the necessary elements, which is adapted to be received in a rectangular recess and in which the thermostat is responsive to room temperature instead of the temperature within the heater.

It does not appear from the examiner's statement or from his actions in the case that a search has been made to ascertain whether or not it is new to locate the thermostat and the manually operated switch in the positions disclosed and claimed by the appellant. On the other hand, the examiner has cited several patents to show that it is old to use thermostats in association with electric heaters, and in view of these patents he holds the claims to be drawn to an exhausted combination.

**Patentable Combination Effected.**

The examiner's rejection appears to be based on the theory that since these patents disclose the combination of an electric heater and a thermostat that nobody is entitled to a combination claim including these two elements. We do not subscribe to this theory. We believe that a patentable combination may be effected by combining old elements in a new manner to produce a new result.

The examiner has required the cancellation of certain figures of the drawing, and appeal has been taken from this requirement. As stated by the examiner, however, this is a petitionable rather than an appealable matter.

The appeal is dismissed as to Claim 5 and the decision of the examiner is reversed as to the remaining claims.

## MARCH 20

# *Equipment to Dry Hair and Scalp*

WILLIAM MEYER v. MODERN ELECTRIC EQUIPMENT COMPANY, INC. DISTRICT COURT FOR THE WESTERN DISTRICT OF NEW YORK.

PATENT No. 1541988, claims 2, 5, 7 and 11, for hair and scalp drying equipment largely used for drying women's hair, involving the use, simultaneously, of electric heat and radiant light with stream of air, whereby the slow drying and chilling effect are counteracted by projecting radiant heat and light upon the scalp, producing a new and beneficial result, was held valid and infringed.

The court found that although all the elements were old in the art, the patent depended for novelty upon a combination of elements and manner of assembly, new in the art, and was valid.

The opinion held that defendant's device, operating upon the same principle as plaintiff's device with slight structural alterations, and without suggesting a patentably different mode of operation of air forces, constituted an infringement.

Brown, Jackson, Boettcher & Dienner, (John A. Dienner, of counsel), Chicago, Ill., for plaintiff. Briesen, Schrenk (Paul Kolisch and Han Briesen, of counsel), New York City, for defendant. Fleischman & Altman, Buffalo, N. Y., defendant's solicitors.

The full text of the opinion of the court, delivered by Judge Hazel, follows:

This is an action for infringement of patent No. 1541988, issued to William Meyer, dated June 16, 1925, for method of and means for drying—specifically a hair and scalp drying equipment largely used for drying women's hair. The method consists of using, simultaneously, electric heat and radiant light with stream of air, the heat being proportioned relatively to the stream of air in aid of circulation and to offset the chilling effect of the air on the hair or scalp and to induce speedy evaporation of the moisture.

### Distinction Alleged.

The patentee asserts that his adaptation is distinguished from the use of mere hot or cold air in hair drying—old expedients—because in the first instance there is rapid evaporation but chilling of the scalp, and in the other drying the scalp slowly and also chilling the subject, while by his method the slow drying and chilling effect are counterated by projecting a stream of warm air and radiant heat and light upon the scalp, producing a new and beneficial result. Claims 2, 5, 7 and 11 are involved.

The apparatus claim 2, and process claim 11, which are regarded as typical of the invention, read as follows:

2. "In a device of the class described, a casing having a discharge opening, means for projecting a stream of air from said discharge opening, and an electric light arranged in said casing to emit radiant heat and light rays thru said discharge opening, and means other than said electric light for heating the air stream in its passage through the casing."

"11. The process of drying the hair and scalp which comprises projecting a blast of air upon a portion of the scalp and hair to be dried, simultaneously heating the air above atmosphere temperature to expand it and to lower its water vapor pressure, taking up the mositure of the hair and scalp by vaporization by said stream of air at a rapid rate, said vaporization being accompanied by chilling of the hair and scalp and simultaneously projecting radiant heat and light upon the portion of the hair and scalp to counteract the chilling effect."

The combination of claim 2 includes (1) a casing having a discharge opening, (2) means for projecting a stream of air from said discharge opening, (3) electric light arrangement to send forth radiant heat and light rays through the discharge opening, and (4) means other than said electric light for heating the air stream in its passage through the casing. Claim 5 includes, as a new element of the combination, the tapered tube with lengthwise fins, and 7 pertains to the structure of the apparatus.

It was the patentee's conception to embody in the casing a rotary fan for blowing the air from the rear, and a fixed reflector beyond the fan, an electric, high voltage light bulb in front of the reflector, and an annular passage between the edge of the reflector and inner wall of the casing with a heating coil in the annular passage together with a discharge tube provided with interior ribs to change the spiral air motion, resulting from the rotation of the fan, so as to impart to the air a direct forward motion.

### Speedy Evaporation.

By this adaptation the patentee attained speedy evaporation of the moisture and stimulation of the scalp. The fanned air was projected ahead in the casing, expanded by the heat rays, and flowed, in combination with said rays, to the outlet of the nozzle. To secure projection of the air on the hair or scalp the patentee provided fins or ribs in the tapered part of the casing and extended them lengthwise toward the outlet.

By this arrangement separation and scattering of the air at the opening of the tube is avoided. The combination of air, light and electric force projected and focused upon the desired surface was of the essence of the invention.

Defendant's expert witness was of the opinion that the light bulb did not aid the expansion of air, as testified by the witness Meyer, to project the combined air forward, asserting that the horizontal (instead of vertical) use of the device deterred any such result. Upon this point, however, I think the heated air generated a certain degree of pressure and velocity and, coordinated by blowing a blast of air, caused an acceleration through the nozzle.

The invention is not limited to hair and scalp drying, but the specification says it may be employed for all similar purposes.

The defenses are non-infringement, lim-

itation of claims, and invalidity. Concededly, hair dryers driven by a fan using blasts of warm air heated either by gas or electric heater for evaporating moisture by a stream of warm air were old. So also the use of a radiant heater on the hair to vaporize the dampness and a current of air to diffuse the vapor.

A warm air device was in practical use at the date of the Meyers invention (pltf's Ex. G-2) and as described in the Halliwell patent, No. 738186. The hair in such device, however, was gradually cooled simply by turning off the heating means; and in an earlier Halliwell patent, No. 591966, the heat for drying was produced by a gas burner, and speed in drying apparently was the main object of the invention. In both Halliwell structures means were lacking to avoid the chilling effect upon the scalp which is a prominent feature of the Meyer patent in suit.

Indeed, in general drying the hair rapidly by forcing a blast of air through it, and also a fan in connection with an electric heater were both regarded by users as inefficient and harmful to the scalp, as pointed out in patents to Cannon, and Mauger, Cannon (pat. 1478635) used an electric resistance current in a cylindrical shell, the shell and fan acting as reflectors to reflect the heat from the resistance wire upon the wet hair which was placed across the opening of the shell.

### Prior Patents Lacking.

The fanned air and radiant heat were designed to accomplish Cannon's object, while Mauger (pat. 1006767) in his modification used a mechanically driven blast of air with heat energy in radiant form, the heat reflecting directly upon the hair, and then applying the current of air for cooling. Both Cannon and Mauger, however, lacked the combination of elements embodied in the claims in issue and failed to produce the result of the Meyer patent

Indeed, the use by Cannon of an incandescent resistance coil was regarded by defendant's expert as impracticable in that the hair was in danger of becoming ignited; while Mauger in his efforts to remove mositure by supplying radiant energy was also at fault because of the danger of the radiant heat injuring the hair. Neither of these devices have gone into commercial use.

The Soles patent, No. 939106, defendant claims, show the combination in suit. It is true that the hair is dried by his adaptation by the effect of radiant light and heat from an incandescent lamp located in front of a reflector conjointly with an air blower, yet its practicability was seriously questioned. It is not essentially different from Mauger's structure. It has not come into commercial use, owing, no doubt, to the large opening of the hood together with the interference of the three lamps used by him, which retarded the efficiency of the fan or blower in that projecting sufficient air current on a particular surface in conjunction with the radiant heat and light was ineffective or impracticable. Moreover no means are shown in the Soles device for offsetting chill and stimulating the circulation in the scalp.

The invalidity of claim 5 is urged on the ground that the patent of Voden, No. 366535, disclosed longitudinal fins for projecting the air straight ahead and estopping circular motion. The description shows that the air is blown through a discharge pipe, and then a blast of air projected, without whirling, upon an object, but whether the object is removed from the outlet does not appear. Neither of these prior patents are anticipatory.

A few other prior art patents were dwelt upon by defendant but the patents just mentioned are thought a closer approach than any of the others, and therefore they may be passed.

### Novelty of Device.

The novelty of plaintiff's device, as I see it, is essentially in the combination of elements and manner of assembly of two natural forces acting, as plaintiff's counsel puts it, upon a common field of action, namely, one imparting radiant force to the zone or field, while the other imparts a current of warm air; the heat and radiant light being proportioned relatively to the stream of air to obtain the desired result. The patentee was the first to combine old elements to do this, and the claims sued on are believed valid.

The Meyer patent in controversy, true enough, cannot be classed as a broad invention, in view of prior art structures essaying the same object, but I nevertheless think that an advance has been made and difficulties and interferences with efficiency to which the prior art was subject have been overcome by Meyer's adaptation.

The file wrapper shows a change of wording in various instances from the original claims, but I discover no such restriction as to require a precise location of parts or elements.

Defendant's structure is described in the Kolisch patent, No. 1609412, and operates, in my opinion, upon the same

principles as plaintiff's with slight structural alterations, but it does not suggest a patentably different mode of operation or coordination of air forces. The fan in defendant's structure is a part of the rotating reflector, while plaintiff's reflector is stationary and the fan is separated from it; but defendant's fan performs the identical function.

The patent is not limited to the exact structural details, since the specification says that "the fan may be attached or made a part of the outer edge of the reflector." The different location in the infringing dryer of the heater is likewise inconsequential, since it functions in the same way as plaintiff's, namely, to warm the air blown from the outlet.

Aside from this, none of the disputed claims refer to locating the heater either in front or to the rear of the fan. Defendant also in its tapered shell, has longitudinal fins to produce suitable focusing of the blast of air, as in plaintiff's structure. These alterations are all equivalent adaptations in view of the reasonable scope to which I deem the involved claims are entitled.

It is next contended that claim 11 is merely functional, but, as the elements of the combination are coordinated to produce a new result in their action upon the wet and dry hair, this contention must be regarded as unsubstantiated. It is also to be noticed that soon after plaintiff's device was put on the market, its value over other hair drying instrumentalities received speedy commercial recognition, and that the defendant company with its later structure entered the field and sold at a lower price.

The defendant Modern Electric Equipment Company, Inc., sold the infringing device in this district, while the Halliwell-Shelton Electric Corporation, the manufacturer thereof, has interposed a defense and may be regarded as a real defendant.

The claims 2, 5, 7, and 11 in controversy are valid and infringed by the exhibit structure manufactured and sold by the defendant Halliwell-Shelton Electric Corporation, and a decree for plaintiff may be entered with costs.

February 11, 1929.

## MARCH 21

# *Varied Control in Spraying Paint*

ALLIANCE SECURITIES COMPANY, APPELLANT, V. ROMAN PAINT COMPANY, APPELLEE. No. 5578, CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT.

PATENT No. 1196691, covering a device for atomizing and spraying liquids, particularly paint, the distinguishing feature of the device residing in the use of an automatic pressure regulator in the air line leading to the discharge nozzle, wherein complete independence of the regulation of air pressure to the paint supply and to the nozzle was obtainable, was held not to be infringed by defendant's structure wherein an unloader, comprising a valve located on the compressor, was employed.

The court stated that the invention in the patent consisted in the location of the pressure reducers and that it established the universal principle of construction and operation of devices of this sort.

Appeal from the District Court for the Northern District of California.

Before Gilbert and Dietrich, Circuit Judges, and Norcross, District Judge. The full text of the opinion of the court, delivered by Judge Norcross, follows:

Appellant instituted suit for injunction and an accounting based on alleged infringement of Letters Patent of the United States, No. 1196691, and appeals from a final decree dismissing the bill of complaint for want of equity.

**Upheld in Prior Cases.**

The validity of the patent alleged to be infringed was upheld by this court in the case of J. A. Mohr & Son v. Alliance Securities Co., and Standard Oil Co. v. Same, 14 Fed. (2d) 799.

The question presented is solely one of infringement. The patent covers a certain device for atomizing and spraying liquids, and is particularly designed for spraying paint on surfaces to be coated therewith. The claims of the

patent are quite fully set forth in the opinion of Kerrigan, District Judge, in the Mohr and Standard Oil cases, 14 Fed. (2d) 793, and need not here be set out at length.

From that opinion we quote:

"The central thought running through all of them is the supplying of atomizing air and liquid to a spray nozzle, the latter by pressure applied to the liquid itself, and the former by connection with an air compressor; both pressures being under independent and relatively variable control, so as to be maintained at constant, uniform values and ratios. * * *

"It must be, and I think is admitted, that no single element of the Hopkins patent is new. Its only substantial difference from Fisher, as was repeatedly pointed out in the Hopkins file proceedings, is the provision of an automatic pressure regulator, 9, in the air line leading to the discharge nozzle, in addition to and supplementing the hand-controlled plunger valve, 16a, which already was to be found there."

The main features of the alleged infringing Paasche device and those of the Hopkins patent as affecting the question in controversy are concisely stated in the report of the special master, approved by the Court below, as follows:

"Plaintiff's device, the Hopkins patent, shows 'an air line, 2, extended from a suitable source of supply,' which main air line has two branches; one branch, 15, conducting air to the spray nozzle, the other branch, 4, conducting air to a closed tank containing the paint or other liquid to be atomized, from which tank there extends a conduit, 14, to carry the paint to the spray nozzle. The tubes 14 and 15 are of flexible material, such as rubber.

**Pressure Valves Placed.**

"The important elements of the device are two pressure-reducing valves placed in the two branches of the main air-supply conduit, 2; one pressure reducer, 9, being placed in the air line between the branching point and the air nozzle, and the other pressure-reducing valve, 6, being placed between the branching point and the paint tank. Each of these reducing valves is adjustable with respect to the amount of pressure to be passed through them." * * *

"Defendant's Paasche device embodies a self-contained unit to be readily transported on a small truck. It therefore includes the compressor with its actuating motor and its air reservoir, and in addition, the spraying apparatus. Like the plaintiff's device, it includes a pressure tank to contain the liquid to be sprayed, a spraying nozzle, a flexible conduit to the nozzle for atomizing air, a flexible conduit from the paint tank to the nozzle for the liquid to be sprayed, and a main air supply conduit from the air reservoir.

"This main air supply conduit is connected to the head of the paint tank, and there it branches, one branch continuing as the air tube to the nozzle and the other branch entering the paint tank. Between the point of branching in the air line above referred to and the paint tank is an adjustable, automatic pressure-reducing valve, admittedly similar in construction, mode of operation and result with the reducer 6 of the Hopkins patent. There is, however, no pressure-reducing valve in the air conduit between the branching point and the spray nozzle. On the top of the compressor, interposed, therefore, between the air reservoir and the compressor, is an automatic, adjustable valve called an unloader.

"The question in this case, so far as infringement is concerned, is whether this unloader, in its construction, mode of operation, and results, is the equivalent of the reducer 9 of the Hopkins patent."

Upon the particular question of infringement, we quote from the Master's report the following material excerpt:

"Briefly, it is essential to the Hopkins invention and to the claims and disclosure of the Hopkins patent that the pressure reducing valve 9 be located between the nozzle and the branching point in the main air supply concuit where, on the one side the air conduit goes to the noz-

zle and on the other side the air conduit goes to the liquid tanks. The location of the valve 9 either on the compressor, as on defendant's device, or at any point between the branching point and the compressor, would effect an entirely different mode of operation and result, and would not constitute infringement. * * *

**Independent Regulation.**

"The whole idea of the Hopkins structure is the complete independence of the regulation of air pressure to the paint supply and to the nozzle. Given a pressure to that main air supply (which, as I conceive it, would in ordinary practice be regulated), there is a further complete independence attained by Hopkins as between the pressure to the paint supplied to his nozzle and the pressure of the atomizing air.

"The pressure in the paint tank can be adjusted up to the capacity of pressure in the main air line, so that it is greater than the pressure of atomizing air, a result not possible in the prior art. On the other hand, it can be adjusted so that it is less than the pressure of atomizing air, and of course less than the pressure in the main air conduit. This latter situation was the attainment of the prior art and is the limit of attainment in defendant's structure. * * * In other words, Hopkins' location of his pressure reducers was an act of genius, and established the universal principle of construction and operation of devices of this sort."

What was a new combination solving an existing problem in the art, and covered by the Hopkins patent, does not appear to be shown to have been infringed by the device sought to be enjoined, hence we find no error in the order of the trial court approving and confirming the report of the Special Master. Morris v. McMillan, 112 U. S. 244; Ray v. Bunting Iron Works, 4 Fed. (2d) 214; Clisby v. Reese, 88 Fed. (C. C. A.), 645; Sperry Mfg. Co. v. Owens Co., 111 Fed. (C. C. A.), 388.

The decree of the court below is affirmed.

**March 4, 1929.**

## SECOND SUIT DISMISSED

ALLIANCE SECURITIES COMPANY, APPELLANT, v. FORD MOTOR COMPANY, APPELLEE. No. 5558, CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT.

THE device used by the appellee, designated as "Sparko," for spraying paint, was found by the Court to be closely in accord with the art prior to the patent which it was alleged to infringe, and the device was therefore held not to constitute an infringement.

The patent considered in this case, covering a device for atomizing and spraying liquids, is the same as that involved in the case of the same complainant against the Roman Paint Company. Appeal from the District Court for the Northern District of California.

Before Gilbert and Dietrich, circuit judges, and Norcross, district judge. The full text of the court's opinion, delivered by Judge Norcross, follows:

This is an appeal from a final decree dismissing appellant's complaint, with costs. Appellant filed its bill in equity for an injunction based on alleged infringement of Letters Patent, No. 1196-691, commonly referred to as the Hopkins patent.

This case presents a similar question to that involved in the case by the same complainant against Roman Paint Company, contemporaneously decided.

The device used by the appellee, and alleged to infringe the Hopkins patent, is designated in the record as the "Sparko." It is manufactured in Boston by a paint spraying equipment company, and purchased in the open market by appellee.

The "Sparko" apparatus in principle is very closely in accord with the Fisher and Burdick patents, which antedated the Hopkins patent. With the "Sparko" device the pressure in the paint tank may be equal but can never be greater than the pressure in the atomizing air line.

This fact we think is conclusive of the question of infringement.

The decision of the court below is affirmed.

## MARCH 22

# *Fur Bleaching and Dying Method*

STEIN FUR DYEING CO., INC., v. WINDSOR FUR DYEING CO., INC. EQUITY NO. 3315, DISTRICT COURT FOR THE EASTERN DISTRICT OF NEW YORK.

PATENT No. 1564378 for an improvement in bleached and dyed furs, and Patent 1573200 for a process for bleaching and dyeing furs and the like, were held to be valid and infringed. The defendant treated furs by applying a reducing compound and subsequently bleaching them in preparation for the dyeing operation and by virtue of this fact was found to be a contributory infringer as to claims 17 to 20, 23 and 24 of product patent No. 1564378 and claims 15 to 24 of process patent No. 1573200.

The court found that by the use of ferrous sulphate as a protective agent, followed by the use of hydrogen peroxide as a bleach for application to furs in preparation for dyeing, the patentee had accomplished a new result in a new and different way, by the use of old elements, over prior art methods none of which disclosed patentee's method as applied to furs. Similar methods as applied to wool and to fibers were held to be nonanalogous.

Exhibits to prove public use of substantially plaintiff's process before the date of filing of the applications on which the patents issued were furnished, but these were overcome by plaintiff's proof that the patentee had completed the invention prior to the time of such use.

Edward M. Evarts, solicitor for plaintiff; Edward M. Evarts and Richard B. Cavanaugh, of counsel. Everett & Rook, solicitors for defendant; Russell M. Everett and Harry B. Rook, of counsel.

## MARCH 25

# *Electro-Chemical Preventative For Corrosive Action in Pipes*

EX PARTE MILLS. APPEAL NO. 1430, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1705197 was issued March 12, 1929, to Ronald V. A. Mills for electro-chemical method of and means for protecting the interior of pipes against corrosion, on application filed December 5, 1924.

A foreign patent disclosing clearly the idea of protecting cast iron pipes from corrosion by interposing a removable section of zinc or tin alloy between adjacent pipe sections was held to constitute an anticipation of claims 2 and 3. The appellant's contention that the foreign reference should be given a strict interpretation as the disclosure did not respond to certain limitations in the claims was not sustained since the limitations were for immaterial or uninventive details.

Additional claim 4, submitted for consideration, and containing the limitation that the outer shell of the protective device shall have substantially the same thickness as the adjacent piping and another limitation to the effect that the exterior diameter of the coupling is substantially greater than the exterior diameter of the pipe, was found to be sufficiently limited to be patentable.

Munson H. Lane for applicant.

**Two Claims In Issue.**

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Henry and Redrow) follows:

This is an appeal from a final rejection of two claims numbered 2 and 3. Claim is reproduced for illustrative purposes, and is as follows:

"2. A device for protecting the inte-

rior of iron and steel pipes against corrosion, comprising a removable section located intermediate adjacent lengths of pipe, and consisting of an outer steel shell and an interior casting of zinc of substantial thickness, the internal diameter of the zinc being the same as that of the pipe."

The reference relied upon is: Smith, British No. 921, March 26, 1872.

Appellant is claiming a device for protecting the interior of iron and steel pipes against corrosion. The device claimed is a removable section located intermediate adjacent lengths of pipe to be protected and consisting of an outer steel shell and an interior casting of zinc of substantial thickness, the internal diameter of the zinc casting being the same as that of the pipe sections. The theory of operation of the protective device is that the zinc being more electropositive than steel or iron will produce a current flow resulting in corrosion of the zinc rather than of the steel or iron of the pipes. By making the zinc casting of substantial thickness and removable, corrosion will be resisted for a relatively long time and finally the casting can be removed and a new one substituted therefor.

Appellant urges in support of the patentability of the claims that the disclosure of the reference is uncertain and, being a foreign patent, should be interpreted strictly. It is also urged that, even giving a liberal interpretation to the reference disclosure it does not respond to certain limitations contained in the claims.

**Strict Interpretation Denied.**

Touching the interpretation to be placed on a foreign patent as a reference, we do not understand the law to be that such a reference should be discarded because of uncertainty of disclosure where the uncertainty relates to immaterial or uninventive details. In the present case the reference clearly discloses the idea of protecting cast iron pipes from corrosion by interposing a removable section of zinc or tin alloy between adjacent pipe sections. Obviously it is of no patentable consequence whether the protecting section be of zinc or zinc alloy.

The reference also states, see page 3 of the specification, that for larger sizes of pipes it may be more economical to make the couplings, i. e., the removable protecting device, of some cheaper metal and coat or cover it wholly or partially with the alloy. This, we think, is a fairly definite disclosure of a coupling having a body or coating of protective alloy and a covering of steel or iron.

The statement in the claims that the zinc casting is of substantial thickness, in our judgment, is not a patentable dis-
There is a statement in the specification of the reference to the effect that the
tinction over the reference disclosure.
protective device shall be applied to the pipe sections in such manner that it shall offer as little obstruction as possible to the passage of liquid through the pipes. This, we think, means that the internal diameter of the protective device shall be the same or substantially the same as that of the pipe sections. It is our conclusion that the appealed claims differ, if they differ at all, from the reference by immaterial and unpatentable limitations.

**New Claim Presented.**

Appellant has presented for our consideration an additional claim numbered 4 and asks that we approve its admission and allowance. The examiner states that he does not regard the proposed claim as patentable.

The claim contains two limitations not found in the reference. One limitation requires that the outer steel shell of the protective device shall have substantially the same thickness as the adjacent piping. The other limitation is to the effect that the exterior diameter of the coupling is substantially greater than the exterior diameter of the pipe.

It is our view that these differences in details of construction are sufficient to warrant an allowance of the proposed claim. Since the proposed claim is drawn along the lines of the appealed claims, but is more limited, we approve the admission and allowance of the proposed claim in the absence of more pertinent art than that cited on the appeal.

The decision of the examiner rejecting Claims 2 and 3 is affirmed.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

# Structure of Decorative Candle

EX PARTE DECKERT. APPEAL NO. 1440, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1704729 was issued March 12, 1929, to Danvers O. C. Deckert for a decorative candle and method of making the same, on application No. 195264, filed May 31, 1927.

The decision of the Examiner rejecting claims 1 to 4 was reversed. Claims 1 and 2, relating to appellant's decorative candle comprising a body of wax or like material having an elongated dowel rod embedded axially therein, the Board found was not anticipated by a reference disclosing a means for attaching a window-weight cord to a sash, the arts being quite dissimilar.

The method of making the candles, including the use of a weighted dowel rod to facilitate the dipping operation, was found not to be disclosed nor suggested in either of the patents cited as prior art.

Rippey and Kingsland for applicant.

Before Moore, Assistant Commissioner, and Examiners-in-Chief Ruckman and Landers. The full text of the opinion of the Board follows:

This is an appeal from the action of the examiner finally rejecting claims 1 to 4, inclusive. Claims 1 and 4 are illustrative and read as follows:

"1. A candle comprising a body of wax or the like, an elongated dowel rod completely embedded axially in a body of wax or the like and having a longitudinal hole in its upper end opening laterally to one side of said dowel rod, and a wick extending downwardly and laterally through said hole."

"4. The method of making a candle which consists in successively dipping into molten wax and withdrawing therefrom a dowel rod having its lower end weighted so that it will sink readily into the molten wax, and then cutting the candle and the dowel rod transversely above the weighted end of the dowel rod, and applying a coating of wax to the cut end of the dowel rod."

The references relied upon are: Periera, 803848, Nov. 7, 1905; Sidwell, 1,598,454, Aug. 31, 1926.

Claims 1 and 2 are drawn to a decorative candle and claims 3 and 4 to the method practiced in making the candle.

Apellant's candle comprises a body of wax or like material having an elongated dowel rod embedded axially therein. The upper end of the dowel rod is centrally perforated for a short distance and then the perforation is carried laterally through the side of the dowel. The wick is passed through this central opening and its end is directed through the lateral opening and tied in a knot to firmly anchor the wick against removal from the end of the dowel in the completed candle.

The wax is deposited upon the dowel by dipping. In order to facilitate this operation appellant has mounted a weight on the lower end of the dowel. After the dipping operation the lower end of the candle including the weight and the portion of the dowel to which it is connected is severed from the remainder of the candle and the lower end of the latter is covered with a coating of wax to conceal the end of the dowel.

The patent to Sidwell discloses an ornamental candle having an outer wax portion and a central reinforcing dowel. In the form shown in Figs. 4, 5 and 6 the dowel is provided with a longitudinally extending opening or slot throughout its length and the wick is located in this opening. Sidwell forms the candle body first and then provides it with an axial bore in which he places the dowel. The patent to Pereira, however, discloses that it is old to form candles by the dipping process. The latter patent has no reinforcing dowel rod.

Claims 1 and 2 were rejected on Siddell on the ground that there would be no invention in anchoring the wick in the upper end of the dowel rod in this reference in a manner similar to that employed in attaching a window weight cord to a sash.

The examiner has not cited any references to show the exact structure he has in mind but in any event we deem the claims limited to a specific art which is so different from that of windows that features in the latter art would not suggest modifications in the former. We deem these claims patentable over Sidwell.

The method set forth in claims 2 and 4 is neither disclosed nor suggested in either of the patents. Neither patent discloses the use of a weighted dowel rod to facilitate the dipping operation. We believe this method is not fairly anticipated by the art relied upon by the examiner.

The decision of the examiner is reversed.

## MARCH 26

# *Hinge for Racks in Fruit Cars*

JOHN A. MASSIE, TRUSTEE, PLAINTIFF, v. FRUIT GROWERS EXPRESS COMPANY, DEFENDANT. EQUITY NO. 673, DISTRICT COURT FOR THE DISTRICT OF DELAWARE.

PATENT No. 1588948 for a hinge connecting the several panels of slatted racks used upon the floor of fruit and vegetable cars for the purpose of providing better drainage and ventilation was held to be valid over the defenses of public use, implied shopright, and that the patentee was not the true inventor.

The defendant's contention that David McEwan and not Edward A. Downey was the inventor was not sustained, the court concluding that the finding of the Patent Office, in an interference proceeding between Mr. McEwan and Mr. Downey as joint inventors and Mr. Downey as sole inventor, that Mr. Downey invented the hinge, was correct.

Within the meaning of the statute a case of public use was not established, the court ruled, where the evidence showed that two of the hinges had been made in defendant's shop and attached to two sections of floor rack and their practicability demonstrated before officials of the company, for the reason that this use amounted only to experimental use.

The attempt by defendant to establish a case of public use by oral testimony introduced to prove it equipped the racks for one of its cars with a full set of the patent hinges and then released the car for use in the usual manner was not successful, the oral evidence not being so "cogent as to leave no reasonable doubt in the mind of the court that the transaction occurred substantially as stated."

### No Basis in Fact.

The court held that an implied license to the defendant company, as an employer of the patentee, had no basis in fact since the patentee did not use the employer's time or property to develop the device nor did he assent to the use of the hinge by the defendant company

The full text of the opinion of the court, delivered by Judge Morris, follows:

All the claims of patent No. 1588948 granted to Edward A. Downey, June 15, 1926, on an application filed March 6, 1925, are here in issue. The device called for by the claims is a hinge connecting the several panels of slatted racks, used upon the floor of fruit and vegetables cars to allow better ventilation and refrigeration, so as to permit the folding of the panels face to face or back to back. The plaintiff, John A. Massie, Trustee, is Downey's assignee.

The defendant, Fruit Growers Express Company, though conceding that it has manufactured and used for its ventilating racks the identical hinge of the claims, nevertheless denies liability therefor. It plants this denial upon three grounds: (1) that David McEwan, not Downey, was the inventor; (2) that the device was in public use before March 6, 1923; and (3) that the defendant has an implied license or shopright.

During the fall of 1922 the defendant decided to begin the general use of floor racks in its cars. No hinge then in use for connecting the panels was found entirely satisfactory. The employes became interested. On April 28, 1923, McEwan, foreman in charge of the installation of the racks and Downey, mill carpenter, filed a joint application for a patent for the hinge now used by the defendant. Patent No. 1476397 issued to them December 4, 1923. Thereafter, Downey, conceiving that McEwan's contribution was not of the character to make him a co-inventor, applied for and, after decision in his favor in the interference declared between his sole application and the joint patent, in which proceedings McEwan appeared, obtained the patent in suit.

### Patent Office Findings.

By reason of these facts the plaintiff takes the position that the doctrine of Morgan v. Daniels, 153 U S. 120, applies in the case at bar and that the findings of the Examiner of Interferences, from which McEwan did not appeal, must here prevail against defendant's contention that McEwan was the inventor unless that finding is overcome "by testimony which, in character and amount, carries through conviction."

Defendant counters with the contention that as it was not a party to the interference and as McEwan is not a party here, the decision of the Patent Office is without bearing upon the present issue. Sarfert Co. v. Chipman, 194 Fed. 113, 116 (C. C. A. 3). The difference between the parties upon this sub-

ordinate question is one of degree only. It is obvious that no estoppel runs against the defendant.

Decisions of the Patent Office upon the issue of originality and priority are never final, even with respect to the parties to the interference proceeding. They are subject to examination by the courts. Reckendorfer v. Faber, 92 U. S. 347, 352, 354-5. Yet, such decisions, even when they do not come literally within the scope of Morgan v. Daniels, cannot do otherwise than, in some, though varying degree, depending, among other things, upon the number of the administrative tribunals concurring in the decision, Stonemetz Printers' Machinery Co. v. Brown Folding Mach. Co, 57 Fed. 601, 604, affirmed 58 Fed. 571 (C. C. A. 3), the character and amount of the evidence there adduced and the extent to which the decision itself carries conviction, add to and strengthen the presumption attaching to a patent granted ex parte that the patentee is the inventor of its subject matter.

The true question here, as in all cases of this character, is whether the evidence in opposition to the patent is or is not sufficient to overcome that, including the presumption of validity, presented in its favor.

The evidence is conflicting. Downey testified that in January, 1923, when the matter of obtaining a suitable hinge was one of general interest among defendant's employes, he made a pencil sketch of the hinge on a board, here in evidence, showed it to McEwan, explained to him its mode of operation, and that on the following Monday McEwan, defendant's foreman in charge of its floor racks, brought in on a cardboard, now lost, a drawing of that hinge.

That the pencil sketch upon the board in evidence fully illustrates and discloses the subject matter of the invention is, apparently, neither questioned nor open to question. McEwan, however, denies that Downey exhibited to him the pencil sketch or made to him any suggestion with regard to the hinge. He asserts that he conceived the hinge and made his sketch without any aid whatsoever from any one Each states that the other was permitted to join in the application for the joint patent solely because of that other's assistance in obtaining the patent.

### Patentee Held Inventor.

There is no direct evidence upon this issue. In defendant's view the circumstantial evidence, consisting of the subsequent conduct, behaviour and acts of the two men, is reconcilable only with the story of McEwan. But when it is remembered that McEwan was the foreman in charge of the racks and that Downey was a mill carpenter having nothing to do with racks, the difference in their conduct seems entirely consistent with their respective tasks, without regard to whether the hinge was the invention of the one or the other.

Regardless of McEwan's present recollection of the matter, I am convinced that the finding of the Examiner of Interferences, that Downey invented the hinge, made a complete disclosure of his invention to McEwan and that McEwan's drawing was merely a reduction of Downey's disclosure to the precise dimensions required for use with lumber of the size employed for the racks, was entirely correct.

Was the hinge in public use before March 6, 1923? Late in January or early in February of that year, soon after the completion of his drawing, McEwan with Downey's knowlege caused two hinges to be made in defendant's blacksmith shop, to be attached to two sections of floor rack and their utility or practicability for defendant's purposes tested, or, to use Downey's term, "demonstrated," in defendant's yard in the presence of Anderson, the company's mechanical engineer, Smith, the shop superintendent, Schulze, the general foreman, McEwan, Downey, and one or two others connected with the company. At this test the rack sections were folded face to face and back to back.

The hinges worked satisfactorily in every particular. The test, so far as it went, was completely successful. No injunction of secrecy was placed by Downey upon McEwan or any other person present at the test. These undisputed facts, the defendant contends, make a clear case of public use more than two years before the date of Downey's application for his sole patent and hence a bar to the validity of the patent obtained upon that application. The use was in public and by the public It was a public use within the contemplation of the statute unless it was experimental, conducted in good faith to test the qualities of the invention and for no other purpose not naturally incidental thereto.

Viewed from the company's standpoint the use was manifestly, purely experimental. The two hinges tested were the first that were made in accordance with Downey's invention. The use was of two hinges, not of a full set of sixteen

required for a car. Their use was not in a car but in the yard near the shop.

The vital question, however, is not whether the use was an experimental one from defendant's commercial viewpoint, but whether it was experimental and not public within the meaning of the patent statutes. The question seems no longer an open one. In many cases it has been decided that a use in public for experiment or test is not a public use within the acts of Congress, nor a use evincing a dedication of the invention to the public. Elizabeth v. Pavement Co., 97 U. S. 126.

In United States Rifle, etc. Co. v. Whitney Arms Co., 2 Ban. & A. 493, Fed. Cas. No. 16793, Judge Shipman declared "It does not appear to me that the submitting of an invention to the test of examination by experts, in competition with other inventions, is the public use to which the statute refers. A use for the mere purpose of competitive examination, experiment and test is not a public use."

Judge John Lowell in Sinclair v. Backus, 4 Fed. 539, held that a use is not a public use in a patent sense where, in order to test its comparative as well as its absolute utility, and in order to convince others of its merits, an inventor permits them to try, by use, his invention after he has himself become satisfied that it is useful In Pennock v. Dialogue, 4 Wash. C. C. 538, Fed Cas No. 10941, it was expressly decided that "It is clearly immaterial whether the experiment be made by himself, or by others." I think defendant's use of the two hinges was not of a character to destroy the validity of the patent.

Sometimes later the defendant equipped the racks for one of its cars with a full set of sixteen Downey hinges, made at its blacksmith shop, placed the racks so equipped in the car and then "released" the car for use in the usual manner. With respect to this car two questions arise—first, was this use of the Downey hinge before or after March 6, 1923, and, second, was this use an experimental or a public use. Defendant was unable to produce any record, or other written evidence, identifying the car that was so equipped or fixing the date the hinges were made or put in the car. To establish that this use was more than two years before the date of Downey's application the defendant is compelled to rely upon oral testimony.

Five witnesses, testifying more than five years after the event, fix the date upon which a car was first equipped with racks connected by the Downey hinge as February, or late January, 1923 The only aids to their memory are the recollection that the equipment of the car with the hinge was within a short time, a week or ten days, after the inspection of the racks in the yard, and a further recollection that it was before the completion of a certain car shed that was finished between the middle and the 25th of February, 1923.

I do not question the honesty of a single one of these witnesses. Yet, before a court is permitted to find a prior public use, it must be satisfied "by evidence so cogent as to leave no reasonable doubt in the mind of the court, that the transaction occurred substantially as stated." Deering v. Winona Harvester Works, 155 U. S. 286, 301. Human memory is far from infallible. In the matter of dates experience has found it especially imperfect. Brooks v. Sacks, 81 Fed. 403 (C. C. A. 1). McArthur v. Sears, 21 Wend (N. Y.) 190, 192. Coble v. Grant, 3 N. J. Eq. 629, 63.

### Claim of Public Use.

Other things being equal the clarity and certainty of memory with respect to an occurrence vary with its recency. It is well known that memory frequently tends to confuse the dates and relative times of the happening of similar or related events. To require the unaided memory to fix with absolute precision the particular month in which a certain event took place more than five years past imposes upon it a task for which it is seldom equipped. Again it is not possible to conclude with reasonable certainty that the association of the completion of the car shed and the Downey hinge in the minds of the witnesses did not arise from the advent of the Downey hinge and the yard test of the two hinges, rather than from the equipment of the first car with that hinge.

Moreover, there is affirmative evidence that casts doubt upon the accuracy of the recollection of defendant's witnesses. One Demory became an employe of the defendant company on March 12, 1923. He was put to work on floor racks. The first hinges attached by him were another type known as the "Gascoigne", that was then being generally used by the defendant. Later he went to the blacksmith shop with McEwan, got a full set of Downey hinges, put them on racks for a car. Sweeley, Schulze, Smith and Anderson went down to look at them. The racks were then put in the car. The defendant contends that this was not

the first full set of Downey hinges but another later set. Their inspection by the company's mechanical engineer, the shop superintendent, the mechanical superintendent, the general foreman and others casts grave doubt upon the accuracy of this contention.

Again, the Downey hinge was not put in general use by the defendant until June, 1923. It seems obvious that any one or more blacksmith-made sets put in use in cars prior to that time were so used for experimental purposes. I think the patent in suit is valid

I find no premises of fact upon which a conclusion that the defendant has an implied license or shopright can be based. It is true that at the time he made and disclosed the invention to the defendant, Downey was one of its employes. His work, however, was that of mill carpenter. It had nothing whatever to do with floor racks or floor-rack hinges. In no sense can it be said that his invention was made in the course of his employment. Nor did he use the time or property of his employer either to develop or to put his invention into practical form.

The most that can be said is that he permitted the defendant to make and experiment with the hinge in order that they might be convinced, as he already was, of its merits. He did not assent to the use of the hinge by his employer. The company was notified of the application for the joint patent and its grant.

Soon after its grant an offer to sell it to the company was made and refused. Later, in September, 1925, the company prepared an assignment to it of the shoprights under the patent Downey and McEwan refused to sign it. Downey was told that he could have "until four o'clock to think it over." He construed this to be a discharge and left the company. At defendant's request he returned and has since continued in its employ. His attitude with respect to his monopoly has not been different since the granting of the patent in suit. Downey has received from the defendant nothing whatever in time, money or materials for his invention, and he has done nothing to stop him from denying that defendant has a shopright. I think it has none. Solomons v. United States, 137 U. S. 342, 346

The prayers of the bill of complaint must be granted.

## MARCH 27

# *Making Gasoline from Natural Gas*

CARBIDE & CARBON CHEMICALS CORPORATION, APPELLANT, v. THE TEXAS COMPANY, APPELLEE. No. 5346, CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT.

ALL the claims of Patents 1465598, 1429175 and 1523314, relating to the manufacture of natural gasoline from natural gas, were held to be invalid for want of invention and for anticipation.

The court stated that the processes of extracting from the natural gas as much as possible of the less volatile constituents, one by compression and one by absorption, were old in the industry, and that the patents in suit relate to the stabilization step which follows the extraction step.

It was found that the use of the rectifying column in lieu of the weathering process for reducing the volatility of the raw natural gasoline to bring it within permissible limits for use was followed by a very substantial increase in the yield.

Patent No. 1465598, however, directed generally to the process of rectification at any temperature, was held to be too broad to be valid, as rectification had been used in numerous industries including the benzol, Blau gas, and others, and its application to the taming of natural gas was uninventive; it being stated that the law is well settled that it does not show invention to apply an old process to a new subject, without the exercise of the inventive faculty. Also, a prior patent, No. 1415058, contained a suggestion of the use of rectification for stabilizing natural gas gasoline.

**Found to Be Void.**

The invalidity of Patent 1429175 was based on the ground that the product claims of the patent amounted to no more than the making of a chemical analysis of the product of the process of Patent 1465598, in specifying the difference in the degree or proportion of the constituents.

Patent 1523314 was held to be invalid

because the claims covered the necessary result of rectifying natural gasoline, and because of the prior art disclosing the process.

John A. Mobley, F. P. Warfield, L. A. Watson (Mayer, Warfield & Watson; Andrews, Street, Logue & Mobley, on the brief), for appellant. Brady Cole, R. J. Dearborn, Merrell E. Clark (Frederick F. Fish; Daniel Stryker; Baker, Botts, Parker & Garwood, on the brief), for appellee.

Before Walker and Bryan, Circuit Judges, and Grubb, District Judge. The full text of the opinion of the court, delivered by Judge Grubb, follows:

This is an appeal from a decree of the District Court of the United States for the Southern District of Texas, dismissing the bill of complaint of the appellant (plaintiff) against appellee (defendant) for the alleged infringement of patents numbered respectively, 1465598, issued to DeBrey, 1429175 issued to Thompson and 1525314 also issued to Thompson. Title to all three patents was vested in plaintiff at the time of the filing of the bill of complaint, and of the infringement.

Infringement is alleged of claims 1, 3, 4, 9 and 10 of the DeBrey, and claims 2 and 3 of the first Thompson, which are process claims, and of claims 7, 8 and 9 of the first Thompson, and 1, 2, 3, 4, 5 and 6 of the second Thompson, which were product claims.

The infringement is based on the use of a rectification column by the defendant at its Burkburnett plant for reducing raw natural gasoline to a proper vapor tension to make it a marketable product. The defendant concedes infringement of all the process claims of the patents sued on and all, except two, of the product claims, infringement of which is denied.

The defense against the claim of all three patents is invalidity for want of invention and anticipation. The District Court adjudged all of the claims of all the patents invalid for want of invention and for anticipation in a thorough and well considered opinion, with which we agree, and which we adopt, and which renders unnecessary a very extended review of the law and facts of the case by us.

The opinion of the District Judge is reported in 21 F. (2) 199. The patents in suit have also been adjudged invalid by the District Court of Delaware in the case of Carbide and Carbon Chemicals Corporation v. Phillips Petroleum Company, reported in 28 F. (2) 218.

The material in connection with which the claimed inventions of the patents in suit have their most important use is natural gas gasoline, also known as natural gasoline. Natural gas is obtained from gas and from oil wells. It is a mixture of a number of hydrocarbons, which differ from each other in boiling points. Natural gas contains hydrocarbons, which, when isolated, are so volatile as to be gaseous at normal pressures and temperatures, and also hydrocarbons which are less volatile and, when isolated, are normally liquid, but carried with gaseous ones in natural gas.

Natural gasoline is a liquid mixture of the less volatile hydrocarbons, separated from the natural gas. Excessively volatile natural gasoline is dangerous to handle or transport. Its transportation is regulated, and the measure of volatility prescribed by such regulations is its "vapor tension," which is determined by physical tests.

In the manufacture of natural gasoline from natural gas the first step consists of extracting from the natural gas as much as possible of the less volatile constituents; the processes of extraction leave with the raw gasoline extracted too much highly volatile constituents, which makes the mixture too volatile for shipment or use. Two processes of extraction, one by compression and one by absorption, were old in the industry.

The patents in suit do not relate to the extraction step, but to the stabilization step, which follows it. The stabilization step consists of reducing the volatility of the raw natural gasoline extracted to bring it within a permissible limit for use. In the early days of the industry the raw gasoline was stabilized by a process called in the industry "weathering" and consisting merely in subjecting the raw material to the atmosphere in open tanks, until enough of the more volatile constituents had evaporated to reduce the volatility of the residue to a safe limit.

This process involved the loss of a considerable amount of material, which might have been included in the final product because the more volatile carried off with them substantial quantities of less volatile constituents. In the early days of the industry the raw material was abundant for the demand, and the cost of the weathering process insignificant, and the incentive to improve the process not great.

Another method of stabilization was by "blending" the more volatile raw gasoline with less volatile naphtha, re-

ducing the volatility of the mixture to a safe point. For many years "blending" was a profitable operation. In later years because of the increased price of naphtha and the increased cost of its transportation, the practice of blending has diminished. The process of weathering involves the making of a separation between more volatile and less volatile constituents by simple distillation, which cannot produce a sharp cut and involves a substantial loss of valuable constituents.

As the demand for gasoline increased, there came a tendency to make producing plants more efficient and this caused the use, as a substitute for weathering, of the rectifying column. This is a more efficient form of distillation apparatus than the weathering tank. It makes possible a closer separation between constituents of different volatilities than can be accomplished by simple evaporation with the weathering tank.

The greater efficiency of the rectifying column over the simple still, where a close separation is desired, has caused it to take the place of the still in many industries, among them the natural gasoline industry. The closer is the separation, the larger becomes the yield. The substitution of the rectifying column for the weathering tank in the natural gasoline industry was followed by a very substantial increase in the yield.

The process described by the DeBrey specification and covered by the claims sued on is no more than the rectification of mixtures of hydrocarbons and particularly of natural gasoline under the third claim. The method to be employed is the ordinary rectification column, as known and used in other industries. No new process of rectification is described or claimed in the patent.

The claim of DeBrey that his rectification was to be carried on at a "suitably low temperature" merely means a temperature such as will produce the desired and predetermined result. So a "superatmospheric pressure not exceeding 20 atmospheres" adds nothing to the ordinary process. We construe DeBrey's patent to cover rectification at any temperature, and at any pressure, and so to cover rectification generally.

No drawing of the rectification column to be employed accompanied the original application of DeBrey. The examiner called for one and DeBrey's attorneys replying asked that the requirements of a drawing be waived, stating "that any rectification apparatus capable of operating under pressure is suitable." This clearly indicates that no stress was placed on any new rectification apparatus by the applicant.

The novelty in the DeBrey disclosure, if any, was in the suggestion that rectification, as theretofore in use, in numerous industries including the benzol, Blau gas and others, be applied to the taming of natural gas gasoline in substitution for weathering and blending. This would apply only to claim 3 which is the only claim limited to natural gas gasoline.

The law that it does not show invention to apply an old process to a new subject is well settled. In Brown v. Piper, 91 U. S. 37, the Supreme Court said, in rejecting a patent for want of invention:

"The answer is, that this was simply the application by the patentee of an old process to a new subject, without any exercise of the inventive faculty, and without the development of any idea which can be deemed new or original in the sense of the patent law. The thing was within the circle of what was well known before, and belonged to the public. No one could lawfully appropriate it to himself, and exclude others from using it in any usual way for any purposes to which it may be desired to apply it."

The plaintiff seeks to do the inhibited thing. It seeks to appropriate to itself the old rectification process, and exclude others from its use in the old and usual way, as applied to the natural gas gasoline industry. This it could not do even if DeBrey had been the first to suggest the use of the rectification column in the natural gas gasoline industry. We think Schill & Woidich, in the application to their patent (No. 1415058), anticipated DeBrey in the suggestion of the use of rectification for stabilizing natural gas gasoline, and also in describing a suitable rectification apparatus for accomplishing that result.

We think all the claims of the DeBrey patent (except claim 3), all of which cover the rectification of hydrocarbons generally, are anticipated by many patents covering rectification, and that claim 3 is anticipated by the disclosure of Schill & Woidich; that DeBrey's specifications and claims, covering no new process of rectification, but merely applying old processes to the natural gas gasoline art, contain no invention; and that all the claims of DeBrey are therefore invalid for want of invention and for anticipation.

What has been said of the DeBrey patent applies equally to the process claims

of the first Thompson patent (No. 1429-175). The application of DeBrey was filed in the Patent Office three years before the application of Thompson for his first patent. To be sustained, claims 2 and 3 of the first Thompson patent, which are the process claims, must contain something different from the process disclosed by DeBrey.

On the contrary, the specification of the first Thompson patent, as relates to the process claims, describes only the ordinary rectification of natural gasoline by old and customary methods of rectification. His apparatus is of the conventional type, and is operated in the ordinary way a rectification column would be operated for reducing the vapor tension of a mixture. His process claims are invalid, not alone for the reasons that make DeBrey's claims invalid; but, in addition, because they are anticipated by DeBrey's disclosure.

The product claims of the first Thompson patent (Nos. 7, 8 and 9) must describe a substantially different product from that obtained by the rectification in the ordinary way of natural gasoline to be valid. The validity of the claims is based on the presence of an increased amount of butane, and a decreased amount of propane, and the discovery that butane could be left in the liquid mixture in greater quantities, if propane was more thoroughly eliminated from it.

If the product of the Thompson claims is the product of rectification of natural gasoline in the ordinary way, then it would not be patentable. The owner of a patented process could not be deprived of the use of his process by a later patent acquired by another on the product of the process. The product of DeBrey's patented process could not be appropriated by Thompson, if both are the result of the same process.

If what Thompson accomplished by his product claims, amounted to no more than the making of a chemical analysis of the product of the DeBrey process, and an expression of the result, it clearly was not the disclosure of a substantially different product from DeBrey. The discovery by analysis that a reduction in the propane content of the mixture would enable the butane content to be materially increased, and with it an increase in the yield of the resulting gasoline, would not involve invention. This would amount only to a difference in the degree or proportion of the constituents.

It is settled law that a mere difference in proportion of the constituents is not patentable. In the case of Bituminous Products v. Headley, 10 F. (2) 673, the court said:

"The new product must differ from the old, otherwise than in degree; to support a patent the new characteristics of the patent must be other than, or not confined to, the mere augmentation or diminution of the known characteristics of the several ingredients which is in correlation with the increased or diminished amount of the respective ingredients entering into the composition."

What Thompson did was confined to a determination by chemical analysis of the characteristics of the product resulting from the ordinary rectification of natural gasoline, and by reducing the propane content and thereby increasing the amount of butane possible, also increasing largely the yield. At most it was a change in degree of constituents and not in identity from prior products. There was still present some prppane, and only more butane. As Thompson differed from DeBrey only in following his rectification process by an analysis of the product obtained by it, which failed to disclose a different product, DeBrey anticipated Thompson in the resulting product.

The claims of Thompson's second patent (No. 1523314) are all product claims, and in order not to be barred by Thompson's first patent must distinguish over what is disclosed in the first Thompson patent as much as if the author were a stranger. They also were made invalid by the disclosure of Schill & Woidich and that of DeBrey. As in the case of the claims of his first patent, they are invalid because they cover the necessary result of rectifying natural gasoline. As in the case of the product claims of the first patent, there is nothing disclosed but a difference of degree between the constituents and all prior products. No new product is created. There is an increase of butane, and a decrease of propane, but Thompson's product, as well as the prior products, contained some of each.

The commercial success of the rectification column, when applied to the natural gasoline industry, is only to be considered when the question of validity is a doubtful one. It may also be accounted for by the recent wonderful increase in the use of and demand for gasoline, making the use of more expensive equipment in its preparation profitable.

Our conclusion is that for the reasons indicated the decree of the District Court was correct, and is affirmed.

## MARCH 28

# *Arrangement of Cases in Stores*

EX PARTE CLARENCE SAUNDERS. APPEAL No. 13647, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1704061 was issued March 5, 1929, to Clarence Saunders for a Self-Serving Store, on application No. 512530, filed November 3, 1921.

The rejection of claims 1 to 8 and 10 to 15, for a self-serving store, was affirmed on appeal.

Claim 1, based on the feature of having low display devices at the front and elevated display devices at the rear, was held to be uninventive.

The use of a double turnstile, as set forth in claim 2, the Board found constituted nothing more than mere duplication.

Claims 3, 4, 5, 12, 13 and 14 including basket racks adjacent each entrance of the double gateway, were stated to be unpatentable, as it would be obviously expedient to place basket racks adjacent each entrance if the entrances are duplicated.

The Board ruled that since there was no necessary or mutual cooperation between specific store arrangement and specific cabinet structure with an elevated passage the rejection of claims 6 to 10, covering this arrangement, had been properly rejected as being for aggregations. Claim 9, however, including the walkway between the cases and the cases open at the front and rear, was found to include sufficient construction to define over the art.

Ernest W. Bradford for applicant.

Before First Assistant Commissioner Kinnan, Examiners-in-Chief Skinner and Ide. The full text of the opinion of the Board of Appeals follows:

This is an appeal from the final rejection of claims 1 to 15, inclusive, claims 1, 2, 3, 6 and 11 being illustrative and reading as follows:

"1. In a self-serving store, a lobby, a rear storage section and a main sales section, parallel rows of display units forming a tortuous pathway in said main sales section, personal service sales units extending transversely of the store at the rear of the sales section, and having low display devices at the front and elevated display devices at the rear, substantially as set forth.

"2. In a self-serving store, a front section comprising a lobby, a rear storage section, and a main sales section comprising rows of merchandise containers forming a circuituous path for customers, and a double entrance unidirectional gateway at the inlet to said path comprising oppositely movable turnstiles leading to opposite sides of the entrance aisle of the circuitous path, substantially as set forth.

"3. In a self-serving store, a front section comprising a lobby, a rear storage section, and a main sales section comprising rows of merchandise containers forming a circuitous path for customers, a double entrance turnstile structure at the inlet to said path leading to opposite sides of the inlet and a basket rack adjacent each entrance of said gateway, one of said basket racks extending transversely of the store and forming a part of said pathway, substantially as set forth.

"6. A store for the vending of merchandise having a partition dividing the room into an ante-room or lobby and a sales-room, said partition being constructed to provide an entrance and an exit, closures for the entrance, closures for the exit, series of merchandise display cabinets or holders arranged in rows in the sales-room at distances apart to form aisles and having passageways at alternate ends whereby a continuous circuitous path is formed from said entrance to said exit, a structure adjacent to the terminal path at its exit providing a checking and settlement station, and walk-ways for employes inside said merchandise display cabinets, substantially as set forth.

**Rows of Display Units.**

"11. In a self-serving store, a lobby, a rear storage section and a main sales section, a partition between the lobby and the main sales section, parallel rows of display units forming a tortuous pathway in said main sales section including a central row spaced from said partition, and display devices at the rear end of the sales section extending transversely of the store close to said central row to close the path and to separate the sales section from the storage section, said transversely arranged display devices being spaced from the side walls to provide one or more passages leading to the storage section, substantially as set forth."

The references relied upon are: Saunders, 1242872, October 9, 1917; Saunders, 1357521, November 2, 1920; Davis, 1345481, July 6, 1920; Carroll, 1347936, July 27, 1920; McCarty, 1348024, July 27, 1920.

Claim 1 was rejected on Saunders, No. 1242872, and reads thereon except that it includes a personal service sales station at the rear, between the sales room and the store room, consisting of low display devices at the front and elevated display devices at the rear. The arrangement of low and elevated display devices is only what is usually found in any store and we see nothing inventive in locating such a personal service station at any point where space can be found for it.

Claims 2 and 3 were rejected on the same Saunders patent in connection with McCarty. This claim calls for a double turnstile constituting a double unidirectional entrance to the sales section. Saunders shows at 26 two gates swinging in opposite directions which would constitute a double entrance and McCarty shows two turnstiles but they move in opposite directions and form a single entrance and single exit. We see no invention, however, in merely duplicating a turnstile to allow two lines of customers to enter at the same time, especially in view of the two gates of the Saunders patent. Claims 4, 5 and 14 also involve this double entrance and what has been said applies to these claims also.

Claims 3, 4, 5, 12, 13 and 14 include basket racks adjacent each entrance of said gateway. Both the Saunders patents, Nos. 1242872 and 1357521, show basket racks adjacent the single entrances are duplicated. It is obvious that the basket racks should also be duplicated and there would be no invention in placing another basket rack along the partition 5 in Saunders No. 1242872.

Claims 6-10, inclusive, and claim 15 were rejected as aggregations. We agree with the Examiner that there is no necessary or mutual cooperation between specific store arrangement and the specific cabinet structure with the elevated passage shown in elements 21, 22 and 23, Fig. 2, except that the arrangement of the walk way between two cases enables the inspector to see what is going on in each of the passages. So far as this coaction is concerned, it is old in No. 1242872 which shows a walk way on top of each of the show cases. Claim 9 includes the walk way between the cases and the cases open at front and rear which specific construction is in our opinion sufficient to justify the allowance of this claim.

Claims 6, 7, 8, 9, 10 and 15 were also rejected on Saunders, No. 1242872 taken with Davis or Carroll. All these claims include the walk ways, some of them stating that the runway is inside the cabinets, as claims 6 and 8, while others, as claims 7, 10 and 15, are broader. They also include entrances to the walk ways and some specify steps leading up to the walk ways. In Saunders No. 1242872, there are steps 22 leading to the walk ways on top of the cases and there is nothing patentable in using as many such entrances and steps as are desired, nor do we think there is anything inventive broadly in sinking the walk ways below the top of the cases, see space K in Carroll, and page 1, lines 62-68. We find nothing patentable in these claims except claim 9 which, as before stated, we consider allowable.

Claim 11 was rejected on the same reference as claim 1. This claim is broader than claim 1 in some respects and involves nothing more over the Saunders patents than moving the doors leading to the store room over to the side walls so that the latter forms one side of the door opening. This is a common arrangement of doors in houses and involves no invention.

The decision of the Examiner is reversed as to claim 9 and affirmed as to all the other claims.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

# *Control for Engine's Temperatures*

EX PARTE FRANK J. IRVING. APPEAL NO. 1549, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1704943 was issued March 12, 1929, to Frank J. Irving for thermostatically controlled power actuated means, on application No. 432064, filed December 20, 1920.

The rejection of claim 1 was affirmed on the ground that the thermostat control for the cooling system of the engine disclosed in the reference constitutes an anticipation, although it may

not be as effective in operation as the means disclosed by applicant.

Upon a finding that the plurality of references cited did not show the combination set forth in claims 2 to 8 the rejection was reversed and the claims allowed, the Board stating that the art disclosed no single motor means controlled by a thermostat for controlling both the radiator air shutter and the valve for regulating flow of fluid to the radiator, and that it would involve invention to add to the basic reference independent valve and shutter operators shown in other patents.

Williams, Bradbury, McCaleb & Hinckle for applicant.

The full text of the opinion of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Ide and Landers) follows:

### Appeal From Decision.

This is an appeal from the decision of the primary examiner finally rejecting claims 1 to 8, inclusive, of which the following are typical:

"1. In a temperature controlling apparatus for internal combuston engines, a radiator, shutter means for controlling flow of air about said radiator and engine, valve means for controlling the flow of fluid within said radiator and thermal means responsive to engine temperature for controlling said shutter and valve means.

"2. In a temperature controlling apparatus for internal combuston engines, a radiator, shutter means for controlling flow of air about said radiator and engine, valve means for controlling the flow of fluid within said radiator, means responsive to the running condition of the engine to actuate said valve means and said shutter means and thermal means responsive to engine temperature for controlling said shutter and valve means."

The references relied upon by the examiner are: Thomas, 1241681, Oct. 2, 1917, Rumens, 1390724, Sept. 13, 1921; Rayfield, 1335391, March 30, 1920 (reissued as 16437, Oct. 12, 1926).

Applicant's device comprises a thermostat shown secured to the water tube that connects the upper part of the water cooling chamber of an automobile with the upper part of the radiator. The thermostat, when heated sufficiently by the engine, actuates a balanced valve in a tube which connects the interior of the exhaust manifold of the engine with one end of a cylinder of a motor. Within the cylinder is a piston, the rod of which projects through the other end of the cylinder and is connected with a crank which operates a valve in the water-tube passage. The end of the piston rod is also connected, by means of a wire, with a bell-crank lever having connections for opening the shutters in the front part of the radiator. The shutters are closed by the tension of a spring which tends to yieldingly hold the shutters closed.

### Cites Three References.

Claim 1 was rejected on the patent to Thomas. We agree with the examiner in the rejection of this claim. Thomas shows in a temperature-controlling apparatus for internal combustion engines a radiator 3, shutter means 6, 7, 8, 9, 10 for controlling the flow of air about said radiator and engine, valve means for controlling the flow of fluid within the radiator attached to the movable end of a thermal means b4, responsive to engine temperature, for controlling the shutter and valve means.

The valve closes the passageway in the pipe to the radiator until the heat of the engine heats the thermostat sufficiently to open the valve. When the valve is open a bypass pipe conducts water to a motor 6 having connections with the shutters whereby the pressure of the water in the motor opens the shutters against the tension of a shutter-closing spring.

Applicant denies the operativeness of the Thomas motor, but we belive the motor is operative as described by Thomas, although it may not be as effective as the motor disclosed by applicant.

Claims 2 to 8, inclusive, were rejected in view of the combination disclosed by Thomas. The examiner holds there would be no invention in adding to Rumens such a valve, etc., as is disclosed by Rayfield.

### The Second Claim.

Claim 2 is not met by Thomas because Thomas does not disclose "means responsive to the running condition of the engine to actuate the valve means and said shutter means." This "means responsive," etc. is the motor 18, 19, 20 and connections 32 and 35 of applicant's device. The Thomas device has a means b4 responsive to the running condition of the engine to actuate the valve means but the means b4 does not actuate the shutter means. If we consider the means b4 as the equivalent for the motor 18, 19, 20 and connections 32 and 35 of applicant's device, then we do not find thermal means responsive to engine temperature for controlling said shutter and valve means.

Rumens shows shutter means for controlling flow of air about the radiator and engine, but no means for controlling the flow of fluid within the radiator.

Rayfield shows no shutter means for controlling flow of air about the radiator and engine but shows means responsive to the running condition of the engine to actuate the valve means for controlling the flow of fluid within the radiator. No single motor means, controlled by a thermostat, for controlling both the shutter and the valve is shown in any one patent cited by the examiner and we think it would involve invention to add to Rumens a valve such as shown by Rayfield and actuate the valve by the thermostatically controlled shutter actuating motor of Rumens in the absence of any patent showing such combination of parts, or the combination of equivalent parts, to be old.

Claims 3, 4, 5, 6, 7 and 8 specify the patentable combination stated in claim 2 and are made more specific as to details of construction and we think they may be allowed along with claim 2.

The decision of the examiner is affirmed as to claim 1 and is reversed as to claims 2 to 8, inclusive.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

## MARCH 29

# *Power Machinery for Pressing*

AMERICAN LAUNDRY MACHINERY COMPANY ET AL., PLAINTIFFS-APPELLANTS, v. PROSPERITY COMPANY, INC., DEFENDANT-APPELLEE. CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

CLAIMS 6, 10 and 41 of patent 1379601 and claims 4, 5, 6 and 15 of patent 1489227, directed to power pressing machines for garments and for laundry work where heat and moisture are used, were so narrowly construed in view of prior art as not to be infringed by defendant's structure.

The court stated that while there was identity of result between the operation of the patent device and that made by appellee, identity of result is not the sole test of infringement for there must be identity of means and mode of operation as well.

The invention, including means to prevent the worker's hand from being caught between the two pressing members by so arranging the mechanism that the pressing surfaces can first be brought together only by manual means, and then when so positioned applying the power to effect the pressing operation, the court found, was old in the art and the patented structures differed from the art only as to the means employed.

It was decided that no infringement existed because appellee's machine paralleled a prior patent except that motor means was used in lieu of manual power means to effect the pressing operation, and in view of this the claims in suit were held to a very narrow range of equivalents.

Charles Neave, B. W. Brockett, E. L. Hyde and Maxwell Barus, of counsel for appellant; Drury W. Cooper, Sturges S. Dunham, and Frederick G. Bodell, of counsel for appellee.

Appeal from the District Court for the Northern District of New York.

### For Pressing Garments.

Before Martin T. Manton, Learned Hand and Augustus N. Hand, Circuit Judges. The full text of the court's opinion, delivered by Judge Manton, follows:

This is a suit for infringement of patent No. 1379601 issued to Andree, on an application filed October 31, 1919, and granted May 24, 1921; also of patent No. 1489227 issued to Benjamin & Carroll, on an application filed May 13, 1918, and granted April 1, 1924. Machines made pursuant to these patents are for shaping and pressing garments such as wearing apparel and also for general laundry work where heat and moisture are used. The essentials of the machine comprise a buck—an ironing board—and a head—an iron. They may or may not be coextensive in size, but usually they are coextensive in area. The head is heated by steam or gas. Some are power machines where the maximum pressure is exerted by a motor or belt driven parts. Some are operated by hand or foot. They are old in the art. Of these power driven machines but 30 or 40 were made by

the appellants under the Andree improvement patent and 863 were made under the Benjamin & Carroll improvement patent. Before the trial, appellants ceased making the power driven machine.

The inventions were made to meet the problem of preventing a worker's hand from being caught between the two pressing members. The mechanical contrivance made under the Andree patents makes the machine incapable of being power closed from its normal wide-open position, in which the work is completely visible and accessible. The machine is made fool proof so that the operator cannot upset its cycle of operation. There is no claim of advancing the performance of the machine or making it do better work. The invention is claimed to be an improvement for safety.

Claims 6, 10 and 41 of the Andree patent sued upon are broad. They relate to mechanism in which the press force is applied by power, after the head has been moved by hand to a pressing position. After the work is laid in position on the buck, the head is closed by the foot or hand of the operator so as to bring the head down upon the work to a closed position, after which the head is subjected to the effect of power means which causes it to produce final pressure upon the work.

Because of the heavy power pressure, the inventor proceeds to make the machine incapable of closing the press from full open position and, in the same operation, following through to final pressure. The operation is referred to as an initial closing and a subsequent final closing. It is claimed that this is accomplished by arranging the power closing and the power opening mechanism in undisturbable half cycles so that, once initiated, the power closing or power opening step is compelled to advance to completion. While the power mechanism is in motion, the operator cannot interfere either with such power mechanism or with the operable parts of the machine.

**Means for Locking Press.**

In a machine made under the patent, there is provided "operator operated means for producing a closing movement of the press," a foot treadle or hand actuated mechanism for bringing the head and buck together—which is referred to as an initial closing of the press—a motor means for power source and "final pressure means operated by said motor means." This conveys the final pressure power effect.

Finally, there is provided means actuated by said motor means for locking the press closed during the operation of the final pressure means. This includes the devices which make it impossible to apply final pressure until an interlocking effect is produced by the initial closing of the press. With a locking effect, produced by initial closing of the press, there is a locking effect produced by actuation of the motor means, the operation of the locking means, preventing the press from being prematurely released or opened in its normal operation and from being disturbed by the operator or being interfered with until the final pressure effect has progressed to completion.

The Andree machine has a pedal which, upon depression, causes two levers to be rocked on their pivots and in turn moved a link forwardly and toward the rear, the link being connected to a joint and a toggle composed of links straightening the toggle, thereby rocking the arm or lever and bringing the pressing head down upon the the buck. The head may be pulled down by hand by using a handle attached to it.

Pivoted to the frame of the machine immediately back of the foot treadle is a swinging arm or latch, which, when the treadle of the foot lever is depressed, can be swung to the right over a stud on the back of the foot lever, thus locking the foot lever down with the head closed on the buck. Andree does not have an electric motor or an electric controlling switch for the further operation of the machine, but in the machines made by the appellants the closing of the head upon the lock automatically closes the circuit of the electric motor, whereupon the motor immediately starts.

The first operation performed by the motor is to swing a latch forward and hold it there so as to prevent any possible release of the head until after the motor has performed its first cycle, that is, has applied heavy pressure. And thus, when the machine brings the head down upon the buck, the motor first locks the machine. When the machine is locked by the motor means the motor rotates a gear having on one side a stud extending into a peculiarly shaped cam slot in a pivoted arm, so that the stud revolves. It rocks the arm and thereby further actuates the main toggle and applies final pressure.

When the gear has made a half turn the circuit of the motor is broken automatically by the actuating devices of an electric switch; the motor then stops, leaving the press locked under final pressure. When the operator desires to release the press he presses the release

treadle, which closes the switch again and thus starts the motor. The motor goes through its release operation or pressure-relieving cycle. In this cycle the gear completes its rotation, and in doing so it rocks the arm back to its original position and permits the spring to open the latch so that the press can open.

The Benjamin & Carroll patent provides, in the claims in suit, 4, 5, 6, and 15, for the Andree machine, differing only in the addition of an optional control incapable of effective or pressure-producing use while the press is open, whereby the press might be closed and immediately opened without automatically initiating the final-pressure cycle and whereby the final-pressure cycle might be initiated or not, at the will of the operator.

In this combination of the patent is a "controller for special power means adapted for optional use by the operator for power pressure when the pressure is closed" and "means for preventing effective use of said controller when the press is in an open position." By effective use of the controller it coordinates the Benjamin & Carroll optional controller without Andree's idea that the final-pressure effect must be susceptible of production when the press is open.

The claims in issue are said to be directed and applied to any construction in which there is a means to prevent, when the press is open, any manipulation of the controller which will produce this useful effect. They provide for "automatic means for maintaining said controller in step with the normal operation of the press and ready for the next power operation." This is a means for coordinating the Benjamin & Carroll optional control with the Andree machine so that in the normal operation of the press it is automatically cocked and ready for use when the press has been normally closed to apply the final pressure. And when the final pressure has been applied the press is cocked to release pressure.

The operator control is brought about by mechanism added to the Andree machine to produce power operation at a particular point. In the Andree cycle, after the press has been closed by hand, it prevents effective use of the controller when the press is open and by enabling the Andree machine to function at the proper time when the press is closed. An optional control switch is placed in the circuit beyond the main-line switch, tied in with the timing switch and the motor, and is mechanically actuated by a small lever operated by the operator. The prevention of effective use is secured when the plunger switch is omitted by the organization of the controller with the toggles or jack-knife strut at the back of the machine as well as other interlocks.

### Narrow Improvements.

We do not think the appellee's machine infringes the patent in suit, and it becomes necessary only to consider the prior art, with a view of ascertaining the scope we should place on the claims which, at best, cover narrow improvements in a crowded art. Wayne Mfg. Co. v. Benbow, 168 Fed. 271; Tostevin Cottie Mfg. Co. v. M. Ettinger Co., Inc., 254 Fed. 434. Coextensive head and buck with the heads mounted to swing up and down, as in the patent in suit, were old, as shown in Smith No. 1007148 and Cooper No. 1125968.

Initial closing of the press by the operator followed by optional final pressure is shown in the Betz Patent No. 1089385 and the Tarbox Patent No. 880-934. In the Betz press the operator pulls the head down on the buck by means of a handle. This pushes a rod pivoted on the rear end of a lever on which the head is mounted, and brings the lower notch in the front edge of the rod at the bottom, up to the lever of the upper end of a panel pivoted on the rear end of the foot lever.

As long as the foot lever is held up by the spring, the tail of a pawl is in contact with the bracket immediately below and the upper end of the pawl is thereby held out of engagement with the notch and when, with the head down on the buck, the operator depresses the foot lever, the pawl is raised and the inclined edge of the bracket allows the pawl to swing over and under the notch. Further pressure on the lever pushes the rod upwardly and presses the head down hard on the buck.

When the operator takes his foot off the lever, the latter is raised by a spring whereby the tail of the pawl comes down on the bracket and swings the pawl out of the notch. The press is then opened by a common counterweight on the push rod. After the operator has drawn the head down on the work, he can let it swing up again, if he desires, for the purposes of examining the work or arranging it before giving the final pressure to the work or arranging it before giving the final pressure.

In the appellee's machine, the final pressure is produced by the electric motor instead of by the operator's foot. The two machines are in material respects the same. In the appellee's machine, a lever by which the final pressure is exerted can be rocked by the motor-driven cam without operating the head or affecting the head in any way unless the head is first drawn down on the buck by the operator just as in Betz.

The head of the appellee's machine can be brought down upon the work and permitted to rise again for access to the work without final pressure being exerted, unless with the head down the operator throws in the half revolution clutch and so causes the motor-driven cam to depress the lever. It is just as in the Betz machine where the head can be raised and lowered as often as desired without producing final pressure unless with the head down the operator intentionally presses down with his foot on the lever.

### Final Pressure by Power.

Thus it was old in the art to produce final pressure by power prior to the invention in suit. There may be invention in a particular way or means for applying the power to a pressing machine but not in the idea of using power.

The machine constructed pursuant to the Kouyoumjian Patent No. 1024483 can be operated in both ways with the power applied automatically after the iron has been depressed by the operator or with power pressure at the option of the operator after it has brought the iron down on the work. The operator can, after he has closed the press by foot pressure on the treadle, throw on the power and produce final heavy pressure and he can, by lifting his foot, permit the head to rise again.

In the Baujard patent No. 1070318, a machine is described in which the power-pressing member must be brought down on the body by the operator after which application of power pressure follows automatically. As the patent says, "the hydraulic press enters into action only at the end of the descending movement." The Kouyoumjian patentee has the right to use his invention for every purpose in every way without reference to a late comer, like the patentees of the patents in suit. A later inventor may obtain a patent on an improvement, but he has a narrow patent on the improvement and may not make claim to a basic patent covering broadly all means for obtaining the same or a similar result. An improvement patent must leave the way open for others to obtain the same result by other means.

The Benjamin & Connor patent added the so-called optional control, but they monopolize only the mechanism or thing which they have added and not the function of the thing.

### Half Revolution Clutch.

Cooper in his patent No. 1125968 presents a press different in type but involving the stationary and movable elements of all presses. The two members which normally have wide separations between them are adapted to be brought into engagement with the work and therefore to be brought into line and a power device capable of actual optional operation to apply powerful pressure between the pressing members. The pressing members cannot be brought into engagement during their entire movement by the power alone, but the power has to succeed a manual operation, and the patent provides a lock device which prevents the operation of the power unless the two press members are brought into close neighboring relation.

The Ecker patent No. 818753 shows a quarter revolution clutch. The appellee's machine uses the half revolution clutch. Ecker used a cam which had two high and two low parts which, if it had a single high part and a single low part, would produce the half revolution.

The Freedman patent No. 1141181 shows the half revolution clutch. The operations are controlled by the operator through the medium of a lever. After the press is opened, the operator can swing the lever back again up to its rightward position in order to start the press. When he has done this, the first thing that the machine does is to bring the segment or finger into the engagement with the lug on the arm. This arm is rigidly connected to the control lever so that when the parts are in position, the control lever is locked with the result that the operator cannot throw the lever back into the opening position but on the contrary, he must leave it in the closing position until the machine has completed its pressure applying cycle.

When this cycle is completed, the segment rotating with the shaft on which the driving gear is mounted, is carried out of the path of the lug and the operator may then, whenever he choses, throw the control lever over the opening

position, whereupon the half revolution clutch is thrown in again and the machine opens.

The appellee's machine has a half revolution clutch for transmitting power from the driving motor to the cam which rocks the heavy lever at the bottom of the machine. In the first half revolution, the cam roller is depressed and rocks the forward end of the lever downwardly and so applies the power pressure and the clutch then throws out leaving the motor running. In the second half revolution which is initiated by the operator again depressing the control button, the cam is again connected to the constantly running motor and is carried up to its first position, thereby permitting the head to swing up and down from the buck, after which the clutch is thrown out again.

The argument for infringement of the Andree patent in suit is that there is a first lock which prevents the head from flying up while power pressure is being applied; that there is the second lock for maintaining a cycle and consists of a cam and arm, a pad, rod and hook and its cooperating members on the release treadle, and it is argued that the appellee's machine has two locks which correspond to the first lock of the Andree patent. It is said that it also has a second lock consisting of the cam roller and the other parts and a half revolution clutch.

In the appellee's machine there is a notch and pawl which enable the lever to raise the push rod and so force the head down firmly on the buck, much as is done under the Betz patent. The only difference between the appellee's machine and the Betz machine is that in the Betz the final power is applied manually while in the appellee's machine the final power is applied by a half revolution cam. The power applied by the treadle does not close the press, but the press has to be closed by hand and is provided with the same safety arrangement in the Betz as in the appellee's device.

### Cannot Overcome Power.

While the motor is rotating the cam roller and thereby is pressing the head down on the work, the operator cannot lift the head by pulling upwardly on it, but this is because he does not possess enough power to overcome the power of the motor. The motor is pressing down on the power lever.

The appellee's half revolution clutch is not a lock for what it does is to connect and disconnect the motor to and from the roller cam. When the roller cam is in its down position, the operator cannot lift the head. The same is true of the Ecker machine. The appellants argue that the "undisturbability" is due to the Andree locking means, parts which constitute the "controlling mechanism" for the electric switch mechanism by which, when the press is closed, the electric circuit of the motor is closed and kept closed, the motor running until the motor is stopped.

The two locks and other functions are distinguished by the appellants' expert, who says that the machine of both patents in suit provide mechanisms including two locks, one to prevent the head from flying open or the toggles from breaking when power is being applied, and the other to prevent disturbance by the operator of the machine's cycle during the application of power for its release.

The appellee's machine has no release treadle; no hook to set anything in position for actuation by a release treadle; no bell crank lever to close the switch; no electric switch that must be closed and opened to control the cycle of the machine. In its machine, the motor runs continuously. The half revolution clutch is provided to connect constantly running motor to the cam which rocks the lever and to disconnect the motor from the cam, and a button is provided to control the half revolution clutch.

They differ in operation. The result may be the same in that the power pressure is applied and relieved under the control of the operator. But identity of result is not the sole test of infringement, for with identity of result must go identity of means and mode of operation. Stoehrer vs. Lusse, 7 Fed. (2d) 87.

These patents are not entitled to a range of equivalents which would include the different instrumentalities and mode of operation used in appellee's machine. None of the claims require that the pressing members must be closed by the operator before final pressure means can be set in operation, but they are broad enough in their terms to include a machine in which the pressing members may be closed either by power or by the operator. In view of the state of the prior art, appellants cannot be granted such a range of equivalents. It will receive a narrow interpretation and be limited in its validity to claims constituting an improvement on the prior art. Morley Sewing Machine Co. v. Lancaster, 129 U. S. 263; Greene v. Buckley, 135 Fed. 520.

Limiting the Benjamin & Carroll patent, as we are required to do, there is nothing in the optional control means which appellee infringes. The appellee's machine has no tumbler switch. Its optional control does not in any way affect the motor whereas in the patents in suit, the motor is started by the operator both to apply and relieve power pressure. The claims of this patent all include means for keeping the controller in step with the rest of the press and ready for the next pressing operation so that by no possibility whatever can the operator set the power mechanism in operation when the press is open.

In the appellee's machine, the operator can, at any time, with the press wide open or part way open, throw the half revolution clutch into action and thus cause the power means to operate it, and if he does so the controller will immediately be put out of step and he must again put the power mechanism through its cycle before another power pressure operation can be performed. The appellants' claims in both patents sued on may not be read so as to cover the construction or operation of the appellee's machine.

Decree affirmed.

# *Novelty in Design of Carburetor*

EX PARTE ROBERT F. BRACKE. APPEAL NO. 1437, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1705282 was issued March 12, 1929, to Robert F. Bracke for carburetors, on application No. 526-582, filed November 21, 1911.

The examiner's decision rejecting Claims 3 and 5 for a carburetor having as its novel feature a venturi with fuel passages leading to its throat, made particularly small, whereby inaccuracies in the fuel feed were minimized, was reversed on appeal on a finding that the prior art did not show the novel feature.

Williams, Bradbury, McCaleb & Hinckle for applicant.

Before Assistant Commissioner Moore, Examiners-in-Chief Ruckman and Landers. The full text of the decision of the Board of Appeals follows:

This is an appeal from the action of the examiner finally rejecting claims 3 and 5. Claim 3 is illustrative and is as follows:

"3. In a carburetor, the combination with an induction passage having a secondary air intake opening manually fixed as to size, of a choke for said intake, a venturi tube extending from atmosphere and discharging into said induction passage, a low level supply tank, a pipe connecting the low level supply tank with discharge openings at the throat of said venturi tube, the fixed openings into the induction passage and at the throat of the venturi tube being so small that the suction produced at the fuel openings in the venturi tube at the smallest engine demand will be at least sufficient to lift fuel from the base of the low level supply tank plus a distance seven times as great as the possible variation in fuel level in the supply tank, whereby not more than 14 1-3 per cent change in fuel feeding differential will result from a change of fuel level from the substantially empty to the substantially full condition of the supply tank."

The Basic References.

The references relied upon are: Huene, 1275032, August 6, 1918; Tice, 1300517, April 15, 1919; Chandler, 1373550, April 5, 1921.

The invention relates to a carburetor especially designed for use on stationary engines. The carburetor is constructed to draw by suction gasoline from a supply tank located some distance therebeneath without the interposition of a chamber containing a float controlled valve in the feed line. A venturi tube extends at right angles to and opens into the air intake passage adjacent the throttle valve. The outer end of this tube is open to the atmosphere a baffle plate being provided to prevent gasoline from passing to the atmosphere. The throat portion of the venturi tube contains small openings leading to a surrounding chamber which is connected by a pipe to the low level tank.

The patent to Chandler is the principal reference relied upon by the examiner. Neither of the other patents contains structure responding to the requirements of the claims but the patent to Huene does disclose that it is old to dispense with the float chamber and draw gasoline directly from a low level tank to the carburetor by the suction of the engine. The Chandler patent has

a float chamber 4 but the examiner holds this is immaterial in view of Huene's disclosure.

Appellant has discovered if the size of the venturi where it connects to the air intake and if the fuel passages leading to the throat of the venturi are made sufficiently small he can produce a suction many times in excess of that actually needed to lift the fuel from the low level tank and that when such excessive suction is employed the variation in the amount of gasoline fed due to variations in level in the supply tank is reduced to a minimum. He has found by experimentation that these passages should be made so small that the suction produced at the fuel openings in the venturi at the smallest engine demand is at least sufficient to lift fuel from the low level supply tank plus a distance seven times as great as a possible variation in the fuel level for the supply tank. It is this feature which is distinctly set forth in the claims. The examiner admits that the patents contain no suggestion of this feature but holds there would be no invention in determining by experiment the necessary size to produce sufficient suction to lift fuel under certain running conditions to a specified distance. If this distance were only the maximum distance through which the fuel is lifted we would agree with this statement of the examiner. Appellant, however, has done more than determine the necessary amount of suction to lift the fuel from the bottom of the tank to the carburetor. He has discovered that the suction employed should be many times this necessary suction so that the inaccuracies in the fuel feed due to the variations of liquid level in the supply tank are minimized. We deem the claims fairly patentable over the art relied upon by the examiner.

The decision of the examiner is reversed.

## MARCH 30

# *Headlight Reflector Construction*

EX PARTE SAMUEL F. ARBUCKLE AND CARL P. BROCKWAY. APPEAL NO. 276, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1704028 was issued March 5, 1929, to Samuel F. Arbuckle and Carl P. Brockway for a headlamp replacement unit, on application No. 688-947, filed January 28, 1924.

The replacement reflector unit specified in Claim 2 wherein a single means was employed for securing the reflector, bulb and shield together, were found to lack invention in the absence of any specified construction considered as anticipatory.

Claim 12, which appellant had copied from the patent to Carstarphen, No. 1614650, for purposes of interference, was disallowed on the ground that the claim must be narrowly construed in view of the prior art and when so construed it can not be made by the appellant.

The decision of the examiner was affirmed.

Chester H. Braselton for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Skinner and Ide) follows:

This is an appeal from the final rejection of the following claims:

"2. A replacement reflector unit adapted to be positioned in a reflector of a lamp, comprising a reflector; a lamp bulb positioned in the reflector; a shield adapted to be positioned in front of the lamp bulb; and single means for securing said reflector, bulb and shield together.

"12. A headlight comprising, in combination, an outer housing; a concave reflector located within said housing; a second concave reflector of smaller size than the first and adapted to be secured in place within the first reflector, said second reflector having a circular flange extending outwardly at its open end, the diameter of said circular flange being less than the maximum inside diameter of the first mentioned reflector, whereby it will contact with the inner surface of the first mentioned reflector at some point within the same; and

means comprising a threaded tubular member for securing said reflectors together."

The references relied upon are: Babcock, 1219066, March 13, 1917; McKeever, 1253848, January 15, 1918; Balsillie, 1390747, September 13, 1921; Halvorson, 1436655, November 28, 1922; Wood, 1502454, July 22, 1924.

The patent to Balsillie shows a replacement reflector connected to a tubular element C which is provided at its front end with means for attaching a lamp and at its rear end with means serving as a plug to engage the lamp socket in the original reflector of the lamp. The patent to Babcock discloses a screen 4 arranged in front of the lamp bulb 1 and secured by springs 7 to the base of the lamp. Claim 2 merely includes these elements and specifies that they are secured together by a single means. In the absence of any specified construction, we see nothing patentable in securing any number of elements together by a single means as the conception is an obvious one, tending to simplicity, and any invention involved is in the construction whereby it is possible to secure them by a single means. Furthermore, it is difficult to read the claim on appellant's own construction. The reflector 60 is held on the tubular element 66 by the nut 170 which clamps it against the collar 65 which in turn is backed by the upturned ends 70 of the tubular member. The lamp base 100 and the semicylindrical ends 96, 97 of the screen are held within the tubular member by the action of the nut 170 in compressing the split ends of the tubular member 66. The single element for securing these parts together, specified in the claim, is evidently the nut 170 but it is not the sole means, for in securing the reflector 60 on the tube, it requires the cooperation of the collar 65, and in clamping the screen and lamp it requires the split sleeve. These two clamping actions are separate and distinct although they involve a common element.

### Claim 2 Unpatentable.

If the single means be taken as the tubular member 66 then the claim would not distinguish from the construction produced by adding the Babcock screen to the structure of Balsillie.

In McKeever the single element 22 secures the shield 24, reflector 12 and lamp 15 together and, in cooperation with the collar 27, secures them to the casing 10. We agree with the Examiner that Claim 2 is unpatentable over these references.

Claim 12 was copied from the patent to Carstarphen, No. 1614650, January 18, 1927, and was rejected on the ground that appellant cannot make the claim. In the patent the replacement reflector 9 is secured to the original reflector by means of the threaded tubular member 11 and nut 13, the last clause of the claim reading:

"and means comprising a threaded tubular member for securing said reflectors together."

In the applicant's device the replacement reflector 60 is secured to the original reflector 12 by means of the tubular member 66, having the lugs 80 at one end and the screw threads 68 at the other end. The screw threads, in conjunction with the nut 170 and collar 65, secure the reflector to the tubular member 66, and the lugs 80 and bayonet slots 131 secure the tubular member to the sleeve 14 and to the reflector 12. The claim is incomplete, as the threaded member of Carstarphen does not alone secure the reflectors together, but, treating the tubular member 66 with its threads on one end and the lugs 80 on the other as the "means," then it is true that this tubular member has threads 68 and the claim can be read on the appellant's device. However, if read in this way, it appears to read also on, or at least is unpatentable over, Balsillie, in which the tubular member C has threads at one end and lugs at the other, and serves to connect the reflector A to the original lamp, which seems to be a reflector, as the structure is described as an attachment to be mounted within the ordinary headlamp of the vehicle. (See page 2, lines 34-37.) Unless the claim be construed as limited to the specific construction of Carstarphen, it is not patentable over Balsillie. If construed as limited to the threaded member and nut of Carstarphen serving to draw and clamp the two reflectors together, the appellant cannot make it. In view of these facts the claim must be narrowly construed. (See Rice v. Schutte, C. D. 1912, page 506.)

The decision of the examiner is affirmed. Limit of appeal to Court of Appeals, 40 days. See Rule 149.

# Carpet Sweeper Brush Cleaner

EX PARTE IRA J. OWEN. ASSISTANT COMMISSIONER OF PATENTS.

PATENT No. 1706039 was issued March 19, 1929, to Ira J. Owen for a carpet sweeper with brush-cleaning device, on application No. 597053, filed October 26, 1922.

Claim 3, covering the combination of a brush and comb, and being specific to the structure of the comb and as to the relation that the teeth of the comb bear to the tufts of the brush, was allowed by the Assistant Commissioner on appeal.

The opinion states that although the general organization is clearly disclosed in the prior art, yet the specific features defined by the claims are sufficiently novel to warrant allowance.

**Appeal From Examiners-in-Chief.**

Appeal from examiners-in-chief. Chappell & Earl for appellant.

The full text of the decision of Assistant Commissioner Moore follows:

This is an appeal from the decision of the examiners-in-chief affirming the decision of the examiner finally rejecting claim 3. The invention relates to carpet sweepers.

The subject matter on appeal is defined as follows:

"3.—A sweeper for carpets or the like comprising a driven tufted brush and a metal comb strip secured to a longitudinal centrally-disposed bar secured to the casing of the sweeper, which strip has outwardly curved teeth struck up from opposite edges thereof and pointed alternately in opposite directions and spaced and arranged to pass between the tufts of the brush, whereby said teeth will act upon the brush to collect alternately the debris from the opposite sides thereof, and on the reversing of the brush discharge such debris into suitable receptacles, substantially as described."

**Four References Cited.**

The references are: Entwisle et al. (British), No. 26003, November 13, 1913; Entwisle et al. (British), No. 178296, April 20, 1922; Armor et al., No. 949694, February 15, 1910; Goble, No. 972690, October 11, 1910.

The claim is drawn to the combination of a brush and comb. It is specific as to the structure of the comb, and as to the relation that the teeth of the comb bear to the tufts of the brush.

The comb is defined as consisting of a strip formed with spaced outwardly curved teeth struck up from opposite edges thereof and pointed alternately in opposite directions.

The relationship of the teeth with respect to the brush is defined by the statement that the teeth are arranged to pass between the tufts of the brush.

The functional cooperation of the comb and brush is defined by a whereby clause to the effect that said teeth will act upon the brush to collect alternately the debris from the opposite sides thereof, and on the reversing of the brush discharge such debris into suitable receptacles.

**British Patent Described.**

This specific subject matter is not disclosed by the cited patents. In the British patent to Entwisle et al., No. 26003 of 1913, principally relied upon in the rejection of the claim, the cleaning device consists primarily of a metal strip carrying blades (D) which enter between the bristles of the brush to cut or break hairs, threads or similar material. The edges of this strip are serrated at e to engage the bristles and remove material loosely adhering to the brush. These serrations are not disclosed with certainty as "curved" nor as arranged to pass between the tufts of the brush.

While the patents to Armor et al. and Goble show curved teeth, yet they do not show outwardly curved teeth struck from the opposite edges of the strip and pointed alternately in opposite directions, one row of teeth collecting while the other row is discharging the debris as the brush rotates in opposite directions. Nor do any of the references show the teeth so arranged as to pass between the tufts of the brush, as claimed.

While the general organization is clearly disclosed by the cited patents, yet it is believed that the specific subject matter defined by the claim is sufficiently novel and useful to justify the allowance of the claim.

The decision of the examiners-in-chief is reversed.

## APRIL 1

# *Improvement In Grinding Machines*

EX PARTE JAMES N. HEALD AND RAY D. HUBBELL. APPEAL NO. 846, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1705114 was issued March 12, 1929, to James N. Heald and Ray D. Hubbell for a Grinding Machine, on application No. 703097, filed March 31, 1924.

Claims 6 to 9, covering a grinding machine and means for increasing the travel of the reciprocating carriage to carry the grinder past the dressing tool when desired, and including means for automatically reestablishing the normal reciprocating working traverse, were allowed over the examiner's rejection, in view of the fact that the prior art did not suggest in what manner the basic references might be modified to produce appellants' claimed structure.

George H. Kennedy, jr., for applicant.

### A Representative Claim.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Skinner and Ruckman) follows:

This is an appeal from the rejection of claims 6, 7, 8 and 9, of which claim 6 is representative and reads as follows:

"6. In a grinding machine, a grinding wheel, adjustable means for procuring limited reciprocatory working traverse between said wheel and the work to be ground in the normal operation of said machine, a grinding wheel dresser, means operable without destroying the adjustment of said adjustable means to increase the relative movement, in one direction, between said wheel and said work, thereby to subject said wheel, when desired, to the action of said dresser, and means brought into action after said increased movement for automatically reestablishing said limited reciprocatory working traverse."

The references relied upon are: McDonough, 1497574, June 10, 1924; Morgan, 1535331, April 28, 1925; Conradson et al., 1534302, April 21, 1925; Bloxam (Br.), 205136, October 9, 1923; Marks (Br.), 200853, July 18, 1923; Greenfield Tab and Die Corp. (Fr.), 546824, September 4, 1922.

The invention relates to a grinding machine and particularly to the means for increasing the travel of the reciprocating carriage to carry the grinder past the dressing tool when desired, and includes means for automatically reestablishing the normal reciprocating working traverse.

The construction of appellants' device is clearly and concisely given in the examiner's statement and need not be repeated here.

The specification, on page 1 of the application, states:

"The present invention relates to grinding machines, and contemplates certain improvements and refinements in the reciprocatory table control mechanism disclosed in the copending application of Drake and Guild, Serial No. 685577, filed January 11, 1924, the principal object herein being to make the wheel dressing and truing operation in a grinding machine wholly automatic from start to finish, once said operation has been inaugurated by the machine operator."

### Automatic Reestablishing Means.

The application No. 685577 of Drake and Guild, referred to above, matured into patent No. 1603667 on October 19, 1926, and is assigned to the same company as the present application. The construction of appellants' device is quite similar to that of Drake and Guild except that in the latter device it was necessary for the operator to push the latch lever 31 to the right to engage notch 33 with boss 34 thereby holding blocks 11 and 28 in predetermined relation.

Appellants have added thereto the spring 29 carrying the lug 30 for holding the block 11 from moving to the left with the table until the latch member 20 positively engages the block 11 thereby doing away with the necessity of the operator restoring these parts by hand. This automatic reestablishing means is recited at the end of each of the appealed claims. In claim 6 it reads "means brought into action after said increased movement for automatically reestablishing said limited reciprocatory working traverse."

It is noted that the examiner has allowed six claims which include the above automatic restoring means in combinations that recite the members 7 and 8 as "stops." Appellants contend that they should not be limited to the use of stops and have drawn the appealed claims of broader scope by using the

term "means." They further contend that the appealed claims are drawn to the novel combination embodying their improvement, that they are equally patentable with the allowed claims and merely omit certain unnecessary limitations of the latter.

The examiner has rejected the claims on certain combinations and modifications of the references.

The examiner holds that if the device of the Morgan patent is provided with another stop at the extreme left corresponding to the stop 86 of the Marks British patent and the third stop is made a reversing stop instead of a limiting stop in view of McDonough, it would meet the appealed claims.

In Morgan the dressing point 72 is carried by the swinging arm 67 which is thrown down and clamped to the table during the dressing operation. Apparently it must be moved out of the way before the carriage can resume its normal working stroke. This requires the intervention of the operator and is not accomplished automatically as called for in the claims.

The examiner refers to Conradson as operating in "substantially the same way as does the British patent to Marks." We do not find in Conradson or in McDonough a fair anticipation of the appealed claims, nor do we think they could be modified or combined with the other art cited to embody the structure of the appealed claims without invention.

The decision of the examiner is reversed.

# *Inaccuracy of Claims for Packing*

EX PARTE CHARLES LAMB AND DOUGLAS R. RADFORD. APPEAL NO. 364, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1706031 was issued March 19, 1929, to Charles Lamb and Douglas R. Radford for Double Cross Expansion Packing, on application No. 56467, filed September 15, 1925.

The rejection of claims 16 to 23 as failing to read on disclosure and as being inaccurate was affirmed.

The Board ruled that if the packing material set forth by applicant, consisting of layers of fabric vulcanized to interposed layers of rubber, permitted relative movement between the fabric layers, then the alternate layers of fabric and rubber disclosed in the references would permit such movement.

Ford W. Harris and Bacon & Thomas for applicant.

Before Assistant Commissioner Moore, Examiners-in-Chief Ruckman and Landers. The full text of the opinion of the Board of Appeals follows:

### Illustrative Claims.

This is an appeal from the rejection of claims 16 to 23. Claims 16 and 23 are illustrative and read as follows:

"16. A body of packing adapted to be compressed upon an axis thereof to cause said packing to expand transversely of said axis, said packing having two portions arranged in consecutive order upon said axis, each of said portions being formed of laminations of packing material movable relative to each other, said laminations being disposed obliquely relative to said compression axis, the slope of the laminations of said portions relative to said axis being of opposite algebraic sign from each other, said portions meeting each other on a plane transverse to said axis.

"23. A body of packing adapted to be compressed upon an axis thereof to cause said packing to expand transversely of said axis, said packing including two portions substantially rectangular in cross section and meeting face to face on said axis, each of said portions having laminations of packing material vulcanized in rubber so as to be movable relative to each other, said laminations being disposed obliquely relative to said compression axis and to the plane upon which said portions meet."

The claims were rejected by the examiner "as inaccurate and failing to read on the disclosure." Each of the appealed claims includes "laminations of packing material movable relative to each other."

The examiner points out that the specification does not state that the layers of fabric are relatively movable and calls attention to the description on page 3 of the specification reading:

"The primary and secondary strips 25 and 26 consist of alternate layers of rubber 30 and fabric 31, the fabric 31 being preferably canvas and the texture thereof being cut on a bias. As shown in Figures 2, 3 and 4, the layers of rub-

ber 30 and fabric 31 are diagonally arranged and do not extend parallel to any of the outer faces of the strips 25 or 26. The layers of rubber and canvas 30 and 31 are preferably attached together, as by vulcanizing."

**Relative Movability.**

He asserts that such layers of fabric vulcanized together by means of interposed layers of rubber cannot be said to be movable relative to each other.

Appellant contends in his brief that in his packing the fabric layers do move relative to each other and he files a sketch purporting to be an enlargement of Figures 2 and 3 for the purpose of showing that when the packing of Figure 2 is compressed as shown in Figure 3, the layers of packing material have actually moved relative to each other. He further offers to set this forth in a proposed amendment to the specification. We are not satisfied that such an amendment would not embrace new matter. Application drawings are not scale drawings and it is not clear that Figure 3 was intended to show a relative movement of the fabric layers from their position in Figure 2. The examiner takes the position that the layers in Figure 3 have been merely distorted. Appellant contends that the distortion is in the rubber layers 30 only.

Moreover we do not see that this alleged relative movement of fabric layers adds anything patentable to the claims which originally stood rejected on references. These references show packing having alternate layers of fabric and rubber vulcanized together. Furthermore appellant admits that packing of said alternate layers disposed on diagonals is old, for on page 1 of his specification he states:

"It has long been the practice to provide packing of rectangular cross section consisting of alternate layers of rubber and fabric vulcanized together, which layers are disposed on diagonals since it is found that such a packing expands readily."

**Refusal of Substitute.**

If the layers are relatively movable in appellants' construction they would apparently be so movable in the prior art construction.

Appellant requests permission to substitute "having" for "being formed of" in claims 16 to 20. We must refuse this request in view of our holding above that this structure is not warranted by the disclosure. Moreover, this proposed amendment would still leave it indefinite whether the "laminations of packing material" referred to were the rubber layers 30, the fabric layers 31, or both.

The decision of the examiner is affirmed.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

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# *Trolling Spoon With Novel Shape*

EX PARTE FRANK S. TUCKER. APPEAL NO. 1395, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1706906 was issued March 26, 1929, to Frank S. Tucker for a Trolling Spoon, on application No. 712951, filed May 13, 1924.

A trolling spoon having reversely cupped front and rear ends and a diamond shaped central portion was held patentable over the prior art which failed to show the diamond shaped central portion, the Board stating that in a well developed art any improvement may consist of a slight difference in structure of curvature. The examiner's rejection of the three claims in the case was reversed.

Two additional claims presented were not considered for the reasons given in ex parte Moore, 1923 C. D. 13.

Royce A. Ruess for applicant.

The full text of the opinion of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Ruckman and Landers) follows:

This is an appeal from the three claims in the case. Claim 1 is representative, and reads as follows:

"1. In a trolling spoon, a substantially ovaloid body having its front and rear end portions of reversely related concavo-convex cross-section and conjointly defining a substantially diamond shape appearing plane central portion, the side edges of the body being of ogee configuration and the front end being of greater width than the rear end."

The references relied upon are: Breidenstein, No. 728360, May 19, 1903; Selig, No. 1115743, November 3, 1914; McMahon, No. 1136475, April 20, 1915; Reekers, No. 1471280, October 16, 1923.

Appellant's alleged invention is a troll-

ing spoon having reversely cupped front and rear ends and a central body portion of diamond form.

The examiner admits that the references do not show the diamond-shaped central portion, but holds that this is not a patentable difference. In this well-developed art any improvement must consist of a slight difference in structure or curvature. Appellant contends that his construction produces a distinctly different movement of the spoon in water from that of the references. Appellant's contention appears to be well founded, in view of the numerous affidavits of record.

We must decline to consider two additional claims presented in appellant's brief, for reasons fully set forth in the Commissioner's decision in Ex parte Moore, 1923 C. D. 13.

The decision of the examiner is reversed.

## APRIL 2

# *A Device for Protecting Checks*

EX PARTE CLARENCE R. MARTINEAU. APPEAL NO. 540, BOARD OF APPEALS OF THE PATENT OFFICE.

REISSUE Patent No. 17241 was issued March 19, 1929, to Clarence R. Martineau for Check Protecting Devices, as reissue of patent No. 1578289, filed July 8, 1926, Ser. No. 121225.

Claims 10 and 11 were disallowed in the reissue application upon a finding that they were directed to a different invention from that presented in the original case, it being held that a combination and one of the elements of the combination were not for the same indivisible invention.

Claims 17 and 18, drawn with a long preamble forming a setting for the real invention recited, namely, a check or seal, the element of the combination, were also held to be for a different invention from that originally claimed.

The decision of the examiner was affirmed.

Before Assistant Commissioner Moore, Examiners-in-Chief Ruckman and Landers. The full text of the decision of the Board of Appeals follows:

This is an appeal from the rejection of Claims 10, 11, 17, and 18. Claim 10 is representative and reads as follows:

"10. A new article of manufacture in the form of an endwise insertible mutilatable metal check or seal in the form of a leaf, having an extended leading end for insertion into the bite of check-mutilating wheels, and having at its final end a set of identifying indicia, and having between said ends an uncut body-portion interlockable with a locking bolt by means of the endwise insertion of the check."

The references relied upon are: Oliver, No. 150182, April 28, 1874; Beasley, No. 377662, February 7, 1888; Amos, No. 389732, September 18, 1888; Wheaton, No. 504643, September 5, 1893; Brooks, No. 982122, January 17, 1911; Sharp, No. 1074020, September 23, 1913; Tyden, No. 1080184, December 2, 1913.

The application filed July 8, 1926, is for the reissue of Patent No. 1578289, issued March 30, 1926. The invention is a check-protecting device.

Claims 10 and 11 call for "a new article of manufacture in the form of an endwise insertible mutilatable metal check or seal in the form of a leaf," having the construction specified in the claims. The examiner rejected these claims (1) "as being for a different invention from that claimed in the original patent" and (2) "as being unpatentable over the developed art."

While the application of the patent described the check or seal, it was claimed merely as an element of a combination and there was nothing to indicate that appellant considered that he had made an invention in a check or seal per se. The check or seal is clearly a different invention from a combination in which it appears merely as one of several elements. It is well settled that such a patent may not be reissued to embrace claims for the different invention disclosed, but not claimed or attempted to be claimed in the patent (Nelson v. Felsing, and Felsing v. Nelson, 142 O. G. 289; Morse Chain Co. v. Link-Belt Co., 189 Fed. 584; Diamond Drill Contracting Co. v. Mitchell, 269 Fed. 261; ex parte Bedell, 329 O. G. 802).

The art cited by the examiner under his second ground of rejection of these claims consists of the patents to Wheaton, Tyden and Beasley. These patents show metal seals in the form of a leaf with identifying indicia on one end, a body

portion interlockable with a locking bolt and also an end which might be inserted in the bite of check-mutilating wheels, if desired, as in the patent to Sharp.

Claims 17 and 18, as pointed out by the examiner, appear to be drawn with a long preamble forming the setting for the real invention that follows and which is the metal leaf check of Claims 10 and 11. In our opinion the rejection of these claims also on the grounds given above respecting Claims 10 and 11 is well taken.

The decision of the examiner is affirmed.

## APRIL 3

# *Claims for Enclosing Particles Of Yeast in Milk Over Prior Art*

EX PARTE BAYLIS M. DAWSON. APPEAL No. 308, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1706564 was issued March 26, 1929, to Baylis M. Dawson for yeast compositions and methods of preparing the same, on application No. 572-087, filed June 30, 1922.

Claims, 3, 4, 5. 6, 8, 9, 10, 11 and 12 for yeast product encapsulated in milk solids were found to be allowable over a prior patent disclosing the use of gelatin as a protective agent, it being stated that milk solids are peculiarly adapted for this use since they permit desiccation of the mixture without injury to the yeast cells. Method claims 15 and 16 were also passed as patentable.

### Method of Preparing Product.

The rejection of claims 1, 2, 7, 13, 14, 17 and 18, as being anticipated by the prior art, was affirmed.

Earl T. Ragan for applicant.

Before Moore, Assistant Commissioner, Ruckman and Landers, Examiners-in-Chief. The full text of the opinion of the Board of Appeals follows:

This is an appeal from the rejection of all the claims, 18 in number. Claims 2 and 4 are representative and read as follows:

"2. The method of preparing a comminuted product consisting largely of viable yeast cells which comprises mixing and substantially encapsulating yeast with a sufficient quantity of a liquid protective nutrient substance to form a fluent mixture, introducing said mixture in finely subdivided form into contact with a body of an acroform fluid and maintaining the latter in contact with the subdivided particles of the yeast mixture suspended therein for a sufficient time and at a sufficiently high nonlethal temperature to desiccate the particles.

"4. A comminuted and substantially dry composition consisting essentially of viable yeast particles substantially encapsulated in milk solids."

The references relied upon are: Stauf, 666711, January 29, 1901; Merrell et al., 878977, February 11, 1908; Whitney, 1306569, June 10, 1919; Dick, 1374555, April 12, 1921.

The invention of this application relates to yeast compositions and methods of preparing the same. Claims 1, 2 and 13 to 18 are method claims, while claims 3 to 12 are for the yeast composition.

The nature of the invention is briefly set forth in the examiner's statement as follows:

"The subject matter of the instant case relates to a process of spray drying a mixture of yeast and a protective agent such as milk or gelatin with or without the addition of malt extract, and the resulting product as set forth in the claims copied above. Milk, however, is preferred as the protective agent to encapsulate and preserve the viable yeast cells because it has a higher nutritive value than gelatin and also serves as a medium in which the yeast cells may grow and propagate when mixed with moisture under favorable conditions."

### The Whitney Patent.

In the patent to Whitney, viable yeast is mixed with substances suitable for yeast food. The substances mentioned as suitable are dextrin, glucose, malt, maltose and sugar. The patent specification further states:

"In place of the soluble carbohydrates or in admixture therewith, soluble proteids such as gluten, legumin, albumen, gelatin, peptone, etc., may also be employed."

Whitney does not include milk or milk solids in this list of suitable substances. Moreover Whitney does not dry his mixture by the spray desiccating process of

appellant's method claims. The other patents cited by the examiner show that the step of spray desiccating as applied to other substances or compositions is old. That this method of drying broadly is old is admitted by appellant on page 3 of his specification where he refers to patent No. 1090740 to McLaughlin as disclosing an apparatus suitable for carrying out his process.

The position of the examiner is given in his statement as follows:

"Applicant has merely followed the teachings of the prior art in the application of spray drying to the yeast and milk mixture and the selection of milk in place of gelatin as disclosed by Whitney as the preferred protective agent because of its higher nutritive value can be regarded in view of the prior art as only an obvious expedient such as might be expected of one skilled in the art and not amounting to invention."

We are not prepared to accept this holding of the examiner. The milk increases the nutritive value of the composition as a food product and acts as a food for the yeast organism. Moreover, appellant's statement in his specification that milk solids are peculiarly adapted to act as the protective or encapsulating substance for the viable yeast particles in that they permit desiccation of the mixture without injury to the yeast cells, is not contradicted.

Of the claims for the composition, claims 3, 4, 8 9, 10, 11 and 12 specifically mention "milk solids" or "milk solids and the solids of malt extract" as the yeast-cell encapsulating material. Claims 5 and 6 call for the composition consisting of "yeast and of conjointly desiccated whole cows' milk." In our opinion claims 3, 4, 5, 6, 8, 9, 10, 11, and 12 are patentable.

**Including Milk With Yeast.**

Claim 7 which specifies "yeast and a soluble vitamine-containing food encapsulating the yeast cells," we do not consider patentable over the disclosure in the Whitney patent.

Of the method claims only claims 15 and 16 include the milk with the yeast and may be considered as directed to the same invention as the claims considered allowable, supra. They are likewise allowable.

In claims 1, 2, 13, 14, 17 and 18 the material treated consists of yeast and a protective substance. This may be the material recited in the Whitney patent.

We do not think there is invention involved in drying this material by the process disclosed in the other references cited, or the McLaughlin patent, in place of that disclosed by Whitney.

The decision of the examiner is affirmed as to claims 1, 2, 7, 13, 14, 17 and 18, and is reversed as to claims 3, 4, 5, 6, 8, 9, 10, 11, 12, 15 and 16.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

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EX PARTE BAYLIS M. DAWSON. APPEAL NO. 310, BOARD OF APPEALS OF THE PATENT OFFICE.

Patent No. 1706566 was issued March 26, 1929, to Baylis M. Dawson for yeast compositions and methods of preparing the same, on application No. 572089, filed June 30, 1922.

A composition consisting essentially of yeast particles encapsulated by malt extract solids, covered by claims 2, 4, 5, 1 and 9, was found to be anticipated by a prior patent listing malt as a suitable substance to mix with yeast to form a dry yeast composition.

The addition of fruit juice to the malt extract solids as an encapsulating material for the yeast was sufficient to render claims 3, 6, 7 and 8, limited to such a composition, allowable.

Earl T. Ragan for applicant.

Before Assistant Commissioner Moore and Examiners-in-Chief Ruckman and Landers. The full text of the opinion of the Board of Appeals follows:

This is an appeal from the rejection of all the claims, nine in number.

**Representative Claims.**

Claims 1 and 2 are representative and read as follows:

"1. The method of preparing a comminuted product comprising yeast and malt extract solids which comprises mixing yeast with a sufficient quantity of a solution of malt extract solids to form a fluent mixture, introducing said mixtures in finely subdivided form into contact with the subdivided particles of the yeast mixture suspended therein for a sufficient time and at a sufficiently high temperature to desiccate the particles.

"2. A comminuted and substantially dry composition consisting essentially of yeast particles encapsulated by malt extract solids."

The references relied upon are: Merrell et al., 878977, Feb. 11, 1908; McLaughlin, 1090740, March 17, 1914; Whitney, 1306569, June 10, 1919; Dick, 1374555, April 12, 1921.

The invention of this application relates to yeast compositions and methods of preparing the same.

The invention in this case specifically differs from that in companion applications Nos. 572087 and 572088 in that appellant here employs malt extract or malt extract mixed with fruit juices as the encapsulating material for the yeast particles instead of milk solids of application No. 572087 or the fruit juices of application No. 572088.

The patent to Whitney lists malt among the available suitable substances he contemplates mixing with yeast to form his dry yeast composition. This patent is believed to directly anticipate claims 2, 4 and 5 which recite merely the yeast and malt extract.

Claims 3, 6, 7 and 8 add fruit juice to the yeast and malt extract.

The references do not disclose this composition including fruit juice and for reasons similar to those stated in our decision of even date in companion application No. 572088, claims 3, 6, 7 and 8 are deemed allowable.

Claims 1 and 9 are method claims in which the material operated upon is a mixture of yeast and malt extract. This mixture is old in Whitney as noted above. We do not think there is invention involved in drying this material by the process disclosed in the other references cited.

The decision of the examiner is affirmed as to claims 1, 2, 4, 5 and 9 and is reversed as to claims 3, 6, 7 and 8.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

# *Invention by Added Ingredient*

EX PARTE BAYLIS M. DAWSON. APPEAL No. 309. BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1706565 was issued March 26, 1929, to Baylis M. Dawson for yeast mixtures and methods of preparing the same, on application No. 572088, filed June 30, 1922.

### Use of Fruit Juices.

This invention, relating to yeast compositions and the methods of preparing the same, and involving the use of fruit juices as the encapsulating material for the yeast particles instead of, or in addition to, milk solids, was held patentable on appeal. The rejection of the 14 claims in the case as being for aggregations was not sustained.

Earl T. Ragan for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Ruckmand and Landers) follows:

This is an appeal from the rejection of all the claims, 14 in number.

Claims 1 and 2 are representative and read as follows:

"1. The method of preparing a comminuted product comprising yeast and fruit-juice solids which comprises mixing yeast with a sufficient quantity of a solution of fruit-juice solids to form a fluent mixture, introducing said mixture in finely subdivided form into contact with an aeroform fluid and maintaining the latter in contact with the subdivided particles of the yeast mixture suspended therein for a sufficient time and at a sufficiently high temperature to desiccate the particles.

"2. A comminuted and substantially dry composition consisting essentially of yeast particles encapsulated by fruit-juice solids."

The references relied upon are: Whitney, No. 1306569, June 10, 1919; Merrell et al., No. 878977, February 11, 1908; McLaughlin, No. 1090740, March 17, 1914.

The invention of this application relates to yeast compositions and methods of preparing the same.

The invention in this case is specifically different from that in companion application No. 572087, in that appellant here employs fruit juices as the encapsulating material for the yeast particles instead of, or in addition to, the milk solids used in said companion case.

### An Untenable Rejection.

The references do not show this composition, and we are not prepared to hold with the examiner that the claims are unpatentable as covering an aggregation.

Claims 8, 9, 10 include both "milk solids and fruit-juice solids" as the encapsulating material for the yeast particles.

For reasons analogous to those set forth in our decision of even date in said companion application No. 572087 we consider the examiner's rejection untenable.

The decision of the examiner is reversed.

## APRIL 4

# *Tuft Setting on Brush Machines And an Interchangeable Holder*

EX PARTE CONRAD JOBST. APPEAL NO. 995, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1706450 was issued March 26, 1929, to Conrad Jobst for a Brush Machine, on application No. 527590, filed January 7, 1922.

A limitation, to the effect that the tuft setting devices in a brush machine were removable as a unit, was held sufficient to distinguish claims 2 and 3 over the references in which the various elements of the machine could be disassembled separately but not as a unit.

### Tuft Picking Device.

Claims 8 and 9 were also found patentable in view of the prior art, in that they covered a brush machine having a tuft picking and transferring unit arranged to directly deposit a tuft in a passageway of a nozzle whereas in the reference structure the unit delivers the tuft to the passageway indirectly, by passing it through an intermediate mechanism.

The examiner's rejection was reversed.

Whittemore, Hulbert, Whittemore & Belknap for applicant. Before Moore, Assistant Commissioner, Henry and Redrow, Examiners-in-Chief.

The full text of the decision follows:

This is an appeal from a final rejection of claims 2, 3, 8 and 9. Claims 2 and 8 are reproduced as typical of the appealed claims:

2.—In a brush machine, the combination of a bristle feeding unit, a tuft picking unit cooperating therewith to successively pick and deliver tufts, adjustment means for varying the size of the tufts, a removable tuft setting unit adapted to operate on a tuft of predetermined size, and a common actuating mechanism for said bristle feeding, tuft picking and tuft setting units, permitting of the exchange of said tuft setting unit without disassembling of the other units.

8.—In a brush machine, the combination with a reciprocable nozzle having a longitudinal passageway therethrough, and a transverse passageway intersecting therewith, of an inserter movable through said longitudinal passageway, a reciprocable tuft picking and transferring unit arranged to directly deposit a tuft in the transverse passageway of said nozzle, mechanism for imparting substantially harmonic movements of different amplitude and angular displacement to said nozzle and inserter, and means for imparting a substantially harmonic movement to said tuft picking unit in timed relation to said tuft setting unit.

The references relied upon are: Fenerty, 302900, Aug. 5, 1884; Murdock, 934560, Sept. 21, 1909; Murdock, 944142, Dec. 21, 1909; Chandler, 1311796, July 29, 1919; Van Fossen, 1491833, Apr. 29, 1924.

The construction upon which the appealed claims are based is a brush machine. For purposes of a decision on the appeal it is not necessary to discuss at length details of construction.

The claims are directed rather broadly to the general organization of a brush machine including as one of the elements a tuft setting unit including a nozzle, staple forming means and an inserter. The features of the tuft setting unit are included in claim 3.

It is required in claims 2 and 3 that the tuft setting devices shall be removable as a unit. Claims 8 and 9 specify somewhat in detail the construction of the brush setting unit and its operative relation to the tuft picking devices.

### Removability of Unit.

The examiner rejects claims 2 and 3 on the Murdock Patent No. 934560. The Murdock Patent No. 944142 is also cited against claim 3.

Both of these claims require that the tuft setting devices shall be removable as a unit. It is the holding of the examiner that the reference in the claims to the tuft setting devices being removable as a unit does not patentably distinguish from Murdock because a part or parts of the tuft setting devices of the references may be removed.

There is nothing in the patents about removability of the tuft setting devices although they probably may be removed in the sense that the elements of the reference machines may be disassembled separately but not as a unit. The parts

which go to make up the tuft setting devices of the reference constructions are not mounted in the machine so as to be removable as a unit.

It is our view that the limitation to unitary removal of the tuft setting devices is a structural limitation involving the idea of means so as to distinguish the appealed claims 2 and 3 from ex parte Au, 262 O. G. 3, cited by the examiner. We think claims 2 and 3 are not functional, although the elements thereof are broadly stated.

Claims 8 and 9 have been rejected on the Chandler patent. The patents to Fenerty and Van Fossen are cited in connection with these claims as showing eccentric connections for imparting harmonic movements to parts of a brush-making machine.

Each of claims 8 and 9 calls for a reciprocable tuft picking and transferring unit arranged to directly deposit a tuft in a transverse passageway of a nozzle. In the Chandler patent there is a reciprocating member receiving a tuft but it does not deliver the tuft directly to the nozzle; it delivers the tuft to a pair of feed rolls which in turn deliver the tuft to the nozzle.

Accordingly it is our view that the Chandler patent does not meet claims 8 and 9 irrespective of the limitation to harmonic movements of parts included in the claims. We think claims 8 and 9 are not indefinite nor is claim 9 merely a claim for an ordinary brush making machine run in harmonic motion.

The action of the examiner respecting claims 2, 3, 8 and 9 is reversed.

October 6, 1928.

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EX PARTE CONRAD JOBST. APPEAL NO. 996, BOARD OF APPEALS OF THE PATENT OFFICE.

Patent No. 1706451 was issued March 26, 1929, to Conrad Jobst for Apparatus for Forming Brushes, on application No. 527592, filed January 7, 1922.

In a brush making machine the feature of interchangeable holders for the brush backs, each adapted to receive several blanks, thereby providing a construction capable of gang operation, was found patentable. The rejection of claims 1 to 4 on a plurality of references was not sustained on the ground that it was not obvious how the structure of the basic patent could be modified by the teachings of the auxiliary patent to produce the structure of the appealed claims.

Claim 3 was additionally rejected as being for new matter in that it included means for automatically stopping a certain movement at a given time in the operation of the apparatus, and the specification originally states that the machine is stopped at a certain time but does not state whether it is effected automatically or manually, and this rejection was affirmed.

Whittemore, Hulbert, Whittemore & Belknap for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Henry and Redrow) follows:

This is an appeal from a final rejection of claims 1, 2, 3 and 4. Claims 1 and 3 are reproduced as typical of the appealed claims:

"1. In a brush making machine, the combination of a reciprocable driller, a reciprocable tufter, carriers cooperating respectively with said driller and tufter, guideways on said carriers, a pair of interchangeable work holders having guides engaging the guideways on said carriers, means for securing a plurality of brush backs on each of said work holders, mechanism for imparting to each of said carriers step-by-step movements in transverse directions in the same plane, said movements being such that operations are successively performed in a continuous series on all of the brush backs in each of said work holders by said driller and tufter respectively.

"3. In a brush making machine, the combination with a reciprocable driller and a reciprocable tufter, of a common carrier movable in a plane in transverse directions, guideways on said carrier adjacent the driller and tufter respectively, interchangeable work holders engaging said guideways, each work holder having a series of clamps thereon arranged to independently secure thereto in closely spaced relation a series of brush backs, mechanism for imparting to said carrier a step-by-step movement in timed relation to the reciprocation of said driller and tuft setter, said move-

ment successively presenting in a continuous sequence all of the operating points in all of the brush backs, and means for automatically stopping said step-by-step movement when all of the brush backs in one work holder are completely drilled and all of the brush backs in the other work holder are completely filled, whereby said latter work holder may be removed from its carrier and the former work holder transferred as a unit from the guideways adjacent the driller to the guideways adjacent the tufter."

The references relied on are: Young, 664989, Jan. 1, 1901; Winkler, 1087109, Dec. 16, 1913.

### Nature of Improvements.

The claims are directed to improvements in brush making machines and particularly to a construction in which holes are drilled in brush backs and tufts of bristles are inserted in the holes so drilled. In the disclosed apparatus carriers are provided movable in planes at right angles to each other adjacent reciprocating drilling mechanism and a reciprocating tufter. The carriers are provided with guideways adapted to receive interchangeable work holders, each work holder having secured therein a plurality of brush backs. In operation one work holder is caused to travel adjacent the drilling mechanism so that the brush backs mounted in the holder will have the necessary number of holes drilled therein. At the same time brush backs having holes drilled therein will be mounted in the other work holder and traversed adjacent the reciprocating tufter. When the last noted brush backs have rereceived the necessary number of tufts the holder will be removed and the other holder having backs properly drilled will be substituted therefor while undrilled backs will be placed in the work holder associated with the drilling mechanism. By making the holders interchangeable, when the holder containing the series of brush backs with holes drilled therein are transferred to position adjacent the tuft inserting mechanism the holes will properly register with the tuft inserting mechanism. The examiner, in the statement on appeal, says that the gist of the appealed claims is the feature of interchangeable holders for the brush backs, each adapted to receive several blanks, thereby providing a construction capable of gang operation.

There is no anticipation of the finally rejected claims. In order to meet the claims the examiner proposes to modify the construction of the Winkler patent in view of the teachings of the Young patent or to change Young's construction in view of Winkler. In connection with the Young patent the examiner points to that part of the specification wherein it is stated that the holder for a single brush back may be interchanged from the table where boring or drilling is effected to the table where the tufts are inserted. Appellant argues that it would involve extensive structural changes in the apparatus of either the Winkler patent or that to Young to produce a construction responding to the appealed claims. We think appellant is correct. It is not obvious how the structure of Winkler could be modified in view of the teachings of Young to provide a structure responding to the appealed claims or vice versa. So far as the proposed modification of the prior art constructions is concerned it is our view that the action of the examiner should be reversed.

### New Grounds for Rejection.

Claim 3 has been additionally rejected as involving new matter because of the inclusion therein of means for automatically stopping a certain movement at a given time in the operation of the apparatus. No means is illustrated, automatic or manual, for performing the function noted. The specification on page 6 states that at a certain time the machine is stopped but does not explain whether the stopping is effected automatically or manually. There are some general satements in the introduction to the specification to the effect that the operations of the machine are largely automatic but no specific mention is made of the stopping of the machine. Since no stopping mechanism is illustrated and only a general reference to stopping is found in the specification it is our view that the limitation to automatic stopping in claim 3 has no foundation in the application as filed.

The rejection of the appealed claims as lacking invention in view of the prior art is reversed. The rejection of claim 3 on the ground that it involves new matter is affirmed.

Limit of appeal to Court of Appeals 40 days. Rule 149.

## APRIL 6

# *Devices With Distinct Functions*

EX PARTE CECIL H. BOYULS. APPEAL NO. 1173, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1706690 was issued March 26, 1929, to Cecil H. Boyuls for a Laundry Appliance, on application No. 89920, filed February 23, 1926.

Appealed claims 1 to 5, relating to a laundry truck which is obviously useful in a systematic plan for handling laundry, were found unpatentable because of being limited to a truck that is not novel as a device, in that it merely includes several attachments that do not directly or functionally coact in the nature of a machine.

### Not a True Combination.

The Board concluded that the device does not represent a true combination, that the references show the individual features to be independent, and not patentably new, and that the particular way or system in which the composite apparatus is used around the laundry cannot be given weight in determining patentability.

The Examiner's rejection of the claims was affirmed.

Edgar J. Clarkson for applicant. Before Moore, Assistant Commissioner, Henry and Redrow, Examiners-in-Chief.

The full text of the opinion of the Board follows:

This is an appeal from the rejection of claims 1 through 5. Claims 3, 4 and 5 include each feature involved and are copied here:

"3. A laundry truck including a bottom frame, uprights extending vertically from the central portions of the ends of said frame, a clothes receptacle mounted on said frame between the uprights, a carton holder mounted on one of the uprights and substantially on a level with the top of the container, and a horizontal clothes supporting bar connecting the upper ends of said uprights.

"4. A laundry truck including a bottom frame, uprights extending vertically from the central portions of the ends of said frame, a clothes receptacle mounted on said frame between the uprights, a horizontal clothes supporting bar connecting the upper ends of said uprights, a tag board depending below said horizontal bar, and a tag hook carried by said board.

"5. A laundry truck including a container having a batten at each end mounted on the inner side of the respective end below the top edge of said end, a container top adapted to fit within the upper part of the container and rest on the battens, and chains connecting the central parts of the end portions of the container top and the centers of said battens."

The references are: Davis, 596058, December 28, 1897; Shanley, 744808, November 24, 1903; Walz, 1019384, March 5, 1912; Honold, 1169157, January 25, 1916.

This application discloses a rectangular box or receptacle suitable for holding laundry work. It is mounted on a framework having castors so that it can be easily moved about the laundry.

Vertical standards, one at each end, carry a horizontal bar at a convenient height above the box to serve as a support on which to temporarily hang ironed pieces. Two angular arms are attached at one end which conveniently hold a carton in which finished work may be packed. A hook for carrying an identifying tag and a cover for the receptacle are also shown.

The specification sets forth to some extent, and the brief to a very great extent, the plan or system in which this truck is used about the laundry. It is admittedly a very systematic plan, and this truck is obviously very useful in it.

The question presented, however, is whether the truck is patentably novel as a device.

### Importance of Attachments.

It is clear on inspection that the several attachments do not directly or functionally coact in the nature of a machine. The presence or absence of each is entirely independent of the presence or absence of any of the others, both in function and structure.

It is true that the tag board, carton holder and drying bar are supported in common on the same standards but this is not mechanically requisite or of patentable novelty. They could be separately supported.

It is our opinion after careful consideration of the contention of special use under these circumstances that applicant's device represents nothing more than convenient association of several independent features and is not a true

combination in the patentable sense. If the several features are separately old, the claims may be properly rejected on the necessary number of patents to show them.

We are unable to agree with applicant's contention that the particular way or system in which this composite apparatus is used around the laundry can be given weight in determining patentability. The composite apparatus shown by Shanley is sufficient to demonstrate that numerous attachments may be conveniently associated and mounted on wheels.

To select particular things is only a question of adapting the collection of features to a particular work. It does not aid patentability in this case, that the material acted upon is collected and carried along. There is material in the several receptacles of Shanley's apparatus that is acted upon.

Claim 1 includes the receptacle and carton holder. No invention is apparent in broadly attaching a couple of brackets or arms anywhere on Shanley's apparatus to support any article in the manner of Walz. The same is true of the tag board and hook, claim 4.

All of these are also thought to be too simple and obvious from every day experience to amount to invention in themselves and as stated we can see no dependence between them to assist in any idea of new combination. The same arrangement of a cross bar as in claims 2 and 3 which could be used to support a cover cloth is shown by Honold.

Claim 5 is rejected on Davis with Shanley. So far as any combination between the box and truck is concerned the details of the box are entirely immaterial and Davis shows a box having a cover fully equivalent to that of applicant.

It is concluded that this device does not represent a true combination but only the association of several independent features for convenient use and not allowable as claimed in claims 1, 2, 3 and 4. Hailes v. Van Wormer, 87 U. S. 353. It is further concluded that the references show the individual features to be independent and not patentably new.

It is further concluded that the fact that it is used in a laundry according to a certain system or course of procedure, cannot be given any weight in determining patentability in such association of the several independent features.

The rejection is affirmed. Limit of appeal to Court of Appeals 40 days, Rule 149.

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# *Claims for Safety Sheave Block*

EX PARTE WILLIAM H. MCKISSICK. APPEAL NO. 1468, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1707560 was issued April 2, 1929, to William H. McKissick for Safety Sheave Blocks, on application No. 157130. filed December 27, 1926.

The examiner's rejection of claims 13 to 17 on appellant's patent which was granted on a copending application was affirmed on appeal, the Board of Appeals stating that there must be a patentable difference between the claims of the two cases even though the record application was filed as the result of a requirement of division, the case of In re Isherwood being held applicable.

Jack A. Schley and Alfred T. Gage for the applicant. Before Assistant Commissioner Moore and Examiners-in-Chief Skinner and Ruckman.

The full text of the decision of the Board of Appeals follows:

This is an appeal from the rejection of claims numbered 13 to 17 in paper No. 10. Claim 13 is typical and reads as follows:

"13.—In a safety sheave block, a support, a sheave rotatably mounted therein, and a housing comprising permanently secured side plates having inwardly directed longitudinal flanges spaced transversely to form a fixed line gap of sufficient width to permit the passage therethrough of a cable line while preventing contact of a workman's hand with the line engaging surface of the sheave."

The reference relied on is: McKissick, 1633537, June 21, 1927.

The claim stands rejected on appellant's patent 1633537 granted on a copending application.

This patent shows and claims a construction in which one of the guard plates is fixed and the other is adjustable laterally to provide space for the insertion of the cable. In the present application ball-guard plates are fixed or permanently secured, and are spaced apart sufficiently to permit passage of the cable.

We agree with the examiner that there is no invention in increasing the gap be-

tween the edges of the plates in the patent if necessary to permit insertion of a cable of the desired diameter without shifting one of the plates.

The case of In re Isherwood, rather than those cited by the appellant, is believed applicable here. In that case, the Court of Appeals of the District of Columbia held that there must be a patentable difference between the claims of the two cases even though the record application was filed as the result of a requirement of division.

The decision of the examiner is affirmed. Limit of appeal to Court of Appeals, 40 days. Rule 149.

# *Wire Gauze Made Partly of Steel*

EX PARTE ALBERT ELSENHANS. APPEAL No. 994, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1707757 was issued April 2, 1929, to Albert Elsenhans for a rotary sieve of wire gauze, particularly for paper-making machines, on application No. 110009, filed May 18, 1926.

A claim for wire gauze for paper-making machines, consisting of wires of alloy steel reinforced with weft wires of lower-quality nonrusting material, was held patentable by the Board of Appeals, the decision of the examiner being reversed.

The Board decided that appellant had done more than merely substitute alloy steel wires for the brass wires previously used, in that he obtained a structure that had marked improvements over prior-art screens in its wearing properties.

Knight Brothers for applicant.

Before First Assistant Commissioner Kinnan, and Examiners-in-Chief Ruckman and Landers. The full text of the opinion of the Board of Appeals follows:

This is an appeal from a final rejection of the following claim:

"Wire gauze for paper-making machines comprising warp wires of strong, tough, nonrusting steel and weft wires of lower quality nonrusting material."

The reference cited is: Caldwell, 284-273, September 4, 1883.

The invention relates to a wire fabric for use in paper-making machines The specification states that wires heretofore commonly used for the wire gauze of paper-making machines are mostly composed of bronze or material similar to bronze. It further points out that recently, since the development of highly alloyed improved steels which do not rust, it has been proposed to form the gauze out of such steels. It is stated in the brief that experiments to this end proved unsuccessful, since the tough material was not pliant enough to make a satisfactory level and even paper-machine sieve.

The instant invention is directed to the use in the wire gauze of warp wires of strong, tough, nonrusting steel and weft wires of lower quality nonrusting material. The brief presents a proposed claim in lieu of the finally rejected claim which also states that the weft wires are more easily bendable than the warp wires.

The patent to Caldwell discloses a wire fabric formed of brass or similar material. Additional longitudinal strength is imparted to this screen by the inclusion of an excess of warp wires. All of the wires, however, are of the same material and none of them properly may be regarded as formed of the strong, tough, nonrusting steel defined in the claim.

The examiner takes the position that Caldwell has improved the old construction by the use of additional warp wires, whereas, appellant has made a corresponding improvement by the use of warp wires formed of material having increased wearing properties. We are not satisfied that the improvements are of like or similar character. While Caldwell has increased the tensile strength of his screen, it would not seem that he has increased its wearing quality, as has appellant. If appellant had done no more than substitute one material for another in forming his screen we would not regard the change as involving invention. However, it seems to us that the idea of using the more easily bendable weft wires of the old material in conjunction with the steel warp wires, thereby forming a smooth screen and yet one having marked improvements over prior art screens in wearing properties involves invention.

The claim presented in the brief is deemed patentable and if presented in a proper amendment we recommend its allowance. The claim on appeal, however, does not bring out the quality of the weft wires by virtue of which they are more easily bendable than the warp wires, and accordingly we affirm the action of the examiner in rejecting this claim.

APRIL 8

# Combination of Old Elements In Windshield Wiper Invention

V. H. KENDALL, RECEIVER OF PERFECTION PRODUCTS COMPANY, DEFENDANT-APPELLANT, v. TRICO PRODUCTS CORPORATION, PLAINTIFF-APPELLEE, No. 5084; FRANK KRITZ, ETC., v. TRICO PRODUCTS COMPANY. No. 5125. CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

PATENT No. 1522344, for a wind shield cleaner, was held to be valid over a large list of prior patents which showed each of the elements of the claims in suit but which did not show the combination, the court stating that "a combination claim may involve invention even if every element is old, provided a new result is accomplished, or an old result reached by a new and better way."

### Public Acceptance a Factor.

The court found that the claims were not for aggregations and that each related to a unitary machine for windshield cleaning; also, weight was given to the general and immediate public acceptance of the patent device as confirming the existence of invention in it.

Appellee's bill for infringement was sustained upon a finding that appellant's device was similar in structure, method of assembly and appearance to the claimed construction.

In appeal No. 5125 the denial of the motion to set aside the preliminary injunction to prevent infringement of patent No. 1522344 pending the determination of another suit, was affirmed, it appearing that the affidavit filed with the appeal did not amount to proof of anticipation of the patent "so clear, satisfactory, and beyond reasonable doubt as to make the refusal to set aside the preliminary injunction an improvident exercise of discretion."

Appeals from the District Court for the Eastern District of Michigan.

Before Moorman, Hicks, and Knappen, Circuit Judges. The full text of the court's opinion, delivered by Judge Knappen, follows:

Appellee brought suit in the district court against the Perfection Products Company (a common law trust) and Kritz and Bauer, Trustees, for infringement of United States Patent No. 1522344, issued January 6, 1925, to Thompson, assignor to Oishei (later assigned to plaintiff), for automatic windshield cleaner, as well as for unfair competition in connection with such infringement. Both validity of patent and unfair competition were denied.

The district court held the patent valid and infringed, found unfair competition, awarded permanent injunction and accounting for profits and damages on account of the infringement, as well as damages for unfair competition, reserving the question of increased damages until the coming in of the master's report.

The appeal from the decree in No. 5084 was taken within 30 days and before the accounting. Before the appeal was taken the receiver of the Perfection Products Company was substituted as defendant in lieu of the original defendants. Before that appeal was docketed in this court plaintiff filed another bill in the district court against the Perfection Products Association, to which defendant the assets of the Perfection Products Company had been conveyed by the latter company during the pendency of the suit against the Perfection Products Company—as well as against the other defendants and appellants in No. 5125 above named, for infringement and alleged unfair competition connected therewith, with respect to not only the Thompson patent, No. 1522344, before mentioned, but also four other United States patents owned by appellee Trico Products Corporation, viz: No. 1544928, issued September 22, 1925, to Oishei as assignee of Thompson, on automatic windshield cleaner; No. 1562122, issued November 17, 1925, to Oishei, on fluid pressure motors; No. 1565493, issued December 15, 1925, to Oishei, and as assignee of Erwin C. Horton, on fluid pressure motors; No. 1567328, issued December 29, 1925, to Oishei, on motors for windshield cleaners.

### Achievement of New Result.

On the filing of this second bill, on motion of plaintiff, and after notice to defendants and due hearing, but before answer to the bill of complaint was filed, a preliminary injunction was issued pending trial on the merits or until the

further order of the court, against infringement of the Thompson patent No. 1522344 and unfair competition. A motion made by defendants, after answer was filed, to vacate the order of preliminary injunction was denied. The appeal in No. 5125 is from the denial of this motion. The two appeals were heard together here. It is stipulated that the record in 5084 may be used and considered on the appeal in No. 5125.

1. Case No. 5084. By the device of the patent, No. 1522344, the familiar windshield cleaner is made to wipe the glass through the medium of a swinging vane-piston rigidly attached, within a suitable casing, to a rock-shaft whose rocking is directly caused by the oscillating of the piston at right angles to the rock-shaft, and substantially parallel to the face of the windshield, such oscillation being produced by atmospheric pressure (as from the intake manifold of the automobile engine), that is to say, pressure on the one side and partial vacuum suction on the other side of the vane, alternately and automatically applied by the use of suitable valve mechanism.

This shaft, which extends at right angles to the windshield, is thus rocked parallel to the face thereof. A wiper arm, rigidly attached to an extension of the rock-shaft outside the casing, causes the wiper automatically to move back and forth, in an arc of a circle, over the face of the windshield to correspond with the rocking of the shaft. The oscillating of the vane-piston, the rocking of the shaft and the moving of the wiper arm are thus simultaneous.

We think the claims of the patent in suit not invalid, either for anticipation or for lack of invention in view of the prior art. Defendant cites a large list of prior patents, for which the most that can well be claimed is that they show that each element of the claims in suit (all of which are combination claims) was old somewhere in prior art —the list including even such patents as Hull (rotary steam engine) and Greer (reciprocating steam engine), having fluid pressure motor devices with vane-type of oscillating pistons.

While windshield wipers were old, as were cleaning devices operated by fluid pressure for rocking a shaft, and even the use of pistons for applying the power —nowhere in the prior windshield cleaning art, or even in an analogous art, do we find the combination which characterizes either of the respective claims of this patent; and it is a commonplace that a combination claim may involve invention even if every element is old, provided a new result is accomplished, or an old result reached by a new and better way, which we think is plainly the case here. Loom Co. v. Higgins, 105 U. S. 580, 591, et seq.; Ohio Co. v. Bucher Co.—C. C. A. 6—266 Fed. 891, 894, and cases cited.

**The Effect of Prior Use.**

We cannot think that prior use in such devices as rotary and reciprocating steam engines and washing machines of fluid pressure motors (water or air), having a vane-type of oscillating piston, is enough to render invalid the novel and valuable combination claims here in question relating to windshield cleaners. The nearest disclosure in the prior windshield art is contained in the patents of Floberth, in one of which (No. 1309724, July 15, 1919) the air pressure which created the rocking movement was exerted upon a diaphragm, which was caused alternately to move up and down. No piston of any kind was employed.

In another Floberth patent (No. 1352-504, issued September 14, 1920), the piston was of the double head, reciprocating type, operating the rock-shaft through the medium of a rack and pinion, and differing from the Thompson patent not alone in the last-named feature, but in that the piston is not in any sense a vane or oscillating piston operating in an arc of a circle. The Thompson device applies the power created by the oscillating vane directly to the rock-shaft, and without the use of rack and pinion or any other intervening mechanism. It should go without saying that such direct connection saves both time and power, and thus effects the result in a new and materially better way, as contrasted with Floberth's indirect application of power, including the use of rack and pinion, which necessarily produces substantial friction and waste of time and power.

Thompson's device, comprising an oscillating vane, a rock-shaft and an attached wiper constitute a single unit. We are cited to nothing in the prior art disclosing such device, and we think it involves real invention. Nor, in view of the conditions already stated, are we impressed with defendant's contention that the application of a vane-type motor to a windshield cleaner is merely the coupling of a motor that will run any kind of a machine to a machine that will run with any kind of a motor.

Indeed, in view of the unitary character of Thompson's device, with its vane rigidly attached to the rock-shaft and its wiper a mere extension of that shaft, simultaneously operated, we think the statement of the district judge, that it is impossible to say where the motor ends and the machine begins, or where the machine ends and the motor begins, is not without force. We think it unnecessary, in view of what we have said, to discuss any but the two Floberth patents. The general and immediate publice acceptance of the Thompson device convincingly confirms the existence of invention therein.

We thus see no merit in the suggestion that the invention of the Thompson patent lies not in the combination, but only in the substitution of one form of fluid-pressure motor for another form of fluid-pressure motor in an old combination. That suggestion loses sight of the unitary character of Thompson's device and the direct and simultaneous action of its three elements, producing an essentially new combination. Every case involving the use of old elements in a new combination must be judged upon its own peculiar facts. The ultimate question, whether real invention or only mechanical skill is disclosed, is, at the last, a question of fact, as is likewise the specific question whether or not the transfer of a device from one art to another, and its adaptation to use therein, involves patentable invention. Herman v. Youngstown—C. C. A. 6—191 Fed. 579, 582, and cases cited in Ohmer v. Ohmer—C. C. A. 6—238 Fed. at pp. 186-187.

While this court has recognized that if most of the elements are already in the combination, the addition of one or two, already well-known, singly or in groups, as common expedients in similar situations, or the substitution for one or two of those elements of devices familiar to mechanics for analogous use, must be a very meritorious case of benefit to the art to justify a patent (Hug v. Lakewood Engineering Co., 7 Fed. [2d] 98); in the instant case, however, not only is the substituted device not found in closely analogous arts, but the record here shows to our minds, a very meritorious case of benefit to the art. Indeed, defendant's complete adoption of the Thompson device as an article of manufacture and sale is a cogent admission of its usefulness, and thus of its benefit to the art.

Nor, under the facts of this case as already set forth, are we impressed that the decision of this court in the Crown Cork & Seal Company case, 217 Fed. 385, has any controlling application. The situation here is much broader than assumed by defendant.

Upon analogous principles, we find in the decisions of this court in the Troy Wagon Works case, 274 Fed. 612, and Frey v. Marvel, 236 Fed. 916, nothing opposed to the views we have herein expressed.

Defendant's counsel stresses the fact that in the opinion of the Board of Examiners-in-Chief of the Patent Office it was said that in the absence of teaching by prior patents that the oscillating type of piston is advantageous for use in places where but little pressure is obtainable, applicant should be given the benefit of the doubt. We see upon this record no sufficient reason why the applicant should not have been given the benefit of such doubt as may have existed.

We are not impressed that any of the claims of the Thompson patent are aggregational. Each relates to a unitary machine for windshield cleaning. The elements of the combination co-act to produce a new and useful result, and not a mere aggregation of several results. Egry v. Standard Co.—C. C. A. 6—267 Fed. 186, 191.

Nor are we impressed that Thompson's device is shown not to be commercially successful. In the last analysis, we think the record on that subject practically means only that the patent drawings fail to show any soft packing between the shaft and casing cover, which would be needed adequately to seal the leakage of air therebetween and prevent excessive friction. Patent drawings are not usually working drawings, and the record does not convince us that the use of such packing would not readily occur to a competent mechanic in the actual building of the machine. As put on the market, success commercially seems beyond question.

Defendant admits infringement if the claims are valid. It contends, however, that the patent is sustainable only by limiting the claims to the exact features or changes made in Thompson's motor-actuating device over the prior art; and that, if so limited, infringement does not exist. It follows from what we have

said, that we think the claims should not be so limited.

We fail to find anything in the trial court's action in expediting the record which can be regarded as supporting an opinion, for the purposes of this case, that the Thompson motor was old, or as justifying a remand for further proof. The prior art record seems sufficiently before us.

Defendant contends that plaintiff has failed to prove unfair competition, for lack of proof that defendant palmed off its goods upon the public as the goods of plaintiff, or attempted or intended so to do. Defendant stresses the opinion of this Court in Rathbone, Sard & Co. v. Champion Steel Range Co., 189 Fed. 26, which involved an unpatented structure, and not unfair competition in aggravation of patent infringement. In the instant case the district court saw and heard all the witnesses. In his written opinion he said:

**Deliberate Infringement.**

"The patent being valid it follows almost inevitably from the similarity of the parts, their methods of assembly, the external resemblance of the defendant's device with that of the structure made under the authority of the patent, extending even to the interchangeability of the two structures upon windshields drilled for the one, that unfair competition is fully disclosed by the record. The patent in suit is found to be valid and infringed, and such infringement to be wanton and deliberate. * * *"

This conclusion should be accepted by us unless the evidence decidedly preponderates against it. The Martin Mullen—C. C. A. 6—260 Fed. 916, 922, and cases there cited. We see no inconsistency between that case and the Rathbone, Sard & Company case, supra. While we are not now prepared to say that the evidence preponderates against the conclusion of unfair competition, as distinguished from mere infringement, we find it unnecessary at this time to pass upon that question which may become unimportant in case the master shall find no damages resulting to plaintiff from the sale by defendants of windshield cleaners resembling in appearance and dress the windshield cleaners of plaintiff, and inasmuch as in the absence of the master's report we cannot consider the question of increased damages. Upon the master's accounting either party may introduce such further evidence as it desires upon the question of unfair competition.

2. Case No. 5125. Refusal to vacate the order of preliminary injunction. This appeal involves no question of validity or infringement of any patent but the Thompson patent No. 1522344, involved in case No. 5084. The sole question here is whether the refusal to vacate the preliminary injunction was clearly an improvident exercise of discretion; the rule being that the order should not be disturbed unless it clearly appears that the court below has exercised its discretion upon a wholly erroneous conception of pertinent facts or law. Crescent Co. v. National Co.—C. C. A. 6—219 Fed. 130. In that case we said:

"Where plaintiff's title to a patent is clear (as in the case here), and the record shows a fair probability that the patents are valid and raise a sufficient showing of public acquiescence therein, and that infringement exists, the same considerations relating to the exercise of discretion in issuing injunctions in patent causes pertain as in equity causes generally; that is to say, injunction should be granted or withheld according, as upon a balancing of convenience and inconvenience seems necessary to the rights of the parties."

The situation presented is no more favorable to defendants than if we were considering an appeal from the order for preliminary injunction. The specifically controlling question is: Did the district court, in refusing to set aside its preliminary injunction, fail to apply well-settled principles of law to a conceded or indisputable state of facts? Cf. Winchester Co. v. Olmsted—C. C. A. 7—203 Fed. 493. We think this question should be answered in the negative.

**Introduction of 1912 Motor.**

In view of the conveyance by the Perfection Products Company of its assets to the Perfection Products Association, and the connection of defendant Kritz with both associations and with the transfer of assets in question, it was, to say the least, within the judicial discretion of the trial judge to entertain the motion for preliminary injunction, based upon a bill which sought to bind the defendants by the decree in the former case. It seems to be of no practical importance whether or not Kritz was actually served with the injunction in the principal case. When the decree

was made finding the Thompson patent valid and infringed and unfair competition established, and awarding permanent injunction, Kritz was a party defendant thereto.

The motion to set aside the order of injunction, and the appeal from the decision thereon, were based generally, first, upon a contention that the Thompson patent was invalid and the decree to the contrary erroneous, and (at least inferably) not binding on the present defendants; second, an affidavit of a patent engineer that in principle of operation the device disclosed by the Hull patent (on rotary steam engine), already referred to herein, is the same as that of the Thompson windshield cleaner of patent No. 1522344; also that vane types of piston, both with and without adjustable means for maintaining a tight joint, at the rock-shaft end of the piston, also with and without passages therein for introducing and ejecting fluid pressure, had been used in motor devices of various kinds for actuating all sorts of apparatus for more than a quarter of a century, citing the Greer reciprocating engine patent we have already referred to, as well as a large number of other patents, nearly all of which were introduced as exhibits on the hearing below of case No. 5084, and containing arguments against the validity of the Thompson patent last referred to; third, the affidavit of A. G. Lodewyck, a mechanical engineer, that in the year 1912 he made and/or invented a fluid pressure motor having a swing vane-type piston, an oscillating shaft, automatic valve mechanism for the purpose of alternately allowing the pressure to be applied directly to one side of the piston and then upon the other side, and preferably by either high or low presure; that he several times applied for patents on his invention and variations thereof, his applications being rejected as lacking patentable invention, as distinguished from merely structural changes.

A motor said to have been made in 1912 was introduced with the affidavit, and alleged to have been ever since continuously in the affiant's possession; and that in 1919 or 1920, he "conceived the idea" of substituting his earlier type of motor for "those then in use," apparently intending to include a windshield wiper which had the reciprocating type of piston, operating by fluid pressure obtained by employing a conduit connection to the intake manifold of the internal combustion engine, but did not manufacture such device because of the fact that his application for patents on his earlier device had been rejected as not involving invention, and he was advised by competent counsel that a patent on the combination would not be valid.

To say the least, this affidavit does not amount to proof of anticipation so clear, satisfactory and beyond reasonable doubt, as to make the refusal to set aside the preliminary injunction an improvident exercise of discretion. Cf. The Barbed Wire Patent, 143 U. S. 275. Defendant's counsel say of the Lodewyck device that it was admittedly designed primarily for water pressure operation in driving automatic clothes washing machines. There is no claim that it was a combination motor and windshield wiper.

### Value of Prior Art.

We have not here discussed each specific allegation of the affidavit, or each item of counsel's argument, but we have considered all of them. We think these affidavits fail to throw any appreciable new light upon the question of invention in the Thompson patent No. 1522344, and that they are, at the most, merely cumulative of the testimony introduced before the district judge, who had heard oral testimony, not only by laymen, but by expert mechanical engineers, bearing upon the value and effect of the prior art. We think defendant's motion was submitted to the reasonable discretion of the trial judge, which we have no reason to believe was abused.

It follows that in No. 5084 the decree of the district court should be affirmed so far as concerns the adjudication of validity and infringement of patent, and without prejudice to the power of the court on the coming in of the master's report, upon the court's own motion or at the request of either party, to consider further the question of unfair competition.

In No. 5125 the denial of motion to set aside the preliminary injunction should be affirmed.

## APRIL 9

# *Excluding Patentee From Relief Under Act Permitting Appeal*

STUART E. MACGREGOR, PLAINTIFF, v. PERCY C. CHESTERFIELD, DEFENDANT. No. 2974, DISTRICT COURT FOR THE EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION.

A PATENTEE does not come within the provisions of Section 4915 of the Revised Statutes granting equitable relief to an applicant for a patent, for the reason that the statute clearly provides that it is only "whenever a patent on application is refused" that resort to "remedy by bill in equity" is authorized and that only "the applicant * * * may have remedy by bill in equity," it is held herein.

In this instance the bill in equity alleges that the applicant copied claims from the patentee's case and won the decision on priority in the interference, and on appeal to the Board of Appeals, subsequent to which the patentee brought this action seeking relief under Section 4915. Defendant's motion that the bill be dismissed was granted.

**Contention of Intent.**

The plaintiff was not sustained in his contention that it was the intent of the draftsman of Section 4915 to extend the rights under this statute to all parties to an interference, in view of the terms of Section 4909, which provides that every party to an interference may appeal to the Board of Appeals from a decision by the Primary Examiners or the Examiner of Interferences.

Regarding jurisdiction, the court stated that it must be borne in mind that the jurisdiction of a Federal Court, when challenged, is not to be presumed, but must be made affirmatively to appear by him who invokes it.

Barthel, Flanders & Barthel, of Detroit, Mich., attorneys for plaintiff; Parker & Burton, of Detroit, Mich., attorneys for defendant.

The full text of the opinion of Judge Tuttle follows:

This cause is before the court on a motion to dismiss the bill of complaint on the ground that it appears from such bill that this Court has no jurisdiction over the subject matter of this suit.

The bill alleges that "This action is brought under Section 4915 of the Revised Statutes of the United States and the jurisdiction of this Court is founded upon said Section 4915 of the Revised Statutes"; that the plaintiff is the true, sole, and original inventor of certain new and useful improvements in alloys or composition of matter upon which he duly filed an application for a patent in the United States Patent Office and on which such patent was thereafter duly issued to him; that before the plaintiff had filed his said application the defendant also filed in said Patent Office an application for a patent on a composition of matter, and that after the aforesaid patent was issued to the said plaintiff, the said defendant copied the claims of the said patent of the plaintiff and requested an interference thereon; that thereupon an interference was declared between the two patents just mentioned, as a result of which the Examiner of Interferences awarded to said defendant priority of invention of the subject matter involved in said interference and that this decision of said Examiner was thereafter affirmed, on appeal, by the Board of Appeals; and that, therefore, the plaintiff brings this bill of complaint under said Section 4915 of the Revised Statutes and prays that he may be adjudged to be the first, sole, and original inventor of the subject matter in controversy and entitled, as such, to receive a patent for his invention as specified in his claims, and that said defendant may be adjudged not to be such inventor of the subject matter of said interference or of any part thereof and not entitled to receive a patent upon his aforesaid application.

The motion of the defendant recites that it appears from the bill of complaint that this Court has no jurisdiction over the subject matter of this suit and is without jurisdiction to hear and determine this cause because said bill shows that this suit is brought under Section 4915 of the Revised Statutes, which provides a remedy by a bill in equity only for an applicant for a patent whose application has been refused, whereas said plaintiff is a patentee in the aforesaid patent issued to him and involved herein; that said section provides no remedy or

relief for such a patentee under the averments of said bill; that the only affirmative relief provided by said section is an order of the Court authorizing the Commissioner of Patents to issue a patent to the applicant plaintiff, and that, as plaintiff herein now has a patent covering the subject matter at issue, relief under this section is not provided, notwithstanding that plaintiff has been unsuccessful in the aforesaid interference involving such subject matter.

**Basis of Right for Suit.**

Section 4915 of the Revised Statutes of the United States, which, as amended by the Act of March 2, 1927, is now Section 63 of Title 35 of the United States Code, contains the following provision:

"Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the Court of Appeals of the District of Columbia, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law."

The statute just quoted is the basis, and the only basis, of the claimed right of the plaintiff to maintain the present suit, as indeed appears even from the allegations of the bill already mentioned. The nature and extent of such right are defined and limited, and must be determined, by the language of this statute, properly construed. Unless, then, this statute applies to the plaintiff and confers on him the right to prosecute this suit, the motion of the defendant must be granted and the bill dismissed. It must also be borne in mind that the jurisdiction of the Federal court, when challenged, is not to be presumed, but must be made to affirmatively appear by him who invokes it.

In examining the language of the statute just quoted, it will be noted that it is thereby clearly provided that it is only "whenever a patent on application is refused" that resort to the "remedy by bill in equity" thereby created is authorized, and that only "the applicant * * * may have remedy by bill in equity." It will also be noted that, in prescribing the "remedy" thus created, the statute provides that "the court * * * may adjudge that such applicant is entitled, according to law, to receive a patent for his invention," and that "such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent." There is no vagueness nor ambiguity in this language of the statute and it seems plain that the application of such statute is expressly limited, by its terms, to an applicant for a patent whose application has been refused by the officials of the Patent Office and that it has no application to a person, such as the plaintiff here, who has already received from the Patent Office the patent which is the subject matter of the suit which he thus seeks to institute in this Court.

It is conceded in the brief of the plaintiff that "if the strict and literal construction of the wording of the section is followed, it would appear that a patentee does not belong to those entitled to the relief extended by the section;" but it is urged on behalf of the plaintiff that "It is not unreasonable to suppose that the draftsman of Section 4915 overlooked the possibility of a patentee becoming entitled to the relief intended."

**Claim of Omission.**

It is argued that "In drawing Section 4915, the draftsman, with the consent of Congress, either carelessly omitted or intentionally omitted the phraseology that would expressly extend the right provided by the section to parties to an interference"; and in support of this contention counsel refers to the language of Section 4909 of the Revised Statutes, being Section 57 of Title 35 of the United States Code, which provides that "Every applicant for a patent * * * and every party to an interference may appeal from the decision of the Primary Examiner, or of the Examiner in charge of interferences in such case, to the Board of Appeals," and counsel argues that similar language should be read into Section 4915 "and the

section construed as though it expressly referred to any party to an interference." I am unable to follow or agree with this argument, which, in my opinion, defeats itself, since it necessarily assumes (and, as I think, properly so) that Congress, in enacting Section 4909, as amended by the Act of March 2, 1927, had in mind the propriety of expressly mentioning "every party to an interference" when it desired to grant a right to such a party as well as to "every applicant for a patent." Consequently, when it omitted similar language from Section 4915, which it also had under consideration, and amended in certain respects, at the same time and by the same Act of March 2, 1927, the implication is strengthened, rather than weakened, that such omission was deliberate and indicates its intention to limit the remedy of that section to the "applicant" there mentioned.

If there were any doubt as to the correctness of the conclusion to which I have referred, with respect to the proper construction of Section 4915, such doubt would be removed by a consideration of the language of Section 4911 of the Revised Statutes, being Section 59a of Title 35 of the United States Code, as amended by the Act of March 2, 1927, already cited, which section, as so amended, provides as follows:

"If any applicant is dissatisfied with the decision of the Board of Appeals he may appeal to the Court of Appeals of the District of Columbia, in which case he waives his right to proceed under Section 63 of this title. If any party to an interference is dissatisfied with the decision of the Board of Appeals he may appeal to the Court of Appeals of the District of Columbia, provided that such appeal shall be dismissed if any adverse party to such interference shall, within 20 days after the appellant shall have filed notice of appeal according to Section 60 of this title, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in Section 63. Thereupon the appellant shall have 30 days thereafter within which to file a bill in equity under said Section 63, in default of which the decision appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said 30 days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said Board of Appeals shall be withheld pending the final determination of said proceeding under said Section 63."

### Intent on Part of Congress.

Not only does the language just quoted show that Congress, in legislating on this subject, was careful to expressly grant to "any party to an interference" such rights as it desired such a party to exercise, but it also clearly indicates an intent on the part of Congress to make the provisions of Section 4915, which is referred to in Section 4911 as "Section 63," inapplicable to a party to an interference other than an applicant only if an adverse party to such interference has appealed from a decision of the Board of Appeals to the Court of Appeals of the District of Columbia. As, however, it does not appear that either party to such interference took any appeal from the decision of the Board of Appeals, the provisions of said Section 4911 can have no application to the present suit except as an aid in determining the proper construction of the applicable language of Section 4915. The evident intent of Congress was that no party except an applicant may file a bill in the district court to review the action of the Patent Office under either Section 4911 or Section 4915.

For the reasons stated, I reach the conclusion that the plaintiff is not within the provisions of Section 4915 of the Revised Statutes and that, as his bill of complaint herein is based solely upon rights claimed to have been granted by said section of the statute, the motion of the defendant to dismiss said bill must be granted and such bill of complaint dismissed accordingly, and an order to that effect may be entered.

APRIL 10

# Slow Heating of Oil as Part Of Fractional Distilling Process

EX PARTE JOHN PRIMROSE. APPEAL NO. 497, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1707369 was issued April 2, 1929, to John Primrose for a method of Fractional Distillation, on Application No. 689404, filed January 30, 1924.

The rejection of claims 1 and 2 as being unpatentable over references was affirmed.

Appellant's method of distilling oil consisting in circulating oil through a closed system including a storage tank and a heating device, wherein the heat applied and the velocity of oil are so regulated that the temperature of the oil raised gradually without heating it to cracking temperature, was held anticipated by a prior patents.

The Board found that the differences which appellant pointed out as distinguishing his device from those of the prior art were not present in the claims. The statement in claim 2 as to "relatively clean distillation cuts" not in excess of a "predetermined and relatively small amount," the opinion states, was too general to be patentable.

John E. Hubbell for the applicant. Before First Assistant Commissioner Kinnan and Examiners-in-Chief Henry and Ruckman.

The full text of the decision of the Board of Appeals follows:

This is an appeal from final rejection of claims 1 and 2. Claim 1 is reproduced for illustrative purposes.

"1. In distilling oil, the method which consists in circulating the oil through a closed system comprising a storage tank and a fire heated tubular oil heater with such velocity of flow through the oil heater relative to the heat absorption capacity of the oil heater as to gradually raise the temperature of the oil in the system without heating the oil to a cracking temperature, and withdrawing the vapors liberated as the oil is heated up."

The references cited are: Johnston, 117425, July 25, 1871; French, 1394488, October 18, 1921; Hanna, 1449227, March 20, 1923; Peebles, 1438502, December 12, 1922; De Clerq (German), 166723, January 10, 1906.

What appellant is claiming is a method of distilling oil. The method consists in circulating the oil through a closed system including a storage tank and a heating device, the heater being of such character and the velocity of oil travel being at such a rate that the temperature of the oil is raised gradually without heating it to a cracking temperature.

The vapors liberated as the oil is heated up are withdrawn and led to a suitable condenser. The point mainly stressed on the appeal is the gradual raising of the temperature of the oil in the system. The claims on appeal do not bring out whether this raising of temperature gradually refers to a single fraction of the distillation or to all of the fractions successively.

Some point is also made of the special form of oil heater employed, but we think patentability cannot be predicated on the special form of apparatus employed in carrying out the method.

It is also argued in the brief on appeal in support of the patentability of the claims that here the oil is being treated in batches as distinguished from the treatment of the oil continuously. There is nothing in the claims limiting them to batch treatment.

The reference discussed most extensively by the Examiner and by appellant in his brief is the patent to French. This reference relates to fractional distillation, and clearly discloses the regulation of the temperature and speed of travel of the oil. It is appellant's contention, as we understand his position, that the French reference fails to disclose the gradual raising of the temperature of the oil system.

Appellant admits that at a certain stage in the French procedure the temperature is raised, i. e., when going from a lower boiling to a higher boiling fraction, but contends that there is no gradual rise in temperature of the oil. Appellant also makes the point against the French reference that the fractional distillation therein is carried out in distinct stages; hence there can be no gradual rise of temperature of the oil between successive fractions.

The differences pointed out, while

probably existing in the systems, i. e., appellant's system and that of the French patent, have not been included in the claims on appeal. Thus, when the system of French is started into operation the oil pumped from the receptacle A into the heater C will be relatively cool when it enters the heater with a higher temperature when it is sprayed into chamber E.

No reason is seen for denying that the oil is gradually heated in its travel through the heater and into chamber E. Accordingly, we hold that the appealed claims are not patentably distinguished from the French reference.

The statement in claim 2 as to "relatively clean distillation cuts" not in excess of a "predetermined and relatively small amount," is too general to set up a patentable distinction.

The patents to Hanna et al. and Johnston do not meet the claims literally. In the Hanna et al. reference cracking is desired. However, this reference discloses a temperature differential between the heating coil 16 and the tank 9.

No reason is seen why the heat increase is not gradual. The Johnston patent discloses clearly in an oil distillation process a gradual rise of temperature. We refer to the temperature change taking place as the oil flows downward over the surfaces of chambers B, B1, B2, B3 and B4.

It is doubtful if there would be any invention in connecting the lower chamber B4 with receptacle E, thereby providing for a continuous circulation.

Touching the Hanna et al. patent we are not satisfied that, as broadly as the appealed claims are drawn, it would be inventive to employ temperatures not high enough for cracking, but suitable for distillation.

In the German patent, No. 166723, there is disclosed a tar distillation process in which the tar or oil is forced by a pump from a receptacle through pipes B to a coil contained in a fire heated coil heater. It is clear, we think, from the disclosure of the reference that the tar or oil enters at the top of the furnace and passes downward through the coil to the region of greatest heat, thereby securing a gradual rise of temperature in the oil or tar.

The tar is then forced back into the receptacle completing the circulation in a closed system. We think the appealed claims are not patentably distinguished from the German reference.

The decision of the Examiner is affirmed.

Limit of appeal to Court of Appeals 40 days. Rule 149.

## APRIL 15

# *Mechanism for Drilling Rocks*

EX PARTE RUDOLPH S. WEINER. APPEAL No. 1188, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1707649 was issued April 2, 1929, to Rudolph S. Weiner for rock drilling tools, on application No. 551272, filed April 10, 1922.

References failing to describe the devices disclosed therein as being capable of operating in the manner in which the device specified in claim 22 operates, were nevertheless held to be anticipations for the reason that they inherently possessed that capability of operation.

The examiner's rejection of claims 22, 25, 26 and 28 on prior art was affirmed. Claims 23 and 24, however, were allowed on appeal.

Louis A. Maxson for applicant.

Before First Assistant Commissioner Kinnan and Examiners-in-Chief Henry and Ruckman. The full text of the decision of the Board of Appeals follows:

The claims presented for consideration on this appeal are numbered 22 to 26, inclusive, and 28. Claims 22 and 23 are reproduced for illustrative purposes:

"22. In combination a drilling motor having a plurality of parts, means for holding the parts thereof in assembled relation, alined feeding means for said motor, said feeding means being swingable laterally relative to said motor about said holding means as a pivot to permit access to the rear end of the motor while the holding effect of said holding means is maintained the same, and means for fixedly holding said feeding means in operative position.

"23. In combination, a drilling motor having a plurality of parts, means under tension for holding the parts thereof, in assembled relation, alined feeding means for said motor normally rigidly connected thereto at the rear end thereof, cleansing means carried by said drilling motor and removable rearwardly therefrom, and means operable to permit said feeding means to be swung laterally relative to said motor about said hold-

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ing means as a pivot to permit removal of said cleansing means while the tension of said holding means remains the same."

The references relied upon are: Bayles et al., 1114335, October 20, 1914; Bayles et al., 1201676, October 17, 1916; Smith, 1253290, January 15, 1918; German patent, 232872, August 20, 1910.

The claimed construction is a drilling mechanism including a drilling motor, having associated therewith a cleansing mechanism, and a feeding means for the motor alined therewith and so connected to the motor that upon the release of a screw or bolt the feeding means may be swung laterally to permit access to the rear end of the motor. The parts of the motor and the feeding means are held together by rods extending longitudinally of the motor and one of the rods serves as a pivot for lateral swinging of the feeding means when the screw or bolt heretofore mentioned is released.

Claim 22 has been rejected on each of the references listed in the statement on appeal. None of the references describes the capability of the feeding means to swing laterally relative to the motor but we think the Bayles and Taylor construction of patent No. 1114335 inherently possesses that capability. If one of the bolts 11 of the reference construction were removed the feeding means could swing laterally about the remaining bolt 11 as a pivot. It is our view that the rejection of claim 22 should be sustained.

### Removal of Cleansing Parts.

Claim 23 stands rejected on the patent to Smith, No. 1253290. This claim includes the cleansing means carried by the motor and removable rearwardly therefrom. The claim also is limited to the feature of the lateral swinging of the feeding means relative to the motor. It is probably true that the cleansing means of the reference construction can be removed by disassembling the parts of the mechanism but there is no provision for laterally swinging the feeding means. It seems to us that the overlapping of parts of the motor and feeding means would prevent lateral swinging while the tension of the holding means remains the same. It is our view that claim 23 is not fairly met by the Smith patent.

Claim 24 was rejected upon the references cited against claim 22. We think the claim is not met by the references cited. The claim not only includes the feature of the lateral swinging of the feeding means relative to the motor but specifies that one of the holding elements is shorter than the other. This is a feature of the means for holding the parts of the motor in assembled relation while allowing the feeding means to swing laterally. This structural limitation is not disclosed in the Bayles and Taylor patent, No. 1114335, or in any of the other references cited.

### Unpatentability Distinguished.

Claims 25 and 26 are broad claims and in our opinion are not patentably distinguished from the Bayles and Taylor reference No. 1114335 for reasons stated in the discussion of claim 22. No reason is seen why the tension of the holding rod 11 of the reference retained in position would be disturbed when the feeding means is swung laterally.

Claim 28 has been rejected on the German patent No. 232872. We think the rejection should be sustained. The rear cylinder head of the reference may be taken as a part of the means for holding parts of the motor in assembled position. The feeding means is pivotally connected to the head and may be swung laterally thereby permitting access to the rear end of the motor. The language of claim 28 does not patentably distinguish from the construction and operation of the reference.

The action of the examiner respecting claims 22, 25, 26 and 28 is affirmed. The action concerning claims 23 and 24 is reversed.

Limit of Appeal to Court of Appeals 40 days. Rule 149.

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# *Abrasive Stone for Use as File*

EX PARTE GEORGE E. DRESSER. APPEAL No. 136, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1707472 was issued April 2, 1929, to George E. Dresser, for abrasive stones on application No. 738161, filed September 17, 1924.

Claims 1 and 2, covering thin, weak strips of abrading material reinforced by a channel-shaped metallic strip along one edge and adapted for use as a hand tool to operate between contact points of automobile ignition systems, were held patentable over the prior art disclosing

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channel-shaped holders for blocks of arbading material mounted in supports for use in machines.

New Article of Manufacture.

Byrnes, Stebbins, and Parmelee for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Skinner and Landers) follows:

This is an appeal from the action of the examiner finally rejecting claims 1 and 2, of which claim 1 is an example:

"1. As a new article of manufacture, an abrasive stone for use as a file for dressing the contact points of automobile ignition systems consisting of a strip of abrasive stone of substantially uniform thickness of about 1-16 inch throughout its length and which is thin enough to pass between the contact points of such ignition systems but not thick enough to withstand the use to which it is to be put without breaking and a sheet metal reinforcing member of channel form closely fitting over one edge of the strip along substantially its full length, said reinforcing member extending over a small portion only of the width of the stone and being sufficiently thin so as not to interfere with the use of the stone in dressing the contact points of automobile ignition systems."

The references relied upon are: Cowing, 38153, April 14, 1863; Griffin et al., 729329, May 26, 1903; Gardiner, 437106, September 23, 1890; Johnson, 763764, June 28, 1904; Root, 783464, February 28, 1905; Gherky, 1095994, May 5, 1914; Graf (Aust.), 48177, May 26, 1911; Voigt (German), 332527 August 22, 1919.

Sufficient Novelty for Claims.

The references disclose channel shaped holders applied to the longitudinal edge of strips of felt and blocks of abrading material held in dovetailed supports mounted on machines, but none of them disclose thin weak strips of abrading material reinforced by a channel shaped metallic strip embracing one longitudinal edge of the same so that it may be used as a hand tool and operate in narrow spaces between the contact points of automobile ignition systems. The patent to Johnson shows a V shaped piece of metal embracing the end of a piece of abrading material but it is at most a mere handle or gage and not a reinforcement for a long thin strip of abrading material.

There seems to be sufficient novelty to support the claims and we therefore reverse the decision of the examiner.

# *Attachment for Vacuum Cleaner*

EX PARTE ADAM A. SERVA. APPEAL No. 357, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1708282 was issued April 9, 1929, to Adam A. Serva, for attachments for vacuum cleaners, on application No. 715112, filed May 22, 1924.

This decision holds that a claim for a vacuum cleaner which depends for its novelty upon the use of a "tapered throat at the entrance" of the cleaner is not patentable, for the reason that it is old in the vacuum cleaner art to provide the part to which the hose attachment is coupled with a tapered opening to receive a tapered bearing surface. Accordingly claim 2 was disallowed over claim 1.

Unpatentability of Claim.

Claim 4 was also held unpatentable over claim 1, where it specified that the neck portion leads "from the suction chamber to the inlet opening of the fan chamber," whereas claim 1 stated that the neck leads "from the suction chamber to the fan chamber."

Frease & Bond for applicant. Before First Assistant Commissioner Kinnan and Examiners-in-Chief Skinner and Ide.

The full text of the decision of the Board of Appeals follows:

This is an appeal from the decision of the Examiner finally rejecting Claims 2 and 4 which read as follows:

"2. A vacuum cleaner, including a case forming a fan chamber and a nozzle with a suction chamber having a mouth, and a neck leading from the suction chamber to the fan chamber with a tapered throat at the entrance thereof, and a hose attachment including a tubular shoe having a tapered end insertible through the mouth and wedged into said throat.

"4. A vacuum cleaner including a case forming a fan chamber with an inlet opening, and a case forming a nozzle with a suction chamber having a mouth and a neck leading from the suction

chamber to the inlet opening of the fan chamber, and a hose attachment including a tubular shoe having a tapered end insertible through the mouth for wedging into the entrance end of said neck," as not patentable over allowed Claim 1 which reads:

"1. A vacuum cleaner, including a case forming a fan chamber and a nozzle with a suction chamber having a mouth, and a neck leading from the suction chamber to the fan chamber, and a hose attachment including a tubular shoe having a tapered end insertible through the mouth for wedging into the entrance end of said neck."

in view of the following references: Hoover, 1483977, February 19, 1924; Bing-Werke (German), 343519, November 4, 1921.

Claim 2 differs from Claim 1 only in having the words "with a tapered throat at the entrance thereof" in line 3, following the description of the neck. It is old in the vacuum cleaner art to provide the part to which the hose attachment is coupled with a tapered opening to receive a tapered bearing surface upon the end of an attachment.

This is shown at E2 in Figures 6, 8 and 11, in the patent to Hoover, in the entrance E' to the fan chamber from the suction chamber. The German patent also shows a tapered recess in the neck leading from the nozzle of a vacuum cleaner whereby the tapered end of an attachment may be wedged therein. Claim 2 merely adds to a novel combination a feature which is old in the art and we think the rejection should be affirmed.

Claim 4 differs from Claim 1 by specifying that the neck leads "from the suction chamber to the inlet opening of the fan chamber" while Claim 1 specifies that the neck leads "from the suction chamber to the fan chamber."

Claim 1 necessarily implies "an inlet opening," without which the claim would be for an inoperative construction. We see no patentable distinction between the claims, and the patent to Hoover shows an inlet opening E' to the fan chamber.

The decision of the Examiner is affirmed. Limit of appeal to Court of Appeals 40 days. Rule 149.

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APRIL 17

# *Infringement of Device Used To Fold Edge of Shoe Uppers*

BEACON FOLDING MACHINE COMPANY, PLAINTIFF, APPELLANT, v. ROTARY MACHINE COMPANY ET AL., DEFENDANTS, APPELLEES. No. 2289, CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

PATENT No. 1527395, relating to machines for folding the edges of shoe uppers was held valid and infringed, the decree of the District Court being reversed.

The device in suit, consisting of a fold presser for the folding machine, comprising a curvilinearly faced hammer and an extension toe, so designed that the toe portion will pinch the edge which has been folded over and the curvilinear portion will roll over the fold, ironing it out smoothly, the Court concluded, was not anticipated by prior art in which the presser has a flat face pressing with its entire surface.

### A Mechanical Equivalent.

Defendant's fold presser, made up of disks having curvilinear faces, each face having a curved notch which straddled the fold, was found to be the mechanical equivalent of the patent structure and to constitute an infringement of it.

As to improvement patents Nos. 1527396 and 1589718, the decree of the District Court to the effect that defendant's machine did not infringe was affirmed.

The wiper strip, to which Patent 1527396 is directed, consisting of an oscillating finger acting on the under side of the work to move the strip across the line of the seam to a position substantially in the plane of the upper to which it is sewn, though slightly below it, was found not to be infringed by defendant's machine which opened out the edging by a plow acting in conjunction with a rib on the feed wheel and a wheel presser on top.

In a dissenting opinion, it is stated that plaintiff and defendants are assignees of the same inventor, that present counsel for the plaintiff drew the patents in an obvious attempt to make some of the 204 claims read on defend-

ants' device, that in making defendants' machine the inventor struck out on an entirely new line, and that there was no room for the doctrine of equivalents.

Appeal from the District Court for the District of Massachusetts.

Before Bingham, Johnson and Anderson, Justices. The full text of the court's opinion, delivered by Judge Bingham, and the dissenting opinion of Judge Anderson, follows:

This is a suit in equity brought in the District Court for Massachusetts by the Beacon Folding Machine Company, a Massachusetts corporation, against the Rotary Machine Company, a Massachusetts corporation, and Andrew R. Ridderstrom, Jerome P. Byron, Carl A. Tongberg, John M. Cashman and Christian Christiansen, citizens of Masschusetts, and officers and stockholders of the Rotary Machine Company, for infringement of Letters Patent No. 1527395, applied for January 21, 1920, issued February 24, 1925, to the Beacon Folding Machine Company, assignee by mesne assignments from Andrew R. Ridderstrom; for infringment of Letters Patent No. 1527-396, applied for February 28, 1923, issued February 24, 1925, to the Beacon Folding Machine Company, assignee of said Ridderstrom; and for infringement of Letters Patent No. 1589718, applied for November 3, 1922, issued June 22, 1926, to the Beacon Folding Machine Company, assignee of said Ridderstrom, the inventor of all three patents.

In the court below several claims of the first patent, No. 1527395, were put in issue, but claim 72 is typical of the claims relied upon and reads as follows:

"72. A folding machine having, in combination, a fold presser, means for advancing a sheet of material to the fold presser with the margin folded over upon the sheet, means whereby the fold presser is adapted to engage the folded-over sheet at the edge and margin of the fold only, and means whereby the fold presser is adapted to engage the successive portions of the folded-over portion of the sheet progressively from the edge of the fold inward to progressively press the said successive portions of the folded-over portion from the edge to the inward."

### Objects of the Invention.

In the specification of this patent, the applicant states that his "invention relates to methods of and machines for operating upon flexible material, and more particularly to methods of and machines for folding the edges or margins of shoe uppers, such as vamps and tips."

After setting out in the specification that the objects of the invention are (1) "to provide a new and improved machine of the above-designated character [a folding machine] which shall be simple to construct, etc."; (2) "to provide an improved method of operating upon flexible material, like shoe uppers"; (3) "to provide a folding machine with a variable gage, so that different portions of the work may be differently gaged, as desired"; and (4) "to provide an improved folding machine with positive or all-lever connections the parts of which shall operate at high speed in the desired time relation," the applicant states: "It has hitherto been customary to provide the fold presser with a flat face which pressed down upon the work throughout its surface at one and the same time, producing, upon occasion, a wrinkled fold parts of which were not so well pressed as others. It is, therefore, still another object of the invention to provide an improved fold presser for a folding machine, which shall operate to press the folds progressively from the edge of the fold inwardly.

To the accomplishment of this result, a feature of the invention resides in a curvilinearly faced hammer which is adapted [by reason of an extension toe] initially to pinch the very edge of the fold and then to roll over upon the fold, ironing it out smoothly."

The specification also points out that the fold presser, in a folding machine of the short-feed or step-by-step type and to which it is shown to be especially applicable, operates intermittently; that is, that when the feed elements are in operation in such a machine the presser remains still until the feeding mechanism has ceased working, or practically so, when the presser immediately begins to operate.

The prior art discloses that the inventive features of the fold presser, if any, reside in its curvilinear face and extension toe.

In the District Court it was found that the fold presser is "distinctly different" from those of the prior art, and is "of a novel character;" that it was designed "to pinch the edge which had been folded over, and then to roll out the edging on the sheet"; that "the defendants' machine had nothing at all similar in character to this folder of the plaintiff's patent"; that "the revolving cam-shaped wheels of the defendants' machine which successively pass over the edging, always moving in the same direction as the head rotates, operate on a radically

different principle from the reciprocating folder or presser of the plaintiff's machine"; that the defendants' machine does "not embody this element [a fold presser] of the plaintiff's claims, nor . . . the mechanism or the inventive idea of that patent"; and that the first patent was not infringed.

### The Defendant's Contention.

It is the defendants' contention that the invention in the plaintiff's presser resides in its extension toe, and not in its curvilinear face; that the toe of its fold presser is adapted to pinch or press the fold at its very edge; that while the disks on the head of the defendants' machine each have a curvilinear face that press the fold, they do not press the fold at the very edge but begin to press it at a slight distance in and away from the edge; that the curved notches in the disks step over the edge of the fold and do not press it; that they cannot be regarded, either as a group or singly, as the mechanical equivalent of the toe of the plaintiff's fold presser, for the reason that they do not press the edge of the fold as does the toe of the plaintiff's presser.

We have carefully examined the prior art patents relied upon by the defendants and are satisfied that no fold presser is there disclosed having a curvilinear face adapted to roll and press a fold; though a flat fold presser having a toe is shown. Every prior art fold presser, with a single exception, had a flat face, which pressed with its entire surface. The exception is the Gimson British patent, where the face of the fold presser is not flat throughout but is flat in the region where it contacts with the fold. It presses the fold down flat at the edge, where it is adapted to apply its greatest pressure. It then yields slightly and being moved forward presses or irons the balance of the surface which it had not previously pressed; but in its forward movement it is only the flat portion of its face that contacts with the fold.

It thus appears that the curvilinear face of the plaintiff's fold presser is its chief inventive feature, for its toe extension, except in combination with the curvilinear face, was old. The purpose of the curvilinear face was to obviate wrinkles which might occur in a fold when pressed with a flat face or ironed out by a flat face as in the Gimson patent; and it accomplished its purpose, for machines embodying it went into general use. While it cannot be regarded as a pioneer device in the art of folding the thin or skived edge of a shoe upper, or of folding a strip of fabric or tape sewed to the edge of an upper, and be accorded a wide range of equivalents, it is of a character entitled to a reasonable range of equivalents and is not restricted merely to the device shown.

It must be conceded that each disk in the defendant's device, in that portion of its periphery that contacts with the fold slightly beyond its edge and which rolls along and presses down the inner portion of the fold, has a curvilinear face like the curvilinear face of the plaintiff's fold presser. Their device does not have the toe extension which presses the fold at its edge, but it does have in each of its disks, just preceding the curvilinear face, curved notches, which the defendants say straddled the fold at the edge and do not press it.

### Conflict In Testimony.

The plaintiff, however, says that these curved notches are so shallow that they do not straddle, but embrace and press the fold at its very edge, and are the mechanical equivalent of the toe extension of the plaintiff's device, and that the sequence of action in the defendant's device is the same as in the plaintiff's, to wit: that it first presses the edge of the fold with curved notches in the disks and then presses the balance of the fold by the rolling curvilinear face on the periphery of the disks.

Upon the question whether the curved notches in the disks press the fold at the very edge, the oral testimony submitted in the District Court was conflicting. The plaintiff, however, sought at the trial to demonstrate the defendants' machine and show that the curved notches were of such a character that they pressed the fold at its edge, but the court declined to have the demonstration. At the hearing in this court, the plaintiff was permitted to make the demonstration and thereby disclosed beyond question that the curved notches in the defendants' disks press the fold in a substantial manner and at its very edge; for a thread of silk fed between the notch of a disk and the edge of a fold was pressed so hard that it could not be released without breaking it.

No question was made as to the fairness of the method pursued in making the pressure test and no explanation or qualification of it was offered. It is evident that the test was fair and the proof indubitable. It is also evident that the raised rib on the defendants' feed

wheel, and over which the edge of the fold comes, functions to raise the edge and increase the pressure of the curved notches upon it. We, therefore, conclude that the notch and the curvilinear face on each disk of the defendant's device perform the functions of the extension toe and curvilinear face of the plaintiff's fold presser, are their mechanical equivalents, and that the defendants infringe the claim here in issue under the first patent.

The claim for the fold presser is not restricted to a folding machine of the step-by-step type and there is no occasion for so restricting it.

The second patent, No. 1527396, is also for a folding machine adapted to fold a tape or strip of material which has been sewn to the edge of a shoe upper or sheet of leather, and which, when folded over the edge of the upper or sheet, forms a neatly covered edge, called a French cord. An oscillating finger called a wiper constitutes the invention of this patent. Otherwise the folding machine is the same as in the first patent.

The oscillating finger or wiper, as it is called, acts on the under side of the work and moves the strip or tape to the right, across the line of the seam, to a position substantially in the plane of the upper to which it is sewn, though slightly below it. This wiper or finger oscillates forward and back across the seam on the under side of the work. Its upper face is serrated and scratches or draws the tape across the seam substantially into the plane of the sheet, as above explained.

### An Additional Function.

This wiping out of the strip is the first work performed and takes place immediately after the work is fed a predetermined distance into the machine. Thereafter, the work of folding the tape takes place and is performed in the same way and by the same instrumentalities as are employed in the first machine. In other words the additional function performed by the machine of this patent over that of the first is the opening out of the binding strip so that it will lie substantially in the plane of the sheet preparatory to the actual folding operation. This alone constituted the invention. The machine of this patent is a step-by-step machine. When the feed is in operation the oscillating finger and the fold presser are still, and when the feed mechanism is still the finger and fold presser operate. The specification also shows that the stock is stationary while the wiper performs its work on the strip "at spaced or separated portions only of the strip;" that the wiper does not come in contact with the sheet to which the strip is sewn; and that in the sequence of the operations on the machine the wiper performs its duty before the other parts of the machine begin the folding of the binding.

The file wrapper of the patent shows that the applicant was required in the Patent Office to limit the scope of his claims for the wiper to "a wiper for wiping the unsecured edge of the strip across the secured-together edge into substantially the plane of the sheet." This clause appears in claim 67, which took the place of the canceled claim 73.

In the District Court it was found that "in the defendants' machine there is no such reciprocating wiper;" that "unless the word 'wiper' is extremely broadened, there is nothing that could be termed a wiper at all; that the defendants' machine opened out the edging by a plow acting in conjunction with a rib on the feed wheel and a wheel presser on top; that if the plaintiff's device was a pioneer invention it would be doubtful "whether the defendants' device could be regarded as in any way an infringement;" that "one device is not an infringement of another unless it involves the same inventive idea;" and concluded that "there was nothing in the inventive idea of the . . . second patent which has in any way been used in the defendants' device."

The principal question under the second patent is whether the rib on the defendant's feed wheel, which undoubtedly operates to guide the work, is also the mechanical equivalent of the oscillating wiping finger of the patent. In the defendants' machine the rib on the feed wheel as the work is being fed in, is forced into the angle formed at the junction of the sheet with the strip.

This is due to the pressure from above of the wheel presser, which presses the work down upon the rib and holds it in alinement, and the rib thus under pressure also tends to crowd the strip further to the right. To bring this about the operative, before inserting the work in the machine, is required to open out the strip from the angle which it takes when

sewed to the sheet so that it may be fed into the machine and forced down upon the rib and between it and the wheel presser.

### Requirement of a Wiper.

When the combination of a wiper in a folding machine was new with the second patent in suit, a machine for wiping out the edge of a strip of fabric was old. It is also highly probable that in all the prior art machines where the work was first opened up by the operative and then fed into the machine to be folded that, while the work was being fed in under pressure from above, the strip at the seam was to a greater or less extent crowded to the right, so that all the defendants' rib does is of a like nature and cannot be properly said to answer the requirement of a wiper or to be the equivalent of it.

In this respect we agree with the conclusion reached by the District Court that the defendants' device does not have a wiper and does not infringe; and that this is so even when the claims of the plaintiff's patent are given a construction somewhat broader than the particular device shown. All the claims of this patent are accordingly restricted. The method claims do not stand differently from the others. While the defendants are estopped to assert the invalidity of the method claims because they merely state the functions of the machine, they are not precluded from having them, or the machine claims, limited to the means shown or their reasonable equivalents. Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 556; Weaver v. American Chain Co., 9 Fed. (2d) 372, 382.

The third patent is like the second except that the upper feed element, which has a vertically moving foot corrugated at its lower end and adapted to grip and bend the material as it goes through the machine, has a notch in the heel or inner side of its foot so as to allow the work to bend up slightly at the edge. This notch in the heel or inner side of this foot or feed point is the invention of the third patent. In the prior art machines a space was provided to receive the bent up edge of the sheet or strip and, while the feed point in these machines was not notched, a space was provided to receive the bent up stock, which accomplished a like result. Furthermore, the sheet or upper to be operated upon in this machine is recessed at the edge to receive the edge of the attached strip or tape in the plane of the strip. This causes the edge of the work to turn up and, to remove the pressure of the feed foot upon it, a notch in that foot was provided to receive the edge of such specially constructed work.

The patent is necessarily of a limited character. The machine is identical with that of the second patent, except for the notch in the feed point. If, therefore, we assume the validity of the claims of this patent, they are limited to a feed point having a notch in the heel. The defendants' work retainer, which cooperates with the guide rib on the feed roll, does not perform the same function as the plaintiff's notched feed point. It bends the material down, rather than providing a notch to receive bent up work.

Its function is to hold the seam in the angle of the work close to the guide rib. It is not a feed point. The defendants' machine has no feed point and consequently no notch. A feed point is the member of a four-motion feed, which seizes the work, pulls it forward, then opens, moves back and again seizes the work. The District Court found that the defendants' machine did not infringe the third patent, and with this conclusion we agree. It is unnecessary to discuss the claims of this patent for the defendants' machine does not have the invention of the claims or anything like it.

### A Dissenting Opinion.

Anderson, J., dissenting: Plaintiff is the assignee of the same inventor as are defendants. Assuming defendants to be estopped to deny the validity of plaintiff's patents, they are not estopped to claim that, properly construed, no one of them covers defendants' device. Westinghouse Co. v. Formica Insulation Co., 266 U. S. 342. Present counsel for plaintiff drew these patents, after full knowledge of the construction and mode of operation of defendants' machines, in an obvious attempt to make some of the 204 claims read on defendants' device.

In fact, the patents make but slight advance in the old art of step-by-step folding machines. The majority opinion contains no adequate description of defendants' device. This machine warrants the claim of defendants' counsel that the inventor "struck out on an entirely new line, discarding all preconceived ideas which formed the basis of the step-by-step folding machines, and has produced a machine of a new genus." It is one of the most ingenious inventions I have ever seen. I regard it as a pioneer.

It is, both in structure and in opera-

tion, radically different from plaintiff's step-by-step machines. In general, it consists of peculiar cam-shaped wheels, operating in planetary fashion, feeding the stock continuously and not intermittently as do the plaintiff's machines. It does not "remain idle"—"practically stationary"—an instant, as the specification in patent No. 1527315 of plaintiff's machine sets out. There is no room for the doctrine of equivalents—even if the two machines do produce the same result—which I doubt. Hubbell v. United States, 179 U. S. 77; Electric Signal Co. v. Hall Signal Co., 114 U. S. 87; Diamond Power Specialty Co. v. Merz Capsule Co., 276 Fed. 274, 276; C. F. Mueller Co. v. Clermont Mach. Co., 20 Fed. (2d) 413, 415, affirmed 20 Fed. (2d) 416.

It cannot be too emphatically stated that plaintiff's and defendant's machines have only one thing in common—that is that both are intended to fold leather or binding strips. The inventive idea is entirely different. No one familiar with the art could, from the plaintiff's patent, conceive defendants' machine; plaintiff furnishes no instruction—either in drawings, specification, nor method claims, how to make the defendants' device. Study of the elaborate patent (No. 1527315) leaves the student an entire stranger to defendants' peculiar combination of wheels, so shaped and notched as to fold leather. This ends the case for plaintiff, as Judge Morton held.

**Experiment Beside the Mark.**

I regard the experiment in this court, on which the majority opinion rests, as entirely beside the mark. But I do not agree with the result reached through that experiment, nor with the implied criticism of the court below. I think the rulings of that court were entirely sound and proper; that the judge declined no demonstration pertinent to the issue it was trying. He ruled that, as the defendants had a roller with a notch in it, "The notch increases the clearance and reduces the pressure at the point where the notch appears." This made it immaterial whether you could "put the point of a pin in there" between the rolller and the stock. Nor do I agree "that the test was fair and the proof indubitable." The silk thread might have caught in various ways, even if the notches are deep enough to straddle. The experiment made no impression whatever on me. I refer to it now only to say that I do not agree with the inferences drawn from it by my colleagues.

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# *Construction to Preserve Validity*

UNIVERSAL RIM COMPANY, APPELLANT, v. MOTOR RIM & WHEEL CORPORATION, APPELLEE. No. 4011, CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

THE decree of the District Court holding claims 1, 2, 6, 8 and 9 of Patent 1095775 not to be infringed was affirmed on appeal, the court ruling that the claims covering appellant's demountable wheel rim for automobiles must be so narrowly construed, to rescue them from invalidity under the prior art, that they could not include appellee's devices.

The opinion states that "whatever of novelty there was in the driving means shown in the patent in question is not present in appellee's structure."

Appeal from the District Court for the Northern District of Illinois.

Before Alschuler, Evans, and Anderson, Circuit Judges. The full next of the court's opinion, delivered by Judge Alschuler, follows:

Appeal is from decree of the District Court dismissing, for want of equity, appellant's bill for infringement of claims, 1, 2, 6, 8 and 9 of U. S. Patent No. 1509775, issued to appellant, as assignee of Baker, May 5, 1914, for improvements in demountable wheel rims of the "bolted-on" type, for carrying inflated spare tires. The object of the invention is to facilitate the mounting and demounting of tires upon and from the rim.

**Claims for Construction.**

To this end an integrally flanged rim is transsplit at one point so that the ends may be made to overlap sufficiently to permit the tire to be more readliy removed from or placed into the grooved periphery of the rim. Means are also shown and claimed for holding the rim ends together when the rim is restored to circular form, and to prevent the rim from slipping on the felly as the wheel revolves.

Fig. 4 of the patent drawings shows the rim with mounted tire, separated from the felly of the wheel.

A detachable connecting plate 43 is

shown in place between the bottom of the tire and the outer surface of the rim. Studs 42 are made integral with the plate and pass through corresponding holes in the rim on each side of the split. The rim ends are thus held together against the contracting force exerted by the inflated tire, and expansion from the wedging action employed in bolting the rim on the felly. The studs 42 project sufficiently beyond the rim to fit into corresponding holes 41 in the felly. This positive engagement of rim and felly constitutes the "driving" feature claimed in the patent.

Claims 1, 2, 6 and 9 were in issue in Universal Rim Co. v. Firestone Tire & Rubber Co., 7 F. (2d) 24, where these claims are printed, and are hereby referred to.

It was a crowded field wherein Baker wrought. Demountable rims were old and numerous; so also the "bolted-on" variety. There were also transsplit rims. Baker himself, together with Hawley, procured a prior patent, No. 915954 (March 23, 1909) which showed an integrally flanged split rim with a tongue or plate fastened to one rim end and crossing the split. When on the wheel that rim engaged several small burrs on the felly and was thus more or less positively driven.

French patent No. 404452, to Bouquillon (1909), which the District Court properly found to be prior art, showed an integrally flanged split rim, but without specific means for connecting the ends. That Bouquillon had in mind that in practice some means were to be provided for connecting the ends is clear from the repeated statement in his specification that the rim ends "may be held end to end by any suitable means."

Whatever of novelty there was in the driving means shown in the patent in question is not present in appellee's structure. Its driving means consists not in the studs of a connecting plate, but in the lugs and bolts whereby the rim is firmly and immovably bolted to the wheel.

**Lack of Infringement.**

Nor does appellee's structure have the detachable connecting plate which the patent describes, but it has a short metal strip riveted to one rim end, on its inner face, and extending across the split and attached to the other rim end by a screw. While broadly this is "a plate extending across said split and positively and nonadjustably but detachably connecting the ends of the rim," as described in claim 1, and is "means on said ends positively but detachably connecting the same to render the rim inexpansible by the bolting-on devices," as stated in claim 9, yet with the limitations upon these claims necessary to rescue them from invalidity under the prior art because of their inclusiveness, appellee's structure does not infringe.

The opinion in the Firestone case, supra, where the structure in issue more closely approximated the patent than that here involved, obviates the need of more detailed discussion.

We are in accord with the conclusion of the District Court that appellee's structure does not infringe, and its decree dismissing the bill for want of equity is affirmed.

## APRIL 18

# *Invention in Remedy for Defect*

EX PARTE ROBERT A. PHAIR. APPEAL NO. 942, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1708519 was issued April 1929, to Robert A. Phair for methods of protecting fabrics, on application No. 14341, filed March 9, 1925.

Claims 3 to 6 were allowed upon a finding that the method of treating the fabric of rubber tires for automobiles with an alkali solution to prevent deterioration did not suggest the use of a like solution to treat laundered clothes to prevent their deterioration, it being stated that invention may exist in the discovery of the cause of a defect in an existing machine or process and applying a remedy therefor even though, after the cause is understood, the remedy would be obvious.

The rejection of claims 1 and 2 as being anticipated by the prior art was affirmed.

D. Anthony Usina for applicant.

Before Moore, Assistant Commissioner, Skinner and Landers, examiners-

in-chief. The full text of the Board's opinion follows:

This is an appeal from the final rejection of claims 1 to 6, inclusive. Claim 1 is illustrative and reads as follows:

"1. In the laundering of textile fabrics, the method which includes applying thereto a protective agent adapted to remain in the fabric after laundering and to prevent injury thereto by subsequent exposure of the fabric to acid vapors."

**Laundering of Textiles.**

The reference relied upon is: Muntz, 1203241, October 31, 1916.

The patent to Muntz states that in investigating the covers of pneumatic tires a break was found for which it was difficult to account. On chemically analyzing the fibers, strong traces of SO2 and SO3 were discovered and it was found that the sulphur used in vulcanizing the rubber had become oxidized and formed sulphuric or sulphurous acid which had attacked the cellulose of the fabric.

This trouble was remedied by treating the fabric which was to be used in making tires with a solution of barium hydroxid and then immersing it in a solution of ammonium carbonate which converts it into barium carbonate which is insoluble in water and will remain in the fabric and neutralize any sulphuric or sulphurous acid which may afterward be liberated. Other alkalis may be substituted for the barium hydroxid, such as sodium carbonate, borax or basic lead carbonate, or basic hydroxids such as lime, baryta, etc.

The appellant states that it is common in laundered fabrics to find small holes which do not appear until a considerable time after the goods are laundered. The cause of these holes was not understood but it was finally found that while the fabric was being dried and was still wet, it absorbed sulphur compounds from the air especially in the neighborhood of smelters or of large cities where the consumption of coal is considerable.

When the goods were sprinkled, prior to ironing, the drops of water spread out and the sulphuric acid became concentrated at the circumference and attacked the cellulose, making it brittle and when the goods were washed again the alkali used would dissolve out the brittle portion. The remedy applied was identical with that in the reference, except that the claims specify that the alkali is applied by the rinse water.

The question to be decided is whether there was invention in employing the method of protection disclosed by the Muntz patent for the protection of laundered goods by applying the alkali in the rinse water.

It has been held in a number of cases that invention may exist in the discovery of the cause of a defect in an existing machine or process and applying a remedy therefor even though, after the cause is understood, the remedy would be obvious. See Miehle Printing Press Co. v. Whitlock Pr. Pr. Co. C. D. 1915, page 284; Gen. Elec. Co. v. Sangamo Elec. Co., 174 F. 246; Gen. Elec. Co. v. Hartman 187 F. 131, and Rosemary Manfg. Co. v. Halifax Cotton Mills, C. D. 1919, page 327.

**The Benefit of the Doubt.**

The appellant points out that in the reference, it was known that the rubber of the tire contains sulphur and that the sulphur becomes oxidized so that it was not difficult to deduce that the break in the tire was caused by the formation of sulphuric acid which attacked the cellulose. In the case of laundered goods there was no sulphur in the goods and it was not obvious or readily ascertainable that the holes were caused by the action of sulphuric acid on the cotton. In view of these facts the appellant contends that it was an inventive act to discover the cause of the eating away of the fabric even though, after such discovery, the Muntz patent might suggest the remedy.

The Muntz patent was issued in 1916 yet it does not seem to have suggested anything to the operators of laundries as to the remedy for a trouble which must have been the cause of many complaints.

Claims 1 and 2 do not appear to involve anything more than the treatment of a fabric which has been laundered, with an alkaline solution as disclosed in the reference and we do not consider these claims allowable.

Claims 3, 4, 5 and 6 definitely include the treatment as a step in the process of laundering and although the question of patentability is close, we think the appellant may be given the benefit of the doubt.

The decision of the examiner is affirmed as to claims 1 and 2 and reversed as to claims 3 to 6, inclusive.

# Hoisting Device With Motor Drum

EX PARTE CHAS. F. OSGOOD. APPEAL NO. 430, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1708188 was issued April 9, 1929, to Chas. F. Osgood for hoisting mechanisms, on application No. 530387, filed January 19, 1922.

The examiner was sustained in the rejection of claims 5, 9 and 11 to 17, relating to various features of a hoisting mechanism.

In claim 5 the expression, "driving gearing between said motor and drum including driving pinions at opposite ends of one of said rotors," was found not sufficient to define the claim, in that the limitation to driving pinions at opposite ends of the rotor is an idle limitation as nothing is stated as having cooperative relation with said pinions.

**Anticipation in Prior Art.**

Claim 9 was found readable on a single reference except for the limitation that the motor is disposed within a drum, which limitation was considered unpatentable.

As being too indefinite to meet the requirements of Sec. 4888 R. S., where it specified "means whereby power is delivered, means for causing transmission of power, and means for imparting the power," and including as the limiting feature the statement that "said power transmission and imparting means includes gears carried on each end of said casing and movable in relation thereto," Claim 11 was disallowed.

It was also decided that Claims 12, 13, and 14 were too indefinite and too incomplete to differentiate from the prior art.

The Board agreed with the examiner in holding that a prior patent very different in structure and method of operation from appellant's structure constituted an "absolute literal anticipation" of Claims 15, 16, 17.

Louis A. Maxson for applicant. Before Moore, Assistant Commissioner; Smith and Ruckman, examiners-in-chief.

The full text of the opinion of the Board of Appeals follows:

This is an appeal from the rejection of Claims 5, 9, and 11 to 17, of which Claim 5 reads as follows:

"In a hoisting mechanism, a rotatable winding drum, driving means therefor including a motor disposed within said drum and having intermeshing rotors whose axes trace during operation of said motor surfaces of revolution whose directrices are parallel to elements of the surface of said drum, and driving gearing between said motor and drum including driving pinions at opposite ends of one of said rotors."

The references relied upon are: Elliott et al. (Br.), No. 4297, of 1884; Peirce, No. 425955, April 15, 1890; Pilling, No. 820939, May 15, 1906; Davenport, No. 1110313, September 15, 1914; Matthews, No. 1146339, July 13, 1915; Jenkins, No. 1192322, July 25, 1916; Borkes, No. 1323-245, December 2, 1919.

Claim 5 was rejected as an old combination. The examiner cites patents to Borkes, Davenport, Matthews, and Elliott as showing that it is old to place a motor inside the drum and connect the two by gearing. The claim distinguishes from these references in the type of motor used, i. e., a motor having intermeshing rotors, etc. Appellant does not contend that there is any novelty in the motor, per se. The distinction relied upon and urged by appellant in his brief is the limitation, "driving gearing between said motor and drum including driving pinions at opposite ends of one of said rotors." The examiner cites the patent to Pilling as showing a motor rotor having a pinion at each end and the patent to Elliott as showing that any kind of a motor may have a drum placed around it with some kind of a driving connection therebetween.

Appellant contends that his gearing is specifically defined in the claim to the extent of specifying that it shall "include driving pinions at opposite ends of one of said rotors" and although this feature is shown in Pilling, that it involves invention to arrange such gearing so as to operate the drum when the motor is placed inside the drum as specified in the claim.

Granting this is true, appellant has not specified in the claim the structure whereby his result is accomplished. Nothing is stated as cooperating with the "driving pinions at opposite ends" of the rotor. This limitation is an idle limitation and fails to define the invention. The term gearing is too broad and fails to bring out the invention even with the statement in the claim that the gearing includes driving pinions at opposite ends of the motor. Claims sufficiently specific to give a conception of

appellant's invention have been allowed by the examiner.

Claim 9 stands rejected "on Elliott in view of Pilling's motor and reducing gearing, to replace the slow-speed motor of Elliott." The examiner states that "Pilling's shaft 10 would merely be extended and would replace the crank shaft of Elliott Fig. 2." The appellant points out that a pinion on the other end of the shaft, if it meshed with the circular track of Elliott would render the device inoperative. It could be effected by securing the pinions to the shaft by clutches or by making one pinion a bevel gear and adding two bevel gears to reverse the direction of rotation in the usual way.

It is noted that the claim is readable on Pilling alone except for the limitation that the motor is disposed within the drum.

In our opinion claim 9 falls in the same class as claim 5 and is unpatentable for the same reasons.

We agree with the examiner's rejection of claim 11 on the same ground as claim 9 and also on the ground that it is indefinite, incomplete and functional. The claim specifies "means whereby power is delivered, * * * means for causing transmission of power * * * and means for imparting the power * * *." It includes as the limiting feature in this claim the statement that the "said power transmission and imparting means includes gears carried on each end of said casing and movable in relation thereto." In our opinion the claim does not meet the requirements of Sec. 4888 R. S.

The examiner rejects claims 12, 13 and 14 "as old combinations of a motor and a drum driven thereby." They do not locate the motor within the drum but specify that the motor casing has "its longitudinal axis coaxial to the drum axis."

Pilling is cited by the examiner with the observation that power could be taken from shaft 10 to drive a drum whose axis is in any position. Appellant's contention that the gears at each end in Pilling do not cooperate to effect a speed reduction appears erroneous. Small gear 20 meshing with large gear 19 at each end will effect a speed reduction.

As noted above we think these claims too incomplete and indefinite to patentably cover appellant's invention.

The examiner rejects claims 15, 16, and 17 on Pilling, holding that it is an "absolute literal anticipation."

We agree with the examiner that while appellant's structure and its method of operation is very different from Pilling, these claims are so broadly worded as to read fairly on Pilling. Appellant's contention that the pinions do not cooperate in Pilling to effect a speed reduction is erroneous as noted above.

Appellant has submitted an amendment for which he states permission was given at the hearing consisting in inserting the word "serially" after "cooperate," in each of the claims 15, 16 and 17. We do not think this amendment distinguishes from Pilling. In this patent small pinion 20 cooperates with large pinion 19 in effecting a speed reduction and apparently they cooperate serially in the reference as well as in appellant's device.

The amendment will be admitted, however, for purpose of appeal.

The decision of the examiner is affirmed.

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APRIL 19

# *Jurisdiction in Bringing Suit Against Patent Commissioner*

FRANK A. CANON AND CHESTER E. ANDREWS, PLAINTIFFS, V. THOMAS E ROBERTSON, COMMISSIONER OF PATENTS, DEFENDANT; HUGO DE WATTEVILLE SENITHA, PLAINTIFF, V. SAME; SINCLAIR REFINING COMPANY, PLAINTIFF, V. SAME. EQUITY NOS. 1340, 1360 AND 1370, DISTRICT COURT FOR THE DISTRICT OF MARYLAND.

IT IS held herein that the Commissioner of Patents can be sued under Section 4915 of the Revised Statutes only in the place of his official residence, the District of Columbia, except in such cases as he may accept service in other jurisdictions.

The motion to dismiss for lack of jurisdiction the bills of complaints brought under Section 4915 in the Dis-

trict of Maryland were granted, the court relying upon the Supreme Court decision in Butterworth v. Hill, 114 U. S. 128, holding that Section 51 of the Judicial Code exempts "a defendant from suit in any district of which he was not an inhabitant or in which he was not found at the time of the service of the writ; that such exemption might be waived, but unless waived the defendant need not answer and would not be bound by anything which might be done against him in his absence; and that the official residence of the Commissioner of Patents is at Washington in the District of Columbia."

**Jurisdiction Sole Question.**

The court referred to the Commissioner's statement made before the Committee on Patents in the Senate, Sixty-ninth Congress, December 21, 1926, to the effect that the "Commissioner will accept service only in the District of Columbia or in Baltimore nearby," and concluded that all that the Commissioner intended to say was that he could be reached only by consent in the Maryland District, and that in any event the Commissioner's interpretation could not and would not be binding upon the court.

In No 1340: Robert Ames Morton, for plaintiffs; A. W. W. Woodcock, United States Attorney, and T. A Hostetler, Solicitor for Patent Office, for Commissioner. In No. 1360: Hugo de Watteville Senitha, of New York, plaintiff, in person; Same for Commissioner. In No. 1370: Pennie Davis, Marvin & Edmonds, of New York, for plaintiff; Same for Commissioner.

The full text of the opinion of the court, delivered by Judge Coleman, follows:

The sole question here presented is whether this court has jurisdiction of the Commissioner of Patents in three suits in equity brought under Section 4915 of the Revised Statutes (44 Stat. 1335), to compel the Commissioner to issue certain patents. The question is raised by motions to dismiss the bills of complaint for want of jurisdiction. The Commissioner, although a resident of Chevy Chase, Md., and therefore a resident of this district, has refused to accept service of subpoenas there, claiming that he can be sued only in the District of Columbia, his official residence.

In a similar proceeding, Martin vs. Robertson, Commissioner, No. 1352 of the Equity Docket of this court, the Commissioner filed a motion to dismiss the bill, identical with the motions now before the court. After argument before Judge Soper, the motion was granted March 7, 1928. Complainants in the present suits have asked for a complete review of the question, which appears not to have been directly passed upon, at least in any reported case, in any other jurisdiction; and they have presented lengthy arguments, both oral and written, as has also the Commissioner of Patents, in each case.

The Commissioner relies primarily upon the decision of the Supreme Court in Butterworth v. Hill, 114 U. S. 128, decided in 1884. This was a suit under Section 4915 of the Revised Statutes, brought in the District of Vermont against the Commissioner of Patents who was an inhabitant of the District of Columbia and was there served with process. He did not appear, and a decree of the lower court in favor of the complainant was reversed for want of jurisdiction.

The Court, in an opinion by Chief Justice Waite, decided three things: (1) That Section 739 of the Revised Statutes (Act of March 3, 1875) of which Section 51 of the present judicial Code is an amendment (28 U. S. C. A., Section 112), applied to suits brought under Section 4915, of the Revised Statutes; (2) that the Act of March 3, 1875, exempted a defendant from suit in any district of which he was not an inhabitant or in which he was not found at the time of the service of the writ; that such exemption might be waived, but unless waived, the defendant need not answer and would not be bound by anything which might be done against him in his absence; and (3) that the official residence of the Commissioner of Patents is at Washington, in the District of Columbia.

The Court expressly declared that it did not decide, because unnecessary to do so, whether the jurisdiction of the District of Columbia court in suits under Section 4915 was exclusive, saying, page 131: "It is contended that the Supreme Court of the District of Columbia has exclusive jurisdiction of suits against the Commissioner brought under this section of the Revised Statutes. In the view we take of this case, however, that question need not be decided." But the Court added the following upon which the Commissioner primarily relies in the present cases, page 132:

"The bill in this case was filed against the Commissioner alone and it does not appear that he was an inhabitant of the

District of Vermont. The Patent Office is in the Department of the Interior, Rev. Stat., Sec. 475, which is one of the Executive Departments of the Government at the seat of Government in the District of Columbia. Rev. Stat., Sec. 437. The Commissioner of Patents is by law located in the Patent Office. Rev. Stat., Sec. 476. His official residence is, therefore, at Washington, in the District of Columbia."

The text of that part of the Judicial Code with which we are now directly concerned (28 U. S. C. A. Sec. 112a) is as follows: "* * * except as provided in sections 113 to 118 of this title, (which have no bearing upon the question at issue) no civil suit shall be brought in any district court against any person by any original process or proceeding in any other district than that whereof he is an inhabitant; * * *"

Comparing the above language with the earlier enactment, it will be seen that a defendant can no longer be sued wherever found, but only in the place where he is an inhabitant. The precise question before us is, therefore, does a United States Government official have a dual personality for the purposes of jurisdiction under this section, namely, does he have both an official and a private personality, separate and distinct from each other, and when sued officially, may he be said to inhabit or to reside only where he carries on his official duties, although he may have his home and live as a private citizen elsewhere?

It is well settled that the word "inhabitant" as used in the statute includes the idea of domicile or residence. Shaw v. Quincy Mining Co., 145 U. S. 444; United States v. Gronich, 211 Fed. 548; Thomas v. South Butte Mining Co., 230 Fed. 968.

There is some authority to the effect that interference proceedings brought under Section 4915, as opposed to purely ex parte proceedings, such as the present, may be maintained in any district where valid service can be had on the defendant without regard to his place of residence; and this has been held to be so under Section 51 of the Judicial Code, on the theory that since the suit arises under the patent laws of the United States, it is within the exclusive jurisdiction of the Federal courts and therefore, is not affected by the statutory provisions which it is claimed were intended to apply only to specified civil suits of which the Federal and State courts have concurrent jurisdiction.

See, for example, Lewis Blind Stitch Co. v. Arbetter Felling Machine Co., 181 Fed. 974; and Thomas v. Perre, 205 Fed. 632. But, in view of the express language of Section 51 above quoted, and of its proviso governing actions based upon diversity of citizenship, the soundness of this theory is at least doubtful, although the court does not now pass upon this question because unnecessary to a decision of the precise point before it.

**Even Stronger Dicta.**

Even stronger dicta than that in the Butterworth case, supra, in support of the Commissioner's contention that unless he consents to be sued elsewhere, he must be sued in the District of Columbia, is to be found in at least three cases. In Smertz Wire Glass Co. v. Western Glass Co., 178 Fed. 973, decided in 1909, District Judge Sanborn, then sitting in the Circuit Court for the Northern District of Illinois, Eastern Division, said, page 975:

"Unless the Commissioner actually appears to the suit it must be brought in the District of Columbia in one of its courts; that being his official residence. Butterworth v. Hill, 114 U. S. 128; 5 Sup. Ct. 796; 29 L. Ed. 119."

This statement, however, is unquestionably dictum, because not necessary to the decision. The suit was originally adversary in character, but afterward became an ex parte one by union of the adverse interests. Motions were made to dismiss the suit on the ground that the patents were procured by fraud and collusion in the proceeding brought to establish them, because there were no adverse interests. The Court denied the motions, finding no fraud and also finding that the adverse parties were originally within the jurisdiction of the Court. Thus the question of service upon the Commissioner was not involved.

**Quotation From Cited Ruling.**

The next decision in which the precise question is referred to is Barrett v. Ewing, 242 Fed. 506, decided by the Circuit Court of Appeals for the Second Circuit in 1917. There, Commissioner Ewing accepted service in New York, a district of which he was not a resident, and the Court held that a waiver of the right to object to the jurisdiction was not against public policy, and was therefore binding.

One of the objections made in support of the Commissioner's argument that he had no power to consent to be sued in New York was that the Supreme Court had declared in Butterworth v. Hill, supra, that the Commissioner of Patents

is by law located in the Patent Office and has his official residence at Washington, in the District of Columbia. To this the Court replied, page 508:

"It must be said of the first suggestion that, inasmuch as the Commissioner's official residence is in the District of Columbia, suits which are brought against him in his official capacity should be commenced in that district by virtue of the provision which requires suits to be brought in the district of which the defendant is an inhabitant. This, however, affords no light on the question whether he has the right, which other defendants are conceded to possess, to waive service in the district of his legal residence and to consent to be sued elsewhere."

Nothing more need be said to indicate that the above expression respecting the necessity for service in the District of Columbia is no more than dictum. Certiorari was denied in this case, 244 U. S. 661.

Lastly we have the case of Hammer v. Robertson, Commissioner of Patents, 6 F. (2d) 460, a decision of the Circuit Court of Appeals for the Second Circuit, in 1925, affirming a decree of the lower court granting motions to dismiss the bills of complainant (291 Fed. 656; 300 Fed. 246).

### Ruling on Jurisdiction.

In this case the complainant, after having carried the appeals on his application to the Court of Appeals for the District of Columbia under Section 4915 prior to its amendment in 1927, and after an adverse decision by that court, brought a suit in equity in the Eastern District of New York against Commissioner Robertson. The court held no jurisdiction was acquired by mailing or serving a copy of the bill upon the Commissioner in the District of Columbia, since such service was outside the jurisdiction of the Federal Court for the Eastern District of New York. The court said, page 461:

"As to the first attempt, that is in form of a plenary suit, not unlike Barrett v. Ewing, 242 F. 506, 155 C. C. A. 282, and several others, and the only question is whether the service of process confers jurisdiction; a point on which Butterworth v. Hill, 114 U. S. 128, 5 S. Ct. 796; 29 L. Ed. 119, has never been overruled and is binding on us. Therefore we hold that service on the defendant in Washington, D. C., was unavailing, and the decision below was right.

"Appellant urges that this renders R. S. Sec. 4915, a farce, because it throws him back into the courts of the District of Columbia, which have already decided against him, unless Mr. Robertson consents to be served in the district of his home, and he wants rights, not favors. Even recourse to the Supreme Court of the United States is by recent legislation denied. Chott v. Ewing, 237 U. S. 197, 35 S. Ct. 571; 59 L. Ed. 913; Baldwin v. Howard, 256 U. S. 35, 41 S. Ct. 405, 65 L. Ed. 816. This is the appeal ad misericordiam, and must be addressed to Congress, which makes statute law, not to us who apply it." (Quotation marks inserted.)

The anomalous result referred to by the Court, and which it explained could only be remedied by Congress, has since been remedied by the 1927 amendment of Section 4915 (44 Stat. 1335). It is clear that in this case, just as in all of the previous decisions above analyzed, the precise question raised by the present proceeding was nonexistent, and therefore the allusions to the necessity for consent on the part of the Commissioner, before he may be served "in the district of his home," are dicta.

### Question of Following Dicta.

Should the Court follow the dicta of these various cases, admittedly of a persuasive character, not only by virtue of what was originally said in the Butterworth case, but by virtue of the construction which the Circuit Court of Appeals for the Second Circuit, as well as that which the learned jurist, the late Judge Sanborn, placed upon it in the Eighth Circuit?

Indeed the dicta which we have from these last mentioned jurisdictions would seem to expand the dictum of Chief Justice Waite in the Butterworth case because in that decision, he not only declined to pass upon the alleged exclusive jurisdiction of the Supreme Court of the District of Columbia, but merely said that since the Patent Office is in the Department of the Interior, and is one of the Executive Departments of the Government at the seat of government in the District of Columbia, and since the Commissioner of Patents is by law located in the Patent Office, it follows that his official residence is in the same place.

Complainants urge as a further ground for assumption of jurisdiction

that the Commissioner should not now be allowed to say that he cannot be brought into this Court because he personally gave to the Senate, at the time the amendment to Section 4915 was before that body, a contrary expression of opinion. The text of this amendment of March 2, 1927, 44 Stat. 1335, is as follows:

Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision to the Court of Appeals of the District of Columbia, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law.

In all cases where there is no opposing party a copy of the bill shall be served on the Commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

### Contrast in Procedure.

At the hearing before the Committee on Patents in the Senate, Sixty-ninth Congress, Second Session, held December 21, 1926, when the amendment was under consideration, Commissioner Robertson outlined the procedure under the then existing law as contrasted with that proposed by the amendment, and made the following statement:

"The appeal from the Patent Office must be taken to the Court of Appeals of the District of Columbia. But if after losing in the Court of Appeals of the District of Columbia he wishes to afterwards file a bill under section 4915 he may do so, either in the Supreme Court of the District of Columbia or in the United States district court in Baltimore. We permit the latter, since by filing there he will not have to go to the same court of appeals as before. In other words, he may bring his suit under section 4915 in Baltimore, and it is heard by the Federal court there, the United States district court. If the decision is against him he can appeal to the Federal court of appeals for that district, which is not the Court of Appeals for the District of Columbia but the court at Richmond. So we have practically five appeals.

"Now, on the other part of the diagram we show the appeals as they would be under the proposed bill. First, we have only one appeal within the Patent Office itself. We are going to combine the appeals within the Patent Office under the proposed bill, so that the Commissioner of Patents, the first assistant commissioner, the assistant commissioner, and the examiners in chief, shall constitute a board of appeals, so as to have but the one appeal, thereby doing away with one appeal within the Patent Office itself.

"After we get through the Patent Office, after that one appeal, if the losing party desires to appeal further, he may take one of the two courses shown by the diverging arrows. He may either take an appeal to the Court of Appeals in the District of Columbia, or he may bring a suit in equity under section 4915, but he can not do both. So we have the single simplified appeal in the Patent Office, and the losing party will have only the one appeal from the Patent Office if he goes to the Court of Appeals. If, however, he prefers to go to the Supreme Court of the District of Columbia or the United States district court in Baltimore, under section 4915, he will have in effect two appeals. So we have actually cut these appeals down to two or three, as the case may be."

When asked whether the bill in equity could not be brought in any district, the Commissioner replied:

"It depends on whether it is an ex parte case or a contested case. If it is an ex parte case, the statute requires that service must be made on the Commissioner of Patents, and the Commissioner of Patents will not accept service in these suits all over the United States. The Department of Justice has

not thought it proper to do that, so the Commissioner will accept service only in the District of Columbia, 'or in Baltimore, nearby.'" (Quotations inserted.) —(U. S. Senate Committee on Patents, report of hearing December 21, 1926, pages 7 and 8).

There can be no question but that the amendment still leaves in doubt the exact intent of Congress when it used the words "the court having cognizance thereof." Unfortunately, the attempted clarification on the part of the Commissioner does not in fact clarify this particular phrase, and while the Commissioner admitted the complainants' right to obtain jurisdiction over him, as Commissioner, within the Maryland district, still the closing sentence above quoted would seem to indicate that all that the Commissioner intended to say was that he could be reached only by consent in this district.

**Result of Interpretation.**

However this may be, the Commissioner's interpretation would not, and could not, be binding upon this Court. Nor must any ambiguity in the statute be resolved against the Commissioner unless such conclusion is clearly justified, even if it be assumed that the legislative body was induced, to some extent at least, to pass the measure in reliance upon the representation that jurisdiction over the Commissioner would exist in this district, as a matter of right.

It is, of course, true that this suit, being an ex parte proceeding, is not a contest between two people asserting different rights, but rather it is a suit to determine whether or not the applicants are entitled to patents. It is further true that the argument advanced by the Commissioner, that he and his office will be subjected to great inconvenience if required to answer to suits outside of the district, carries little weight in the present instance because the proximity of Baltimore to the Patent Office nullifies the force that such argument might have were the Commissioner compelled to attend in jurisdictions far removed.

The true answer to the question is to be found not as a result of mere practical considerations, but in the meaning of the words employed in Section 51 of the Judicial Code, which we have heretofore quoted and examined.

We have seen that by the word "inhabitant" as there used is meant one who is resident or domiciled. We have also seen that the Supreme Court has expressly decided that the Commissioner of Patents has his official domicile in Washington.

At that time both the Commissioner's private and official domicile were presumably in the same place, Washington. Now, however, they happen to be in different, although proximate localities and jurisdictions.

As to what the Supreme Court would have said in 1884 at the time of the Butterworth decision, had the present facts been squarely presented to it, it is idle to speculate beyond the point of saying that the Court has at least left us a very strong intimation that it intended to distinguish between an official and private residence.

Such distinction seems to this Court to be logical, although, strange to say, there is an almost complete dearth of authorities touching upon this question. This is due, no doubt, for the most part to the fact that suits by and against departmental and other Government officials are usually controlled by special statutes.

**Lack of Authorities.**

Except for such decisions as Tait v. Baugh, 252 Fed. 317—wherein it was held that a suit against one as sheriff of a certain county in Tennessee, being an action against him as an individual and not against the office, service might be validly obtained against him out of his own State where he was not acting as sheriff—there are virtually no authorities on the subject in the Federal reports. Nor do textbooks and treatises appear to have dealt with the precise question.

And yet the construction which has been placed upon the language of the Supreme Court in the Butterworth case by more than one jurisdiction—including two decisions of that eminent Court, the Circuit Court of Appeals for the Second Circuit; in one of which certiorari was denied, although it, of course, does not follow that, had it been granted, this precise question would have been clarified—and the fact that that construction has been relied upon and adopted ever since the Butterworth case was decided, that is, for a period of 45 years, leads this Court to the conclusion that such construction should be followed unless and until a more forcible argument is presented for departing therefrom.

An order, therefore, will be signed granting the motion in each of the three cases. It follows that in case No. 1360 complainant's petition for a final decree pro confesso must be denied.

# Invention In Hoisting Apparatus

EX PARTE LOUIS A. MAXSON. APPEAL NO. 1708, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1708677 was issued April 9, 1929, to Louis A. Maxson for Hoisting Mechanisms, on application No. 530427, filed January 19, 1922.

Claims 1, 5, 11, 12 and 13 were held patentable upon appeal over a combination of references on the ground that it required such changes in the construction of the basic references as would amount to a reorganization thereof with a mode of operation not contemplated or suggested by the basic reference.

### Reasons for Rejections.

However, claim 1 was disallowed since it called for a final means which was not a structure separable from the previously recited means but was merely a characteristic of such means.

The expression "at least partially" was not such as to render claim 5 alternative, the Board stated.

The rejection of claim 9 as being for an old combination in the prior art was affirmed.

Louis A. Maxon pro se. Before Assistant Commissioner Moore, Examiners-in-Chief Henry and Ruckman.

The full text of the opinion follows:

This is an appeal from a final rejection of claims 1, 5, 9, 11, 12, 13 and 14. Claims 1 and 9 are reproduced for illustrative purposes:

"1. In a hoisting mechanism, a rotatable drum member, a motor having a rotatable casing member coaxial with said drum member and so disposed with relation thereto that a plane perpendicular to the axis of said drum member and cutting the winding surface of the latter also cuts said motor casing, said motor having a power shaft, and means having power supplied thereto by said power shaft for driving either of said members including means for selectively holding either member against rotation and means whereby holding one member effects rotation of the other.

"9. In a hoisting mechanism, a coaxially mounted drum and motor, said motor comprising a rotatable casing and a plurality of intermeshing rotors therein, means for transmitting power from one of said rotors to said drum, said means including braking means for holding said casing to effect rotation of said drum."

The references cited are: Eastwood, 724827, Apr. 7, 1903; Rupnow, 1128525, Feb. 16, 1915; Tadey, 1165814, Dec. 28, 1915.

The construction claimed in a hoisting mechanism including a winding drum having a supporting hub journaled in a frame standard and also journaled on a cylindrical motor casing. Both the drum and motor casing are rotatable.

### Train of Planetary Gearing.

A train of planetary gearing extends from the motor shaft to an internally toothed gear on the winding drum. A plurality of brake mechanisms is provided, one to supply braking pressure to the motor casing and the other to the winding drum.

When the braking mechanism is applied to the motor casing to hold it stationary the drum will rotate and vice versa.

The examiner rejects claims 1, 5, 11, 12, 13 and 14 on the patent to Tadey taken in connection with the patent to Eastwood. Each of the claims of this group is limited to a rotatable winding drum and a rotatable motor casing with means more or less specifically recited for selectively holding either the drum or motor casing stationary while rotating the other member.

In the Tadey patent which discloses a pulley block suspended from an eye or ring the motor casing is not rotated nor does there appear to be any reason for rotating it regard being had for the theory of operation of the apparatus. The Eastwood patent is for an electric motor having a rotating field frame provided with braking mechanism, which, when applied, will stop the rotation of the field frame and permit the rotation of the armature.

The armature shaft carries a pinion from which power may be taken. It is the view of the examiner that the Eastwood patent would teach the modification of the pulley block of the Tadey patent to produce a construction responding to the claims under consideration.

The trouble we find with this rejection is that it involves such changes in the construction of the basic reference as would amount practically to a reorganization thereof with a mode of operation not contemplated or suggested by the Tadey patent.

With respect to Claim 1 the examiner points out that the "means" recited as the final element of the claim is not identified. We think the criticism is jus-

tified. The means referred to is not a structure separable from previously recited means, but is merely a characteristic of such means. In its present form Claim 1 should not be allowed. As to Claim 5 we think the expression "at least partially" does not render the claim alternative.

**Drum and Motor Combination.**

Claim 9 has been rejected as an old combination of drum and motor with driving connection. The patent to Rupnow is relied on to show the combination. The claim is also rejected on Rupnow in view of Eastwood, the latter reference showing the motor feature of a rotary casing and brake.

We think the rejection should be sustained on both grounds. No relation whatever is recited between the motor and drum and the broad recitation of a rotatable casing is purely an arbitrary limitation. The scope of this claim is too uncertain to justify its allowance.

The rejection of Claims 1 and 9 is affirmed. As to the remaining claims appealed the decision is reversed.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

## APRIL 20

# *System of Purifying Motor Oil*

EX PARTE RALPH L. SKINNER. APPEAL No. 865, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1708283 was issued April 9, 1929, to Ralph L. Skinner for internal-combustion engine oil-rectifying systems, on application No. 37157, filed June 15, 1925.

Appellant's system for purifying oil consisting of a suction device to remove the oil from the cylinders to the rectifier where the gasoline and water are vaporized, and means for pumping the purified oil back to the crank case, as set forth in claims 1 to 7, was held to be unpatentable over the prior art, it being found that a basic reference disclosed all except appellant's means for returning the oil to the crank case and this feature was present in another patent.

**Sufficient Difference.**

A difference between claim 8 and the prior art, consisting of a check valve located between the pump for returning the reclaimed oil from the crank case and the latter and stating the purpose of the check valve, the Board found, was sufficient to carry the claim.

Walter M. Fuller for applicant.

Before Assistant Commissioner Moore, Examiners-in-Chief Ide and Landers. The full text of the Board's opinion follows:

This is an appeal from the action of the examiner finally rejecting claims 1 to 8, inclusive. Claim 1 is illustrative and is as follows:

"1. The combination of an internal-combustion engine having a lubricating system, means to withdraw lubricant from said system substantially continuously, means to separate the withdrawn lubricant from objectionable ingredients under subatmospheric pressure and means to deliver the reclaimed lubricant under normal operating conditions substantially immediately to said system permitting the continuity of withdrawal of the lubricant from the system and at a pressure greater than that under which the separation occurs."

The references relied upon are: Hunt, 1484607, Feb. 19, 1924; Skinner, 1502921, July 29, 1924; Vincent, 1545930, July 14, 1925.

**Effect of Rectifying Systems.**

The invention relates to an oil-purifying system for internal-combustion engines. It comprises a rectifier which is connected to the engine cylinders and also to the intake manifold. Suction produced through the latter connection causes a subatmospheric pressure in the rectifier, which induces oil to flow from the cylinders to the rectifier. The gasoline and water are vaporized in the rectifier and conducted therefrom to the intake manifold. The purified oil is pumped to the crankcase. A check valve is provided between the pump and the crankcase so that if the discharge into the latter is above the oil therein air cannot pass back through the pipe and the pump and prevent the establishing of a subatmospheric pressure in the vaporizer.

The examiner has rejected several of the claims on the patents to Skinner and

Vincent, on the theory that in these patents the reclaimed lubricant is returned substantially immediately to the crankcase, or at least that the claims fail to state a substantial difference over the patents in this respect. In each of the patents the reclaimed oil is collected in a chamber attached to the lower portion of the rectifier and is discharged intermittently from this chamber to the crankcase. It is not seen that these patents in themselves anticipate the claims.

The examiner has also rejected the claims on the patents to Skinner and Vincent taken in connection with the patent to Hunt. It is his theory that there would be no invention in using Hunt's rectifying system on an engine in which the oil is withdrawn from the automobile cylinders, as in Skinner and in Vincent, instead of from the crankcase, as in Hunt.

In the latter reference a construction is shown in Figure 1 in which a pump is used for returning the reclaimed lubricant to the crankcase. The vaporizer contains a body of lubricant which has been withdrawn from the crankcase by suction induced from the intake manifold. A float valve in the vaporizer maintains the desired level of lubricant therein. Appellant contends that this valve intermittently closes and opens and that accordingly the oil is not withdrawn substantially continuously from the system. We believe this contention to be in error. If the level of the lubricant in the vaporizer should vary from the position shown in Figure 1 the valve will be adjusted in such direction as to either increase or decrease the rate of flow of the lubricant to the reservoir a sufficient amount to reestablish the desired operating level. It is not seen, however, that the valve would actually close and shut off all flow of lubricant. Even assuming it has so closed it would immediately reopen because the pump for returning the reclaimed oil to the crankcase is operating continuously.

In our opinion the Figure 1 device of Hunt substantially meets claims 1 and 5 which state that the lubricant is withdrawn from the system and which are not limited to the withdrawal of the lubricant from around the piston. Furthermore we believe claims 2, 3, 4, 6 and 7 unpatentable over Hunt taken in connection with Vincent and Skinner. Clearly enough there would be no invention in removing the oil from that part of the system disclosed in Skinner and Vincent by the Hunt device.

### Reversal of Seven Claims.

Claim 8 includes appellant's check valve which is located between his pump for returning the reclaimed oil from the crankcase and the latter and states the purpose of this check valve. It is believed that this claim should be allowed.

The decision of the examiner is affirmed as to claims 1 to 7, inclusive, and is reversed as to claim 8.

Limit of appeal to Court of Appeals 40 days.

Rule 149.

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# *Sweater With Integral Collar*

MYER SIMON v. CLINTON KNITTING COMPANY, INC. DISTRICT COURT FOR THE NORTHERN DISTRICT OF NEW YORK.

CLAIM 1 and 3 of patent No. 1003155 were held to be valid and infringed. Plaintiff's sweater, provided with a collar made integrally with it and adapted to fold within the neck portion or to unfold into an upright position around the neck and having means to hold it in each position, was found to be infringed by defendant's garment in which there were some variations in the manner of sewing the collar to the garment but which involved plaintiff's inventive idea.

### Attack on Validity of Patent.

The prior art, consisting of auxiliary collars that were not integral with the sweater, were found not to be anticipations of the patent device.

Edward M. Evarts (Daniel Aldeman of counsel) attorney for plaintiff; Thomas L. Wilder, attorney for defendant.

The full text of the opinion of Judge Bryant follows:

Plaintiff claims that defendant, during the past six years, has infringed patent No. 1003155 issued to him September 12, 1911, by manufacturing and selling garments that embody the invention claimed in said letters patent. The plaintiff asks for an injunction and an accounting. The patent expired in September, 1928, so that the only relief, if any, to which plaintiff is entitled is an accounting.

Defendant attacks plaintiff's patent claiming anticipation and in support of its contention submits numerous prior patents, among which are patents No. 991370 issued to B. Rautenberg, No. 264802 issued to I. Wallack, No. 925146 issued to S. Weinschenk, and No. 998-627 issued to H. T. Morgan. These patents fail to show anticipation of the invention claimed in plaintiff's letters patent. They cover auxiliary collars that are not an integral part of the sweater itself, such as the Simon patent discloses.

Plaintiff's patent contains four claims, but this action is limited to claims one and three.

Claim one is as follows: "A garment provided with a folded edging strip attached at its edges to the front edges of the garment and at one of its edges to the neck portion of the garment, the opposite edge of said edging strip at the neck portion being free from the garment and from the edging strip forming a collar adapted to be turned up beyond the outer edge of said strip."

Claim three is as follows: "A garment having an edging strip continuous along its front edges and around its neck portion, part of said edging strip at the neck portion being free from the main portion to be turned up above the edge of the garment to form a collar at the neck portion, and means for holding the collar portion folded within the neck portion of the edging strip."

From a study of the claims, diagrams, and specifications, it appears that plaintiff produced a sweater that contained, as an integral part of it, a collar that could be worn folded within the neck portion or in an upright position so as to cover and protect the neck. Suitable means to hold the collar in both positions were provided. Claims one and three state the method of forming the collar full enough so that further comment seems unnecessary.

Defendant claims its garments are manufactured under patent No. 1563927, issued to J. C. W. Rahn. From a study of this patent and a sweater manufactured by defendant, and introduced in evidence, the following differences are noted. Defendant uses a double thickness of material as does plaintiff, but instead of sewing both edges to the garment it sews one and then holds the fold in position by sewing the button holes and buttons through both thicknesses. This gives the same result as though both edges were sewed directly to the garment.

**Embodying the Same Idea.**

The defendant does not cut the strip for the collar, but allows the collar to be turned up just as it is, consequently the collar does not lie flat at the point where it is unfolded, which feature could be eliminated by cutting. Since it is not cut fasteners are not needed to hold the collar down. Defendant claims it does not infringe because of the fact that is does not sew both edges and does not use fasteners to hold the collar flat when folded.

A careful study of plaintiff's patent and defendant's sweater shows that both embody the same idea. The variance in the sewing of the strip and the forming is not sufficient to avoid infringement. It is apparent that defendant is using plaintiff's idea. The Court, therefore, holds that defendant did infringe plaintiff's patent by manufacturing and selling the sweaters in question.

The complainant is entitled to a decree in the usual form, but for no accounting for profits and damages before notice was served on defendant.

March 29, 1929.

APRIL 22

# *Effect of Treaty of Berlin In Filing Patent Applications*

THOMAS E. ROBERTSON, COMMISSIONER OF PATENTS, APPELLANT, v. GENERAL ELECTRIC COMPANY AND ERNST STOFFREGEN, APPELLEES. No. 2771, CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT.

THE decree of the lower court directing the Commissioner of Patents to issue letters patent to the General Electric company and Ernst Stoffregen for an invention previously patented in Germany was reversed on appeal.

Letters patent had been denied appli-

cants on the ground that the application was filed in this country more than 12 months after the invention was patented in Germany and more than six months after the expiration of the time limit provided by the Nolan Act of March 3, 1921. Having exhausted their remedies of appeal to the Court of Appeals of the District of Columbia, action in equity under Section 4915 of the Revised Statutes was brought in the District of Maryland. Motion to dismiss this suit was filed but the motion was overruled by the District Court and upon a hearing the case decided in favor of complainants.

**Reliance Upon Treaty of Berlin.**

In this action the complainants relied upon the Treaty of Berlin, contending that it had the effect, without supporting legislation, of extending for a period of six months from its date, November 11, 1921, the priority rights of German citizens under the Convention of 1883 as amended and Section 4887 of the Revised Statutes.

The court found, however, that the uniform construction of the convention by the Patent Office officials, and by the courts of this country, has been that the convention is not self-executing, but requires the aid of an act of Congress, that Congress had so acted in passing the Nolan Act and that complainants' remedy under that Act had expired by lapse of time which was not revived by the subsequent Treaty of Berlin.

The decision of the District Court was reversed and applicants denied the right to obtain the patent.

Harry E. Knight, Special Assistant to the Attorney General, and T. A. Hostetler, Solicitor, United States Patent Office, for Appellant; Harrison F. Lyman (Fish, Richardson & Neave; Charles E. Tullar and Semmes, Bowen & Semmes on brief) for appellees.

Appeal from the District Court for the District of Maryland.

Before Waddill and Parker, Circuit Judges, and McDowell, District Judge. The full text of the court's opinion, delivered by Judge Parker, follows:

This is an appeal from a decree directing the Commissioner of Patents to issue letters patent to the General Electric Company and one Ernst Stoffregen, covering an invention previously patented in Germany.

Application for patent was filed with the Patent Office on May 10, 1922. It was rejected by the Patent Office Examiner on the ground that it had been filed more than 12 months after the filing of the foreign application. Later it was finally rejected by the Examiner in an opinion concurred in by the Law Examiner. On appeal this decision was affirmed by the Board of Examiners in Chief, in which full consideration was given to the Treaty of Berlin and the provisions of the Treaty of Versailles which it adopted. On appeal to the Commissioner of Patents the decision was affirmed by him. Appeal was taken to the Court of Appeals of the District of Columbia and the decision of the Patent Office was affirmed by that Court. In re Stoffregen, 6 Fed. (2d) 943. Application was made to the Supreme Court for certiorari and same denied. 269 U. S. 569.

Appellees then filed a bill in the court below under R. S. 4915, 35 U. S. C. 63, against the Commissioner of Patents, praying that they be adjudged legally entitled to the patent and that the Commissioner be authorized and directed to issue same. The District Judge overruled a motion to dismiss the bill (21 Fed. (2d) 214), and upon final hearing found in favor of complainants. 25 Fed. (2d) 146. From this finding and the decree thereon the Commissioner of Patents has appealed.

The German application of complainants was filed October 11, 1915, and the German patent was issued thereon October 20, 1919. As stated above, the application was not filed in the United States until May 10, 1922, after the lapse of much more than the year limited by Section 4887 of the Revised Statutes, 35 U. S. C. 32, and more than six months after the expiration of the time limited by the Nolan Act of March 3, 1921, 41 Stat. 1313.

**Reverse Bearing of Statutes.**

It is conceded, therefore, that this application is barred under Section 4887 of the Revised Statutes and under the Nolan Act; but the contention in behalf of applicants is that the application was filed within six months of the date of the coming into effect of the Treaty of Berlin (42 Stat. 1939), and that the effect of that treaty was to extend the time for filing such application for a period of six months after the date upon which it became effective. This contention is based upon the provision of the Treaty of Berlin adopting by reference certain articles of the treaty of Versailles, in one of which is included Section 308, relating to priority rights of foreign inventors.

A proper consideration of the point involved requires, therefore, that we consider the bearing upon each other of Section 4887 of the Revised Statutes,

Section 308 of the Treaty of Versailles, the Nolan Act, the purpose of which was to incorporate into the law of this country the provisions of Section 308, and finally the Treaty of Berlin, which referred to and adopted certain provisions of the treaty of Versailles.

Section 4887 of the Revised Statutes in its present form is the codification of provisions of the Acts of July 8, 1870, 16 Stat. 201; March 3, 1897, 29 Stat. 693, and March 3, 1903, 32 Stat. 1225, the last of which was enacted to incorporate into our law the provisions of the International Convention for the Protection of Industrial Property of Paris, of March 20, 1883, as modified by the Convention of Brussels, of December 14, 1900. It provides that no person, otherwise entitled to a patent for his invention or discovery, shall be debarred from receiving a patent by reason of its having been first patented by the inventor in a foreign country, unless the foreign application shall have been filed more than 12 months prior to the application in this country, in which case no patent shall issue in this country.

In other words, its effect is that the owner of a foreign patent may obtain a patent for his invention in this country, if it is otherwise patentable under our laws, provided he makes application therefor within 12 months after the filing of the foreign application.

Provisions similar to those of this section are found in the laws of most civilized nations; but during the World War it was impossible for inventors of the warring nations to avail themselves of the provisions of such statutes of enemy countries.

This, accordingly, was one of the many matters dealt with by the treaty of peace of Versailles, Article 308 of which provided:

"The rights of priority, provided by article 4 of the International Convention for the Protection of Industrial Property of Paris, of March 20, 1883, revised at Washington in 1911 or by any other Convention or Statute, for the filing or registration of applications for patents or models of utility, and for the registration of trade marks, designs and models which had not expired on August 1, 1914, and those which have arisen during the war, or would have arisen but for the war, shall be extended by each of the High Contracting Parties in favor of all nationals of the other High Contracting Parties for a period of six months after the coming into force of the present Treaty."

The Senate of the United States, on March 19, 1920, definitely refused to ratify the treaty of Versailles. Nevertheless, a month and a day later, April 20, 1920, what is known as the Nolan Act was introduced into the House, its purport being to secure protection to American and foreign inventors in accordance with Section 308 of the Versailles treaty (See Congressional Record of 67th Congress, Third Session pp. 3783-5 and 3947-9). It was approved March 3, 1921 (41 Stat. 1313), and extended the time for filing application for six months, or until September 3, 1921, to foreign inventors whose countries should grant reciprocal privileges to the inventors of this country.

It followed almost exactly the language of Section 308 of the Versailles treaty, except that instead of providing that the rights under existing laws should be extended, the language used was "shall be, and the same are hereby, extended etc." The exact language of that part of the act which is pertinent is as follows:

> That the rights of priority provided by section 4887 of the Revised Statutes, for the filing of applications for patent for inventions and designs, which rights had not expired on the 1st day of August, 1914, or which rights have arisen since the 1st day of August, 1914, shall be, and the same are hereby, extended until the expiration of a period of six months from the passage of this act in favor of the citizens of the United States or citizens or subjects of all countries which have extended, or which now extend, or which within said period of six months shall extend substantially reciprocal privileges to citizens of the United States, and such extension shall apply to applications upon which patents have been granted, as well as to applications now pending or filed within the period herein.

On July 2, 1921, Congress passed the joint resolution ending the war with Germany (42 Stat. 105), which provided among other things that there was reserved to the United States and its nationals "any and all rights, privileges, indemnities, reparations, or advantages, together with the right to enforce the same, * * * which under the treaty of Versailles have been stipulated for its or their benefit." On July 1, 1921, friendly relations with Germany were restored; and on July 6 there was promulgated a decree, published in the Reichsgesetzblatt for July 14, which granted to American citizens privileges reciprocal

to those granted to citizens of Germany in the Nolan Act.

This decree was promulgated under the law for the carrying out of the treaty of Versailles, and accorded to citizens of the United States the rights of priority provided in Article 4 of the International Convention for the Protection of Industrial Property Rights as revised in 1911, up until Sept. 3, 1921, the date to which similar extension had been granted by the Nolan Act. Citizens of Germany thereupon proceeded to avail themselves of the provisions of the Nolan Act, and 371 applications for patents were filed by them thereunder, which was the largest number from any country, there being only 355 from the British Isles and 244 from France.

### The Treaty Ratification.

On November 2, 1921, the treaty of peace between the United States and Germany, known as the Treaty of Berlin, was ratified; and on November 11, 1921, it took effect upon the exchange of ratifications. This treaty is a very brief document. See 42 Stat. 1942. Article 1 thereof provides, among other things, that the United States shall have and enjoy "all the rights, privileges, indemnities, reparations or advantages" specified in the joint resolution of Congress which ended the war, including all the "rights and advantages" stipulated for the benefit of the United States in the treaty of Versailles. Article 2 is the one upon which complainants chiefly rely, and the pertinent provisions thereof are as follows:

> With a view to defining more particularly the obligations of Germany under the foregoing article with respect to certain provisions in the Treaty of Versailles, it is understood and agreed between the high contracting parties:
>
> (1) That the rights and advantages stipulated in that treaty for the benefit of the United States, which it is intended the United States shall have and enjoy, are those defined in section 1 of Part IV, and Parts V, VI, VIII, IX, X, XI, XII, XIV and XV.
>
> The United States, in availing itself of the rights and advantages stipulated in the provisions of that treaty mentioned in this paragraph, will do so in a manner consistent with the rights accorded to Germany under such provisions.
>
> . . . . . .
>
> (5) That the periods of time to which reference is made in article 440 of the Treaty of Versailles shall run, with respect to any act or election on the part of the United States, from the date of the coming into force of the present treaty.

The contention of complainants is that the Treaty of Berlin had the effect, without supporting legislation, of extending, for an additional period of six months from the date when it became effective, the priority rights of German citizens under the Convention of 1883 as amended and Section 4887 of the Revised Statutes, which incorporated the provisions of the convention into our statute law, or, in other words, that it had the effect of extending for another six months the period during which such citizens might file applications for patents or inventions upon which foreign patents had already been obtained.

If this contention can be maintained, they are entitled to a patent on the application filed, as it was filed May 10, 1922, and the six months' period following the coming into effect of the treaty did not expire until the following day.

We do not think, however, that the contention can be maintained, and this for two reasons: (1) because we do not think that the Treaty of Berlin should be construed as providing that the priority rights of German and American inventors should be again extended for a six months' period, in view of the fact that their rights had already been protected in accordance with the provisions of Section 308 of the Versailles treaty by the Nolan Act and the Reciprocal Decree of Germany; and (2) because, even if the Treaty of Berlin be so construed, such construction must rest upon the adoption by that treaty of Section 308 of the treaty of Versailles, which is not self-effectuating, and no supporting legislation has been enacted in aid thereof.

### Views of German Court.

On the first proposition, it must be remembered that the Treaty of Berlin makes no reference whatever to priority rights of foreign inventors or to Section 308 of the treaty of Versailles. That section becomes of importance merely because it is included with many other sections in Part X of the treaty of Versailles, which is referred to in the Treaty of Berlin as one of those parts stipulating rights for the benefit of the United States which it is intended that she shall have and enjoy. At the time of the ratification of the Treaty of Berlin, the treaty of Versailles had been in effect for nearly two years, many of the things provided for therein had already been accomplished, and the greater number of the sections embraced within the parts referred to in the Treaty of Berlin had at that time no practical significance whatever.

While we do not subscribe to the theory, as the Reichsgericht, the highest court of Germany, seems to do, that the treaty created a mere option on the part of the United States to avail itself of such of the provisions of the Versailles treaty as it might choose (see Entscheidungen of the Reichsgerichts, Vol. 114, p. 252, and compare U. S. v. Chemical Foundation 272 U. S. 1, 11), it is clear that it was not intended that either country or its citizens should assume any obligation or acquire any additional rights under those provisions of the treaty of Versailles which had already been carried out or for any other reason had become obsolete.

For instance, it was provided by Section 269 of the treaty of Versailles that during the first six months after its coming into effect the duties imposed by Germany on imports from Allied and Associated States should not be higher than the most favorable duties which were applied to imports into Germany on July 31, 1914; but certainly no one would contend that, by the Treaty of Berlin, Germany again restricted her power to tax imports for an additional period of six months.

Many other sections are in like case, and were manifestly not intended to be brought forward as live provisions of the Treaty of Berlin.

We think that Section 308 of the treaty of Versailles is one of those which had accomplished its purpose and become obsolete at the time of the negotiation of the Treaty of Berlin, and that, therefore, it is not to be construed as imposing additional obligations or conferring additional rights upon either the United States or Germany because of that treaty. In the first place, the time limited under Section 308 had expired more than a year before the Treaty of Berlin was negotiated.

It is argued that this time was extended by Section 5 of Article II of the Treaty of Berlin, which we have quoted above; but this section extends only the time "with respect to any act or election on the part of the United States," and clearly refers to certain acts or elections to be made by the United States as a condition to the enjoyment of certain rights which it was to enjoy only in case it should elect to do so within a specified time.

For instance, Section 289 of the Versailles treaty stipulated that any of the Allied Powers might revive any bilateral treaty with Germany which it might wish to revive by giving Germany notice of its election to do so within a period of six months.

Section 296, providing for the establishment of clearing offices for the settlement of debts between citizens of Germany and the Allied Nations, stipulated that the section should not apply as between Germany and any particular nation, unless within one month of its ratification of the treaty, such nation should give notice to Germany that it desired to enter into such arrangement.

**Other Sections Stipulating Rights.**

There were a number of other sections of the Versailles treaty stipulating rights for the several Allied and Associated Nations, but requiring action on the part of any one of them desiring to avail itself of the rights specified under these sections; and it was manifestly to these that the provisions of Section 5 of Article II of the Treaty of Berlin were intended to refer.

While the Treaty of Berlin was being negotiated, the German authorities raised the point that, under Section 5 of Article II, a contention might be made that the period of occupation of the territory west of the Rhine and of the bridgeheads might be extended for an additional period, since Section 428 of the Versailles treaty provided for Allied occupation for 15 years from the coming into force of the treaty, and it might be contended that as to the United States this period should run from the coming into force of the treaty then being negotiated.

Secretary Hughes replied to this and stated that Section 5 of Article II would not extend the time limited by such sections, but would apply only to such matters as we have indicated above. (See telegram of August 8, 1921, set forth in Senate Document No. 173, 69th Congress, 2nd Session, p. 11.) He said in this connection:

"Rosen evidently attaches too much importance to subparagraph (5) of Article II. You may say positively that it was not intended that this paragraph should apply to the period fixed by Article 428, and if a collateral formal declaration is desired to that effect, you can make it. It is not deemed advisable to redraft the paragraph, as more specific statement is impracticable. Department had in mind provisions with respect to acts or election on the part of the United States where time would be important under provisions such as are contained in subparagraph (e), Article 296, relating to clearing house plan, and paragraph (a), Article 304, relating to Mixed Ar-

bitral Tribunal. As periods of time provided for by these provisions have not been fixed by ratification on the part of the United States, they should be fixed now by agreement."

And, not only does it appear that the time limited by Section 308 had expired before the negotiation of the Treaty of Berlin, but also that the purpose of that section, in so far as it affected the United States and Germany, had already been accomplished by the enactment of the Nolan Act and the promulgation of the reciprocal decree of Germany.

As stated above, the Nolan Act was passed expressly to carry out the purpose of Section 308 of the Versailles treaty. It employs almost the exact language of that section and prescribes the same time limit. The reciprocal decree of Germany was based on legislation passed in execution of the Versailles treaty, and prescribes the same time limit as the Nolan Act. Both nations, therefore, had, as between themselves, carried out the provisions of the section; and it is not reasonable to assume, merely because it happened to be included in a part of the Versailles treaty specified in the Treaty of Berlin as setting forth rights to which the United States was entitled, that the parties intended to give each other further and additional rights thereunder. If the section be considered as a part of the treaty between the two countries, it must be considered as a part which had already been carried out and performed and under which no future rights or obligations were contemplated.

**Question of Additional Rights.**

The Reichsgericht has had under consideration the question as to whether the Treaty of Berlin gave any additional rights over those given by the Nolan Act and the reciprocal German decree, and has expressly held that it did not. See Vol. 114 Entscheidungen of the Reichsgericht, supra, p. 252. In the course of that opinion, this highest court of Germany said:

"This legal condition has not been altered by the treaty of peace concluded between Germany and the United States on August 25, 1921, and ratified by the German Diet on October 20, 1921. This treaty stipulates in Art. 1 the obligation of Germany to allow the United States all rights established in her favor in the treaty of Versailles, and in Art 2, No. 1 expressly mentions as such the rights contained in part X of that treaty, which includes those referring to industrial property (Art. 306 to 311). As this Senate pointed out in its decision of June 2, 1923, it is to be inferred from Art. 2, No. 1, par. 2, these rights are not ipso factor to belong to the citizens of the United States but a special decision and declaration on the part of the United States was needed. This, however, was lacking. * * * Moreover, according to the German view agreeing with that of the United States the regulations of the Nolan Act and the proclamation of July 6, 1921, were not in any way to be altered by the treaty of peace. This results from the very fact that the United States even now sustains the Nolan Act and has not made further changes in consequence of Art. 307, par. 2, of the Versailles treaty."

The expressions used by the German court bring us to the second ground upon which we think that the prayer of complainants must be denied, viz: that even if the Treaty of Berlin be construed as incorporating Section 308 of the Versailles treaty as a live provision under which future action was to be taken, nevertheless, complainants are not entitled to the patent applied for because the section is not self executing and no legislation has been enacted to carry it into effect.

Assuming that a treaty provision affecting patents may be made self executing so that no supporting legislation is necessary under the Constitution to give rise to individual rights thereunder, we are satisfied that Section 308 was not intended to be, and is not, such a self executing provision.

The rule as to whether a treaty is self executing or not is clearly stated by Chief Justice Marshall in Foster & Elam v. Neilson 2 Pet. 253, 313, as follows:

A treaty is, in its nature, a contract between two nations, not a legislative act. "It does not generally effect, of itself, the object to be accomplished; especially, so far as its operation is infra-territorial"; but is carried into execution by the sovereign power of the respective parties to the instrument. In the United States, a different principle is established. Our Constitution declares a treaty to be the law of the land. It is, consequently, to be regarded in courts of justice as equivalent to an act of the legislature, whenever it operates of itself, without the aid of any legislative provision. "But when the terms of the stipulation import a contract—when either of the parties engages to perform a particular act, the treaty addresses itself to the political, not the judicial department; and the legislature must execute the contract, before it can become a rule for the court" (Quotation marks inserted.)

The language of Section 308 is that "the rights of priority * * * shall be extended by each of the High Contracting Parties etc." This not only uses language of futurity, "shall be extended," as to a matter operating as to each nation infra-territorially and not between nations, but also provides that the extension shall be made, not by the instrument itself, but "by each of the High Contracting Parties."

In other words, to use the language of Chief Justice Marshall, each of the parties "engaged to perform a particular act;" and, therefore, "the treaty addresses itself to the political, not the judicial department; and the legislature must execute the contract, before it can become a rule for the court."

**Opinion of Attorney General.**

It was the opinion of Attorney General Miller (19 Op. A. G. 273) that, as Congress alone was given by the Constitution the power "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries," treaty provisions relating to patent rights must be deemed dependent upon legislation in aid thereof. And this seems to have been the view also of Judge Lowell in United Shoe Machinery Co. v. Duplessis Shoe Machinery Co., 148 Fed. 31, and there is much to be said in its favor. Patent rights differ from many other rights which are the subject of treaties, in that they are created by and dependent upon statutes which only Congress has power to enact.

Furthermore, the right under a patent is not one which extends across national boundaries and is, therefore, necessarily a matter for regulation by treaty, but is one which must be enjoyed within the territory of the nation. We think, however, that the better view is that a treaty affecting patent rights may be so drawn as to be self executing. See United Shoe Machinery Co. v. Duplessis Shoe Mach. Co. (C. C. A. 1st) 155 Fed. 842; Hennebique Construction Co. v. Myers (C. C. A. 3d) 172 Fed. 869; the Cherokee Tobacco, 11 Wall. 616, 621; Hijo v. U. S., 194 U. S. 315, 324. But the reasons which led to the doubt as to whether a treaty could be so drawn as to affect patent rights, without supporting legislation by Congress, are matters which must be considered in the interpretation of treaties affecting patents; and they require that such treaties be held not self executing unless their language compels a different interpretation. Patent rights are valid, of course, only within the country granting the patent. They are created by statute, and complicated administrative machinery is provided for the application of the statutory provisions.

Treaties are drafted ordinarily to accomplish certain general results, and in the nature of things cannot regulate details and ought not interfere with the domestic machinery which the several countries have provided for the regulation of patents. For these reasons, unless a contrary intention is clearly indicated, they should be construed, not as of themselves making changes in the patent laws, but as contemplating that the various parties signatory will enact appropriate legislation and promulgate proper rules to effectuate the ends which they are designed to accomplish.

**Rule of Construction.**

This rule of construction has been uniformly followed in this country and treaties affecting patent rights have been held to be not self effectuating, where the purpose that they should be carried out by supporting legislation was not by any means so clearly indicated as in the section of the treaty under consideration. Thus Article II of the Convention of March 20, 1883, provided:

> The subjects or citizens of each of the contracting States shall enjoy, in all the other States of the Union, so far as concerns patents for inventions, trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord, or shall afterwards accord to subjects or citizens. In consequence they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each State.

In the opinion of Attorney General Miller, referred to above, this article was held not to be self executing, but to require the support of legislation before it became a rule for the courts to follow. While the constitutional question to which we have adverted was discussed, the opinion was finally based upon the proposition that the treaty was a contract for operating in the future infra-territorially. The Attorney General said:

> It is not necessary to the decision of the question submitted to me in the matter under consideration to determine whether all the provisions of treaties, whose execution requires the exercise of powers submitted to Congress, must be so submitted before they become law to the courts and

executive departments, for the treaty under consideration is a reciprocal one—each party to it covenants to grant in the future to the subjects and citizens of the other parties certain special rights in consideration of the granting of like special rights to its subjects or citizens. "It is a contract operative in the future infraterritorially. It is therefore not self-executing, but requires legislation to render it effective for the modification of existing laws." (Quotation marks inserted.)

In Rousseau v. Brown 21 App. D. C. 73, Rousseau, a citizen of France, based his claim upon the provisions of the Convention of March 20, 1883. In denying his claim, the court said:

The convention is in the nature of a contract between the parties thereto, and is not self-executing. It requires the action of Congress to give it full force and effect. "This is the construction that has been placed upon it by most of the parties to it," and they have adopted legislation giving effect to it. * * * But, without regard to the action of other States, "the uniform construction of that convention by the Patent Office officials, and by the courts of this country, has been that the convention is not self-executing," but requires the aid of an act of Congress. (Quotation marks inserted.)

See, also, opinion of Judge Coxe in Accumulator Co. v. Julien Electric Co. 57 Fed. 615.

The Convention of Brussels of Dec. 14, 1900, changed the priority period for patents to 12 months and inserted in the prior convention a section known as Article "4 bis." as follows:

"Patents applied for in the different contracting States by persons admitted to the benefit of the convention under the terms of articles 2 and 3 shall be independent of the patents obtained for the same invention in the other States adherents or nonadherants to the Union."

There was some controversy in the lower courts as to whether this was a self executing provision or not, but the Supreme Court, in Cameron Septic Tank Co. v. Knoxville 227 U. S. 39, 49, set these controversies at rest by showing that it was the sense of Congress that the treaty required legislation to become effective, that this was the understanding of other nations also, and that the act of 1903 was passed to carry it into effect.

The Court said:

"The act of 1903 was then enacted, and if there could be any doubt that it expressed the sense of Congress and those concerned with the treaty that it required legislation to become effective, such doubt would be entirely removed by the legislative action of other States. It appears from the report of the Committees on Patents of the Senate and of the House of Representatives on the proposed legislation that 13 countries had adopted legislation giving full force and effect to the provisions of the Additional Act either in the form of a general law or by specific amendment to other laws providing for carrying into force the provisions of the Additional Act as regards the extension of the "delay and priority" to 12 months.

"Other countries were mentioned as being expected to do so. In explaining the object of the bill the member in charge of it in the House of Representatives said that it was to carry into effect the Additional Act of the Convention held at Brussels in December, 1900; * * *.

"If it (the treaty) be not self-executing, as it is certainly the sense of Congress that it was not and seems also to be the sense of some of the other contracting nations, and as the act of 1903 did not make effective Article 4 bis, the provisions of section 4887 apply to the Cameron patent and caused it to expire with the British patent for the same invention."

**Error In District Decree.**

In the light of these decisions, relating to treaties the language of which does not negative the idea of self execution near so plainly as does that of Section 308 of the treaty of Versailles, it is clear that that section cannot reasonably be construed as self executing. As no legislation has been passed in aid of it except the Nolan Act, the time limit of which had expired before complainants filed their application, it follows that there is nothing upon which they can base the extension of priority rights for which they contend.

We have given careful consideration to the able opinion of the learned District Judge; but after full consideration we are of the opinion that the decision of the Court of Appeals of the District of Columbia, which the Supreme Court declined to review, was correct.

In this we are supported by the recent decision of the Reichsgericht, to which we have referred, construing the same treaty and arriving at the same conclusion, a decision which, although not binding, is highly persuasive. There was error, therefore, in the decree of the District Court, and same is accordingly reversed and the cause is remanded with directions to dismiss the bill.—Reversed.

April 9, 1929.

## APRIL 23

# *Propriety of Joinder of Party In Suit Against His Will*

THE MOTO METER COMPANY, INC., HARRISON H. BOYCE AND LEANDER DEVELOPMENT CORPORATION, PLAINTIFFS, V. NATIONAL GAUGE & EQUIPMENT COMPANY, DEFENDANT. EQUITY NO. 699, DISTRICT COURT FOR THE DISTRICT OF DELAWARE.

THIS motion to dismiss the bill of complaint on the ground that there was misjoinder of parties plaintiff was denied.

The facts show that the Moto Meter Company, having a community of interest with Mr. Boyce and the Leander Corporation in the patented device, acquired the capital stock of the infringing defendant and then declined to join in as party plaintiff in a suit for infringement. Mr. Boyce and the Leander Corporation brought suit for infringement and joined the Moto Meter Company as coplaintiff, and the court found that this joinder of parties plaintiff was proper as the status of Mr. Boyce and the Leander Corporation was equal to if not greater than that of an exclusive licensee under a patent.

The court stated further that a licensee has been permitted to make the patent owner a coplaintiff, even against his will, in a suit to enjoin infringement.

### A Motion to Dismiss.

The full text of the opinion of Judge Morris follows:

In this suit in equity against National Gauge & Equipment Company, a Delaware corporation, instituted by Harrison H. Boyce and Leander Development Corporation to obtain injunctive and accounting relief, because of defendant's infringement of three patents, The Moto Meter Company, Inc., a New York corporation, the owner of the patents, and not subject to the process of this court, was joined as a coplaintiff against its will after it had refused a request of Boyce and the Leander Corporation to unite voluntarily with them.

The defendant now moves to dismiss the bill upon the grounds that The Moto Meter Company is not in law a party to the suit in that the rights of Boyce and the Leander Corporation are not of a character to enable them to make that company a coplaintiff against its will, that Boyce and the Leander Corporation cannot maintain this suit under the patent laws alone and that, consequently, the bill is without equity. Boyce and the Leander Corporation make no contention that The Moto Meter Company is not an indispensable party to the cause. They place their opposition to the motion solely upon the ground that under the facts their joinder of The Moto Meter Company was both legal and proper.

The facts are few. For the purposes of this motion they are, of course, conceded. Boyce invented improvements in heat and water indicators for automobiles. Before applying for patents, he disclosed his inventions to George H. Townsend, 2d. They then entered into an agreement whereby Boyce undertook to make and prosecute applications for Letters Patent for his invention. By the same instrument, Boyce granted and sold to Townsend, for the life of the patents, "the sole and exclusive right and license to make, use and sell, and to cause to be made, used and sold throughout the United States and its dependencies, and in all foreign countries, all heat and water indicators for automobiles and the like heretofore invented by Mr. Boyce, * * *."

For the right and license granted, it was provided that Townsend should pay to Boyce "royalty at the rate of 10 per cent of the net selling price of said heat and water indicators sold by him or his agents, together with a payment of $300 upon the signing of this contract," and a minimum royalty of $50 a month. It was likewise stipulated that Townsend should have the right to assign the contract to a corporation to be organized by him, but that neither he nor the corporation so organized should assign the agreement or any right thereunder to any other corporation, association, firm or individual without Boyce's written consent, and that the agreement might be terminated by Townsend on 90 days' written notice to Boyce.

The contract contains no request for the patents to issue in the name of Townsend and no requirement that Townsend or his assignee shall sue in-

fringers. The patents in suit were subsequently obtained by Boyce. No further assignment was thereafter made by Boyce to Townsend.

Townsend assigned all his rights under the contract to The Moto Meter Company. Boyce transferred his to the Leander Corporation. It is virtually agreed that Boyce now possesses no rights under the contract and that the propriety of his joinder as a party plaintiff is at least doubtful, but as his presence as a party is of but little moment and as no objection is now made thereto, it will not be passed upon.

**Propriety of Joinder.**

In 1926, The Moto Meter Company acquired the capital stock of the defendant which was then infringing the patents in suit. Thereafter, The Moto Meter Company requested Boyce and the Leander Corporation to consent that the defendant be granted a licnese under the patents. They refused. The infringements continued. Boyce and the Leander Corporation then asked The Moto Meter Company to join them in this suit. It declined. The suit was then instituted and The Moto Meter Company notified.

That the legal title to the patents passed, by virtue of the agreements, from Boyce to Townsend and is now in Townsend's assignee, the Moto Meter Company, is asserted by the defendant, upon the authority of Waterman v. McKenzie, 138 U. S. 252; D. M. Sechler Carriage Co. v. Deere & Mensur Co., 113 Fed. 285 (C. C. A. 7); Krentler-Arnold Hinge Last Co. v. Leman, 13 Fed. (2d) 796 (C. C. A. 1), is alleged in the bill of complaint and is, consequently, assumed by the court. See Robinson on Patents, section 786; Curtis on Patents, section 212.

That an exclusive licensee may make the patent owner, who, as here, is beyond the reach of process a coplaintiff in an infringement suit, if he refuses the licensee's request to become such voluntarily, is now settled. Ind. Wireless Co. v. Radio Corp., 269 U. S. 459.

But Boyce and the Leander Corporation are not licensees. They assert, however, that in principle and by analogy, their right to join the patent owner, under the facts here pleaded, is equal to or greater than that of an exclusive licensee. This the defendant denies. The precise question thus arising is, apparently, res nova.

A licensee has no property in the patent. He possesses no interest in the franchise. His rights touch only the invention and do not affect the monopoly of the patent otherwise than by estopping the licensor from exercising its prohibitory powers in derogation of the privileges conferred by the license. Robinson on Patents. Sections 763, 806. They constitute but a mere exemption from suit for acts done within the scope of the license.

Though his rights be exclusive, a licensee may not maintain a suit under the patent laws without making the patent owner a party thereto. Where the wrong is infringement the licensee has, under some circumstances, even in the absence of an express covenant on the part of the licensor to sue infringers, been permitted to make the patent owner a coplaintiff against his will in a suit in equity to enjoin the infringement.

**Emphasis in Trust Relations.**

But, even this privilege lacks express statutory authority. It has its roots in the broad but not unlimited purpose of equity to suffer no wrong to be without a remedy and rests solely upon the analogy of R. S. section 4921 to R. S. section 4919 and upon the maxims and principles of equity. Ind. Wireless Co. v. Radio Corp., 289 U. S. 459, 466-7, 472; Littlefield v. Perry, 21 Wall. 205, 223.

The trust relations between the licensor and the licensee, upon which the licensee's right to make the owner of the patent a coplaintiff is immediately predicated, 269 U. S. 469, arise not out of terms of the license expressly so providing but from its equitable implications.

The express rights of Boyce and the Leander Corporation under the agreement with Townsend are to receive the stipulated royalty of 10 per centum of the net selling price of the heat and water indicators sold by Townsend or his assignee, The Moto Meter Company, with a minimum royalty of $50 a month and to prevent the granting to others, by The Moto Meter Company, of any rights whatsoever under the patents.

The Moto Meter Company has circuitously, but nevertheless in essence, violated the latter of these express rights of Boyce and the Leander Corporation by acquiring the capital stock of the infringing defendant and by permitting it, for upwards of two years thereafter, to operate without interference under the patents.

Thereby, The Moto Meter Company has, at least presumptively, gained an advantage for itself and deprived Boyce

and the Leander Corporation of benefits that would otherwise have been theirs.

The extent to which this has been done is without bearing upon the present motion for unless the defendant may be enjoined, The Moto Meter Company may, at will, cease its operations under the patents, permit the defendant to absorb all its business in heat and water indicators for automobiles and thereby reduce, with corresponding benefit to itself, the large royalties of Boyce and the Leander Corporation to the minimum of $50 a month.

### A Violation of Spirit.

A court of equity is not, I think, so limited in its powers as to be required to deny relief under such circumstances. Nor is it necessary in affording relief to depart from established principles. Implied trusts have been long raised by operation of law to carry out presumed intentions of the parties, to satisfy the demands of justice or to protect against fraud. Transfers of property with limitations on the right to redispose of it have frequently been held to create a fiduciary relation with respect to it. International Pavement Co. v. Richardson, 75 Fed. 590; Kitchen v. Bedford, 13 Wall. 413.

In fact, so broad is the rule that "wherever one person is placed in such relation to another, by the act or consent of that other, or the act of a third person, or the law, that he becomes interested for him, or interested with him in any subject of property or business, he is prohibited from acquiring rights in that subject antagonistic to the person with whose interest he has become associated." Note by Judge Hare to 1 Lead. Cas. Eq. 62.

Indirectly, but in effect, The Moto Meter Company, having a community of interest with Boyce and the Leander Corporation, violated the spirit, if not the letter, of that prohibition by its acquisition of the capital stock of the infringing defendant. A violation of the prohibition gives rise to a right to relief under the doctrine of trusts.

A constructive trust in property may be enforced by one prejudiced or deprived of a benefit by fraud or a breach of trust on the part of another who occupies a fiduciary relation with respect to such property and thereby gains an advantage for himself. Columbus, etc., R. Co. v. Burke, 10 Ohio Dec. (Reprint) 136.

I think that under the facts pleaded, the status of Boyce and the Leander Corporation is equal if not greatly superior to that of an exclusive licensee under a patent and that their joinder of The Moto Meter Company as a coplaintiff was well within their rights. 269 U. S. 459.

The motion to dismiss the bill of complaint must be denied.

March 30, 1929.

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# *Apparatus for Handling Fluids*

EX PARTE FREDERICK C. FARNSWORTH. APPEAL NO. 1076, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1708471 was issued April 9, 1929, to Frederick C. Farnsworth for Apparatus for Handling Fluids, on application No. 450614, filed March 8, 1921.

Claim 1, differing from the basic patent in calling for the supply and discharge of water from the bottom of the compartments and for the use of a four-way valve, was held unpatentable in view of other patents disclosing those features.

The rejection of claim 2 on the ground that it merely constituted an aggregation of features found in the four references cited was not sustained, where it was not pointed out which patent would be taken as a basic patent and how it could be modified by introducing the prior art devices to produce the structure called for in the claim.

Rudolph M. Hunter for applicant.

Before First Assistant Commissioner Kinnan, Examiners-in-Chief Ruckman and Landers. The full text of the Board's decision follows:

This is an appeal from the rejection of the two claims in the case. Claim 1 is representative and reads as follows:

### A Representative Claim.

"1. The combination of two compartments, pipes for supplying water to and controlling its discharge from the bottom of the compartments provided with automatic check valves, fluid pressure pipes for each of the compartments for alternately supplying pressure to forcibly discharge the water from the compartments, a four-way valve controlling the fluid pressure pipes whereby the fluid pressure is supplied to the two com-

partments alternately from a common source of pressure and for automatically venting the two compartments alternately when filling, a float actuated by the high and low water levels in one of the compartments, and means actuated by the float to insure the timed operation of the four-way valve."

The references relied upon are: Hermes 533355, Jan. 29, 1895; Sheedy, et al., 704129, July 8, 1902; German patent, 239043, of 1910; Shue, 1197771, Sept. 12, 1916.

In his brief appellant states that the amendment consisting of the insertion of "provided with automatic check valves" which in his amendment filed July 30, 1923 (paper No. 5) appellant directed to be entered after "compartments" in line 3 of original claim 4, should have been entered after the first occurrence of said word in the line, instead of the second as made by the examiner.

This correction has been made so that the claim which is now claim 1 reads as quoted above.

Claim 1 is not believed to be patentable over patent to Sheedy et al. The claim reads fairly upon this patent except (1) that the claim calls for the supply and discharge of water from the bottom of the compartments while in Sheedy the water enters at the top and is discharged from the bottom of the compartments, and (2) the claim specifies a four-way valve while Sheedy shows a slide valve 48.

We see no invention in the first of these differences over Sheedy since patent to Hermes shows that it is old to provide for the entry and discharge of the water through a pipe in the bottom of the receptacle.

Concerning the second point of difference, we do not think any invention involved in substituting for the check valve of Sheedy the four-way valve of Shue or the German reference.

Appellant's contention that the construction of valve 10a shown by Sheedy would result in its opening and letting water into the tank 3a when it should be closed, is not well taken.

**Effect of Basic Reference.**

Claim 2 is more specific to appellant's construction and includes a piston and cylinder for operating the four-way valve for controlling said piston and a float for actuating the pilot valve.

The examiner has rejected this claim on the ground that appellant has merely selected and aggregated features from the four references cited and that this was an uninventive act. The examiner has not stated which of these patents he would take as the basic reference, nor how he would modify it by introducing the prior art devices to produce the structure called for in claim 2. We are not satisfied that this could be done without invention.

The decision of the examiner is affirmed as to claim 1 and is reversed as to claim 2.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

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## APRIL 24

# *Claims for Making Truck Bodies*

EX PARTE LEO J. STYSLINGER. APPEAL NO. 955, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1708639 was issued April 9, 1929, to Leo J. Styslinger for truck bodies, on application No. 673099, filed November 6, 1923.

The main distinction between appellant's disclosure and that of the prior patent related to the method of making the truck body, as the structures when completed were substantially the same. Claims 1, 2, 3 and 4 were directed to the structure, not to the method of making the article, and were found to be unpatentable in view of the prior art.

The use of a wood rather than metal as a material from which to make the truck being considered immaterial from the standpoint of patentability, claim 6, based upon this feature, was held to be anticipated.

Claim 5, rejected on a combination of references, and including certain limitations which were not clearly shown in such references, was allowed.

Byrnes, Stebbins & Parmelee for applicant.

Before Moore, Assistant Commissioner, Henry and Ruckman, Examiners-in-Chief. The full text of the opinion of the Board of Appeals follows:

This is an appeal from a final rejection of claims 1 to 6 inclusive. Claims

1 to 5 are reproduced for illustrative purposes:

"1. A truck body frame for the reception of the sides, ends and floor of the body, comprising a plurality of transverse beams, and a plurality of side irons on each side of the frame, each side iron having a foot which is rigidly secured to one end of a transverse beam and a substantially vertically extending portion, the vertically extending portions of the side irons being arranged to receive the sides of the body, while transverse beams are arranged to receive the floor of the body.

"5. A truck body comprising a metallic frame including transversely extending members, a metallic cover extending over the ends, the tops and bottoms of the transversely extending members, the body having side members, and stakes for supporting extension side boards for the body extending through the openings in the tops of the metallic cover and supported on the bottom thereof."

The references relied on are: Kramer, 1425596, Aug. 15, 1922; Press, 1508122, Sept. 9, 1924.

### Distinction in Procedure.

Appellant is claiming a truck body frame having certain structural characteristics. Thus the frame includes longitudinally extending I-beams, transversely extending I-beams supported by the longitudinally extending beams and having secured to the ends thereof side irons with vertically extending portions of T-section. The side irons receive the sides of the body and the transverse beams support the floor of the body. Certain details of construction included in some of the claims will be discussed in the consideration of such claims.

In the rejection of the claims the examiner relies mainly on the Press patent. So far as the completed structure is concerned the Press patent seems to be a good reference. But appellant argues that Press was not concerned with the production of a truck body frame to which the sides and floors of the body could be applied. Thus it is contended by appellant that the floor and sides of the truck body are assembled on the longitudinal and transverse beams before the side irons are applied.

An affidavit of one Avery who is an engineer for the company manufacturing truck bodies under the Press patent has been filed setting forth the procedure followed in the manufacture of truck bodies under the Press patent.

Affidavits by truck body builders and truck users have also been filed describing prior art procedure relating to the building of truck bodies and pointing out advantages in appellant's construction and method of assemblage. As previously noted the main distinction between appellant's disclosure and that of the Press patent is one of procedure. We note at this point that the appealed claims are concerned with a structure and not a method of producing the structure. Ordinarily claims for a structure should define the invention by a recitation of structural features rather than by limitations as to procedure. Even if it were proper to define an invention relating to a structure by a recitation of the method by which it is produced we do not find in the claims on appeal any direct limitation to a method or procedure.

Claims 1 and 2 are literally met by the Press patent unless it be held that such implied limitations as are included in the expressions "for the reception of the sides, ends and floor of the body" and "arranged to receive" distinguish over the reference. But as noted above these claims are concerned with a structure and the completed structure of the Press patent responds to the claims.

No additional comment is necessary with respect to claim 3 further than to state that we agree with the holding of the examiner that the recitation of T-section side irons is not a patentable distinction over the disclosure of the Press reference.

Structurally, claim 4 distinguishes from the Press disclosure only in the statement that the bumpers extend under the ends of the transverse beams. We think it would be uninventive to extend the bumpers 14 of the Press patent under the ends of the transverse bars 2 of the patent. The parts 12, 13 of the Kramer patent show how such an extension could be made.

### Stakes for Extension Sides.

The examiner rejects claim 5 on a combination of the Press and Kramer patents. The claim calls for stakes supporting extension side boards and a special means for supporting the stakes in addition to subject matter generally included in preceding claims. In the supplemental reference, Kramer, we fail to find a clear disclosure of the extension side boards, stakes and stake supporting means. It is doubtful if the Kramer patent would teach a modification of the Press construction such as would meet

claim 5. As presented to us claim 5 should be allowed.

Appealed claim 6 is drawn along lines generally similar to claim 1 but is further limited to a nonmetallic body carried by the truck frame. The examiner holds, and we agree with him, that from the standpoint of patentability it is immaterial whether the truck body proper is of wood or metal.

Certain additional claims were presented after final rejection but were not admitted by the primary examiner and were not discussed by him except a brief reference in a supplemental statement discussing an affidavit filed under the provisions of Rule 76. Under the circumstances we decline to recommend the admission of the additional claims.

The action of the examiner respecting claims 1, 2, 3, 4 and 6 is affirmed. As to claim 5 the action is reversed.

Limit of appeal to Court of Appeals 40 days. Rule 149.

# *Finding of Patent Infringement On a Glass Receptacle for Ashes*

SMOKADOR MANUFACTURING CO., INC., APPELLANT, V. TUBULAR PRODUCTS COMPANY, APPELLEE. NO. 237, CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

AN ASH tray waste receptacle made of glass rather than of an opaque material such as was previously used in such devices, whereby ready inspection of the container without the necessity of removing it from the stand was made possible, the Court found was patentably differentiated from the prior art.

In view of the fact that complainant's device saved time and labor, that defendant had adopted it and placed it upon the market, thereby attesting to its validity, the opinion concludes that the prior art device consisting of an ash tray, a tube descending to a waste receptacle at the base, and skirt at the base and attached to the lower end of the tube, did not constitute an anticipation.

Patent No. 1646086 was accordingly held valid and infringed, and the decision of the lower court reversed to that extent.

### Lack of Basis for Action.

The Court ruled that there was no basis for a cause of action for unfair competition, upon a finding that the words "Ashless Ash Stand," used by plaintiff, were descriptive of the goods, and that defendant used the mark "Ashagon."

Mitchell & Bechert, of New York City (John P. Bartlett, of New York City, of counsel) for appellant; Gifford & Scull, of New York City (George F. Scull, of New York City, of counsel) for appellee.

Appeal from the District Court for the District of Connecticut.

Before L. Hand, Swan and Augustus N. Hand, Circuit Judges. The full text of the opinion of the court, delivered by Judge Augustus N. Hand, follows:

The complainant has for some time been engaged in the commercial development of ash stands which rest on the floor and have an ash tray at a point within convenient reach of the user, and a vertical tube attached to it for the purpose of conducting the ashes, burnt matches, and cigar stubs into a waste-receiving receptacle in the lower part of the stand.

The first of these smoker's stands, called the "Rock-a-by," or "Roly-Poly," sold under the trade mark "Smokador," was made under United States patent No. 1559234, to Fleming, dated October 27, 1925, and was extensively sold. It was provided with a weighted, rocking base, fitted normally to hold the stand in a vertical position, and to return it to a vertical position when rocked. The base of this stand served both as a support and as a waste-receiving receptacle.

The patent in suit, No. 1646086, also was the result of Fleming's work in the same field as above, and represents an improvement in the mechanical features of ash stands. It adds to the former three-part unit, wherein an ash tray is supported on the upper end of a tube, with which a waste receptacle is connected at the bottom; the further element of a supporting skirt, forming a cavity sufficient to embrace the waste receptacle.

The specification, page 1, line 88, says: "It will be observed that the waste-receiving receptacle is indicated as being made of glass, and it is apparent at once that it is of the conventional shape of an ordinary fruit or preserve jar.

Thus, the user may at any time readily observe to what extent the waste-receiving receptacle is loaded with waste, by simply lifting the stand and peering through said glass receptacle. Again, if the user should have the misfortune to break the jar, it may be very readily replaced for a few cents, or without any expense, if the user happens to have a similar fruit jar in his possession not in service."

It is true that the claims are not in terms limited to a receptacle for waste, made of glass; but mechanical advantages of such a structure are set forth in the above extract from the specification and other advantages in fact exist. If the patent is to stand, the word "glass" must be incorporated in the claims, so that they read "a glass waste-receiving receptacle," instead of "a waste-receiving receptacle."

**Necessity of Limitation.**

Such a limitation is necessary in view of the prior art, for not only did the Roly-Poly device manufactured under the earlier patent, No. 1559234, to Fleming, have all the elements of the patent in suit, except the skirt and the glass jar within it to receive the waste, but United States patent No. 1237014, to Botty & Prior, granted in 1917, shows an ash tray, a vertical tube descending to the base, and a drawer to receive and remove the ashes. This patent discloses in substance a supporting skirt, in which a drawer is inserted to remove the ashes in the same way that a removable glass jar is threaded in the patent in suit.

In United States patent No. 1364892, to Schulte & Weite, there is shown an ash tray, a tube descending to a waste receptacle at the base, which is enveloped by a skirt attached to the lower end of the tube. In the Schulte & Weite device, the ashes are emptied by a shutter in the bottom of the base, operated by a wire running down to the shutter from the top of the stand. It seems evident that the slight variations of the patent in suit from the prior structures do not merit a patent, unless the waste receptacle be limited to one composed of glass.

But the glass construction disclosed in the specification has manifest advantages. It renders the contents of the receptacle at once visible, without removal of the jar. In other words, a porter in a hotel can turn up the stand and see through the transparent glass whether any tobacco refuse is in the receptacle. If none is visible, he need not unscrew the jar, as he would have to do in the case of a stand that had not a transparent receptacle.

The device manifestly saves time and labor. Moreover, a frangible substance like glass would not, we think, readily suggest itself for a receptacle, and such a substance never seems to have been used for the purpose prior to the time when Fleming embodied the idea in the patent in suit. Indeed, the first thought of such a receptacle might well have been negatived by the consideration that glass would expose to view the dirty contents of receptacles in stands that had been used since cleaning. The ordinary artisan thinks in terms of "use and wont."

To substitute glass for a prior, and what we may justly regard as a more obvious, form of container, and to shield it from sight, except when the stand is turned up for examination, seems to us a patentable step. If the advantages of doing what Fleming accomplished had been apprehended, the means to attain them would perhaps be too simple to deserve the name of invention. But the apprehension of the labor-saving, convenient, and neat device disclosed in the patent in suit involved more than the work of a routine mind.

It is true that the complainant has not put an ash stand made in accordance with the patent on the market, but this makes no difference, for the defendant has sold 1,000 of these ash stands. That is a substantial tribute to defendant to the value of the invention. Moreover, defendant obtained the idea of a glass jar from Murray, a former employe of complainant, who submitted a drawing showing a glass jar, made January 13, 1927, three weeks after the date of Fleming's application for the patent in suit. If the patent is of no merit, it is hard to see why defendant followed its teaching, and put a device on the market which admittedly infringed.

It is admitted that defendant paid Murray $1,000 for the so-called invention shown in his drawing embodying a glass receptacle for waste. There is also uncontroverted testimony that complainant gave Murray, early in 1925, and while he was still in its employ, a model ash stand having a glass receptacle (Exhibit 11). It is quite clear that the inventive thought on which defendant's infringing ash stands were based came directly from complainant, and that defendant, whether or not it was ignorant of the real origin of the idea, appreciated the value of introducing glass as a receptacle into ash stands, and was willing to pay to secure the assistance of Murray. In-

deed, defendant's treasurer testified: "I thought this glass jar receptacle was a good thing. It appealed to me very much."

All the patents of the prior art which we have discussed were cited against the patent in suit during its progress through the Patent Office, and it was granted over these references. The regular presumption of validity accompanying a patent thus gains added weight.

The claims should be limited to a glass receptacle, and this limitation may properly be made, where the claims as drawn are too broad, and the invention embodied in the claims are limited as disclosed in the specification. A meritorious invention disclosed in the specification should be saved, in spite of broad claims, by such a limitation. Fowler & Wolfe Mfg. Co. v. McCrum-Howell Co. (C. C. A.) 215 F. 905; Radio Corporation of America v. Twentieth Century Radio Corporation (C. C. A.) 19 F. (2d) 290.

We accordingly hold the patent valid and infringed.

The causes of action for infringement of trade mark and for unfair competition need but slight comment.

About four years ago complainant began to use the words "Ashless Ash Stand" in connection with the fanciful term "Smokador" in marketing its ash stands. These words have neither been shown to have acquired a secondary meaning nor to have caused, or to be likely to cause, deception. The trade mark under which complainant's goods have been sold was "Smokador," and defendant's mark was "Ashagon." The supplemental words "Ashless Ash Stand," used in connection with the trade marks, were only descriptive of the several goods sold. They were not a valid common-law trade mark, nor did they form any basis for a cause of action for unfair competition. Turner & Seymour Mfg. Co. v. A. & J. Mfg. Co. (C. C. A.) 20 F. (2d) 298.

The decree is modified, so as to hold the patent in suit valid and infringed, and is otherwise affirmed.

March 4, 1929.

## APRIL 25

# *Requirement to File Disclaimer*

R. HOE & CO., INC., AND GUARANTY TRUST COMPANY, APPELLANTS, v. GOSS PRINTING PRESS COMPANY. No. 46, CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

THE ruling of this case holds that when a patent has passed through all the courts then available, the plaintiff should be required to file a disclaimer of claims held invalid before proceeding upon such as may have been found valid.

The Circuit Court of Appeals affirmed the District Court in holding one of the claims in suit valid, reversed it as to ten, which it ruled were invalid, and declined to pass upon four. The defendant moved to have the mandate or decree changed, so as to require plaintiff to disclaim the invalid claims.

**Decree in Accordance.**

A decree in accordance with this request was granted, requiring plaintiff to file disclaimer within 30 days after conclusion of proceedings with respect to writ of certiorari.

John D. Morgan, of New York City, for defendant; James J. Kennedy, of New York City, opposed. Appeal from the District Court for the Southern District of New York. Before Manton, L. Hand and Augustus N. Hand, Circuit Judges.

The statement of facts and full text of the opinion of the court follows:

On motion to recall and amend the mandate of the Circuit Court of Appeals.

The merits of this case were considered and the appeal decided in the opinion of this court handed down on January 9, 1929. The court affirmed the District Court as to one of the claims in suit, which it held valid; reversed as to 10, which it declared invalid; and declined to pass upon four.

The mandate issued and was lodged in the District Court, and the plaintiff applied for interlocutory decree upon the single claim. The defendant thereupon demanded that the plaintiff file a disclaimer as to those claims declared invalid, as a condition of proceeding upon that held good.

The District Judge thought that the mandate forbade his imposing such a condition upon the decree to be entered, and the defendant moved on March 11 to

recall the mandate and amend it, so as to require a disclaimer.

Per Curiam. We held in Page Machine Co. v. Dow, Jones & Co., 168 F. 703, that we would not require a patentee, whose claims we had held valid, to disclaim a claim found invalid by the Circuit Court.

At that time the plaintiff had no appeal from an interlocutory decree of invalidity, and the effect of requiring a disclaimer was to make the decision of the Circuit Court final without review by us. If the patentee had had the appeal which he now has, the result need not have been the same, as Judge Westenhaver pointed out in Ensten v. Rich-Sampliner Co. (D. C.) 13 F. (2d) 132.

It is the practice of the Sixth and Seventh Circuits to require disclaimer of those claims held invalid in the Circuit Court of Appeals as a condition of proceeding upon the valid claims. Herman v. Youngstown (C. C. A.) 191 F. 579, 587; Liquid Carbonic Co. v. Gilchrist Co. (C. C. A.) 253 F. 54; Higgin Mfg. Co. v. Watson (C. C. A) 263 F 378, 387; Excelsior, etc, Co. v. Williamson Heater Co. (C. C. A.) 269 F. 614, 619.

We can see no distinction, whether a decree holding some of the claims invalid is affirmed, or this court in part reverses a decree holding them all valid. In each case the time is extended till the decision on appeal.

If this court's decision were final, such a rule would be a corollary of O'Reilly v. Morse, 15 How. 62, 14 L. Ed. 601, Seymour v. McCormick, 19 How. 96, 15 L. Ed. 557, and Gage v. Herring, 107 U. S. 640, 2 S. Ct. 819, 27 L. Ed. 601.

However, it is not final, if the Supreme Court chooses to grant certiorari. In that event, a disclaimer would destroy the patentee's right to a review of our holding as to invalidity.

The patentee should not be put to such a hazard, but should be as free to withhold his disclaimer, until his appeal to the Supreme Court is decided, as he is upon appeal to this court from the decree of the District Court.

The plaintiff at bar goes further, however, arguing that, even after denial of an application for certiorari, the patentee should not be obliged to disclaim. It argues that the Circuit Court of Appeals of another circuit might disagree with our ruling, and the Supreme Court would then take the case on certiorari and might declare the claims valid.

A disclaimer would merely destroy this right, though the defendant is protected forever by its decree, and really has no interest in the disclaimer at all.

While we acknowledge the difficulty and the possibility, it appears to us that so to extend the patentee's time might result in avoiding the statute altogether. The patentee may not sue again, or, if he does, the result may be the same.

It does not follow, because two Circuit Courts of Appeals have held the same way, that a third will not disagree. Must the patentee disclaim at the conclusion of the second suit, or may he wait until all nine circuits have passed upon his claims?

**Restriction on Litigation.**

The question is at best of seasonable action, and in practice there must be some end, short of exhausting all conceivable remedies. When the patent has once passed through all the courts then available, the statute should have its effect; else the putatively invalid claims may remain as scarecrows, preserved against the bare possibility that at some future time they may come to life.

The mandate will, therefore, be recalled and amended, so as to require the plaintiff to file a disclaimer within 30 days after the time expires within which to petition for certiorari, or, if it does so petition, then within 30 days after denial, if it is denied, or affirmance of the decree, if it is granted, and the decree is affirmed.

March 22, 1929.

## APRIL 26

# *Forging of Insulator Caps*

EX PARTE CLINTON W. STOVER. FIRST ASSISTANT COMMISSIONER OF PATENTS.

PATENT No. 1709329 was issued April 16, 1929, to Clinton W. Stover for a Method of Forging Insulator Caps, on application No. 649449, filed July 5, 1923.

The examiners-in-chief, in holding that in the method of making an insulator cap there is nothing novel in the idea of shaping a mold to the form of the article to be produced and that there is likewise nothing novel in the idea of form-

ing pockets in such mold into which the metal may be extruded in the forging operation, were affirmed by the First Assistant Commissioner on appeal.

Frease & Bond for applicant.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

Applicant has appealed from the decision of the examiners-in-chief affirming that of the primary examiner denying patentability to four claims, of which claims 1 and 4 will serve for illustrative purposes, and are as follows:

"1. The method of making an insulator cap or the like from a blank, which includes forging a cup and simultaneously extruding laterally spaced ear lugs on the bottom thereof.

"4. The method of making an insulator cap or the like from a blank, which includes forgoing a cup with an off-set rim and simultaneously extruding laterally spaced ear lugs on the bottom thereof, and then bending the rim inward to form an annular recess between the edge of the rim and the off-set."

The references relied upon are: Goddard, 1232278, July 3, 1917, Fitzgerald, 338051, March 23, 1886, Labourot (French), 542043 May 11, 1922.

The examiners-in-chief in their decision added the reference Lamont et al., 1431238, Oct. 10, 1922.

The claims are directed to a method of making an insulator cap for use in strain insulators. The cap is of the specific form disclosed in the patent to Goddard having two separated counterpart attaching ears such as shown in Goddard but better disclosed in Figure 1 of the patent to Sonnenborn, 1291217, of record in the case.

By means of a die of suitable construction, the blank indicated in Figure 2 is forced by the punch to assume the shape disclosed in Figure 6. By subsequent operations, as indicated in Figures 9 and 11, the shapes illustrated in Figures 10 and 12 may be produced when such shapes are desired.

In order to provide the two spaced ear lugs 16, there is inserted at the bottom of the die, illustrated in Figure 4, a slidable tongue 24, which projects into the bottom of the die so that when the metal of the blank is forced into the bottom of the die, it will be extruded on each side of this sliding tongue and the spaced ears will be formed. This slidable tongue subsequently can be used as a knock-out to remove the forging.

The ears are subsequently bored transverely by the usual boring operation.

It has been held by the examiners-in-chief, and of the correctness of such holding it is believed there can be no reasonable doubt, that there is nothing novel in the idea of shaping a mold to the form of the article it is desired to produce and that there is likewise nothing novel in the idea of forming pockets in such mold into which the metal may be extruded in the forging operation. All this is a matter of common knowledge to workers in molded articles and substantially this much is shown in the French patent to Labourot and in the patent to Fitzgerald.

The applicant has urged the view that the French patent discloses a two-step method before the article indicated in Figure 3 of the patent is produced, but this is not deemed material since the formation of the article shown in Figure 2 is all that need be considered. No contention is made that this article has long spaced ears formed upon it, but the patent does show the shaping of the mold with pockets in it so as to form projections upon the contour of the article.

Likewise, the patent to Fitzgerald shows several pockets in the mold into which the material of the article is extruded to form the necessary projections upon the finished product.

In view of these facts it is believed there was involved nothing inventive, nothing more than the ordinary skill of a workman in designing a mold of the shape to produce the particular article described in this application. It is believed the claims are wanting in merit, and it would seem, for the same reasons, the proposed substitute claims submitted in appellant's brief are likewise without merit.

The subsequent steps, after the first forging operation is completed, of boring holes in the ears and bending down the flanges to the desired shape, are but the usual metal working operations in forming articles of this character and the inclusion of these steps in some of the claims in no way adds to their merit.

The references cited do not disclose the particular die described by applicant, which includes a movable tongue in the bottom which functions to divide the socket or depression in the mold into two pockets to receive the extruded metal to form the spaced ears, and which tongue may be later used as a knock-out. If this construction is novel, it is presumed an allowable claim could be presented for it.

The decision of the examiners-in-chief is affirmed.

# Apparatus for Finishing Hosiery

EX PARTE LYNN GRAY. APPEAL NO. 1267, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1709397 was issued April 16, 1929, to Lynn Gray for hosiery finishing apparatus, on application No. 100601, filed April 8, 1926.

The rejection of the 10 claims in the case, relating to a drying and shaping structure for treating hosiery, as being for aggregations for the reason that all the elements of the combination did not operate simultaneously, was not sustained. The decision of the Examiner was reversed as to claims 1, 3, 5 and 6 and claims 2, 4, 7, 8, 9 and 10 were disallowed as being unpatentable over the allowed claims.

The Board ruled that where the elements form a unitary structure wherein each element necessarily supports and supplements the others, though each element of the structure is old, the combination of them all constitutes patentable novelty.

Morrison, Kennedy and Campbell for applicant.

Before Moore, Assistant Commissioner, Ruckman and Landers, Examiners-in-Chief. The full text of the decision of the Board of Appeals follows:

This is an appeal from the rejection of all the claims in the case, 10 in number.

Claim 1 is representative and reads as follows:

"1. A drying and shaping structure for treating hosiery, including a form provided with oppositely disposed crease-producing edges and with a pair of incuts at opposite sides of and adjacent one of the edges, each incut including a seam-engaging surface whereby seamed hosiery can be boarded, either as a 'left' or as a 'right' on the structure, the two engaging surfaces terminating in and forming one of the crease-producing edges whereby a crease may be selectively produced in the hosiery with the seam therein disposed at one or the other side thereof."

The alleged invention relates to a hosiery drying and shaping form. Appellant constructs his form with a pair of incuts or grooves, providing a seam-engaging surface whereby the crease may be formed on either side of the seam. The present application is a division of one that matured into Patent No. 1583590.

Prior to appellant's invention it appears to have been the custom to use two forms, one for forming the crease on the right-hand side of the seam and the other when it was desired to form the crease on the left-hand side, as shown, for example, on Figs. 3 and 4 of appellant's patent. In the present application appellant has combined the two prior forms in one by making a groove on each side of the crease-producing edge, thus providing for the creasing of stockings into rights and lefts on a single form. The commercial importance of appellant's form is realized from the fact that it is possible by his construction to reduce the number of forms by one-half.

### Novelty is Conceded.

The examiner concedes novelty in this form but has rejected all the claims on the ground of aggregation. He states that "Since only one stocking can be shaped at a time on each form only one of the incuts is used at a time and the incuts do not cooperate in any way." He therefore concludes that the claims are drawn to unpatentable aggregations.

It is well settled, however, that in a patentable combination it is not necessary that all the elements should operate simultaneously. Moreover, in appellant's device there is a certain cooperation in the position of the grooves, in that they are complementary and make it possible to form the stocking with either a right or left crease.

This case is believed to be quite analogous to that of In re Prescott and Rummler, 1922, C. D., 119, in which the Court of Appeals of the District of Columbia said:

"While it is true that each element of the new combination is old, we do not think it may be said that each of these elements functions independently of and without reference to the others, for in combination they form a unitary structure wherein each element necessarily supports and supplements the others.

### Patentable Combination.

"Through the combination a new result is effected, namely, a wheel possessing certain essential characteristics of three wheels of the prior art. In this respect the case differs from Grinnell Washing Mach. Co. v. Johnson Co. (247 C. D., 1918, 263; 254 O. G. 225; 247 U. S. 426).

"Although the question is close, we incline to the view that the idea in-

volved something more than mechanical ability. In such a case we resolve the doubt in favor of the applicant. In re Huff (C. D., 1919, 152; 259 O. G. 386; 48 App. D. C. 258). Inasmuch, however, as claim 28 completely covers applicants' contribution to the art, there is no reason for allowing a large number of claims, and thus inviting controversy and litigation."

For reasons similar to those given by the Court in the above decision we consider that appellant's claims cover a patentable combination. As held by the Court in that case, however, we do not think there is room for the large number of claims presented. Claims 1, 3, 5 and 6, embracing the broadest and narrowest, as well as two claims of intermediate scope, are believed to adequately cover appellant's invention. The remaining claims are not considered patentable over these claims.

The decision of the examiner is reversed as to claims 1, 3, 5 and 6. The rejection of claims 2, 4, 7, 8, 9 and 10 is affirmed on the ground that they are not patentable over the allowed claims.

## APRIL 27

# *Features of Yarn Tension Apparatus*

EX PARTE JOHN O. MCKEAN. APPEAL No. 809, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1708514 was issued April 9, 1929, to John O. McKean for yarn tension devices, on application No. 151144, filed November 27, 1926.

The feature of using a detachable wear plate on a machine was held unpatentable. The rejection of claim 21, directed to an attachment to be used in connection with yarn tensioning mechanisms, and containing as a limitation a detachable wear plate on that part of the machine subject to wear where the yarn drags over it, was sustained.

Claims 22 and 23, including an element associated with the plate and adapted to keep the yarn from moving beneath the plate, were found allowable on appeal. Brown and Seward for appellant.

Before Moore, Assistant Commissioner; Skinner and Redrow, Examiners-in-Chief. The full text of the opinion of the Board of Appeals follows:

### Appeal From Rejection.

This is an appeal from the final rejection of the following claims:

"21. In a yarn tension device, a tension washer, a stationary support therefor having the usual yarn contact surface under said washer, and a replaceable nonyielding stationary wearing plate located upon said yarn contact surface for protecting the same from wear and for permitting the further use of the tension device.

"22. In a yarn tension device, a tension washer, a stationary support therefor having the usual yarn contact surface under said washer, and a replacable nonyielding stationary wearing plate located upon said yarn contact surface for protecting the same from wear and for permitting the further use of the tension device, said plate having means for preventing the accidental threading of the yarn underneath the plate.

"23. In a yarn tension device, a tension washer, a stationary support therefor having the usual yarn contact surface under said washer, and a replaceable nonyielding stationary wearing plate located upon said yarn contact surface for protecting the same from wear and for permitting the further use of the tension device, said plate having a depending flange extending rearwardly from its leading-in end in close proximity to the adjacent side of the support for preventing the accidental threading of the yarn underneath the plate."

It appears that claim 24 was inadvertently included among the rejected claims in the examiner's statement.

The reference is: McKean, 1468486, Sept. 18, 1923.

The application discloses an attachment to be used in connection with yarn tensioning mechanisms. It involves broadly a detachable wear plate on that part of the tension mechanism which is subject to wear where the yarn drags over it, and which plate can consequently be removed and replaced by a new plate when worn, instead of discarding the whole device. This reduces the "junking" of these tensioning mechanisms as a whole to a minimum.

The reference shows the same tension mechanism without such replaceable wearing plate.

The examiner has allowed claim 24

which is limited to one specific form of the three species of plate shown by applicant. We believe claims 22 and 23 can also be allowed on limitations included therein. Each of these includes an element associated with the plate to keep the yarn from being threaded under the plate. It is possible that this element as in claim 24 would act on both sides of the plate but so far as found, it is also new to place a guard member on one side of the particular plate included in these two claims.

Claim 21 omits the limitation to any guard means and is based on the single idea of a replaceable wear-plate on what would otherwise be the yarn-bearing surface of the yarn-tension mechanism. While the reference relied on does not disclose such feature, it is still believed that this claim is not allowable. It is a matter of general mechanical knowledge to use replaceable wear-plates wherever excessive wear is likely. This is the ground taken by the examiner, and applicant appears to acquiesce in this general reference.

It is therefore held that no patentable novelty is involved in using a replaceable wear-plate on the surface of base block 10 of McKean's mechanism. Its function and result would be entirely obvious beforehand, and no mechanical difficulties are involved in merely placing it there. As broadly stated in this claim, it could be simply a plate with two holes in it dropped in place over the two pins 13.

The rejection is affirmed as to Claim 21, but reversed as to Claims 22 and 23.

Limit of Appeal to Court of Appeals, 40 days. Rule 149.

## APRIL 29

# *Refusal of Additional Device*

CLAUDE NEON LIGHTS, INC., PLAINTIFF-APPELLANT v. E. MACHLETT & SON. CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

APPELLANT'S motion to recall and amend the mandate of this court holding patent No. 1125476 infringed was denied.

In the previous proceedings it was held that defendant's lamp infringed the patent which taught that the electrode area must exceed 1.5 square decimeters per ampere as theh rule of relationship. The button-electrode caesium mirror lamp having an area of 0.7 less than one-half the minimum as specified in the patent, the plaintiff seeks to have included as an infringing device in view of that caesium plays a part which is equivalent to additional surface area of the electrodes.

Motion to amend the mandate was brought and theh court ruled that proceeding should be by supplemental bill or by independent suit for infringement as to the caesium lamp.

The full text of the opinion of the court, delivered by Judge Manton, follows:

**Heard on Appeal.**

When this suit for infringement of patent No. 1125476 was heard on appeal from a decree holding the patent valid but not infringed (Claude Neon Lights Inc. v. E. Machlett & Son, 27 Fed. [2d] 702), we held that the lamp made by the defendant and charged to be an infringement, was in fact established to be an infringement.

The lamps there considered (exhibits 9 and 10) had electrodes of large area containing a charge of magnesium carbonate. At the trial and on the appeal, it was claimed that the disclosure of the Claude patent taught that the electrode area must exceed 1.5 square decimeters per ampere as the rule of relationship. It was then asserted that a practical commercial neon tube of long life could not be made except by following this rule of relationship by employing an electrode exceeding the minimum area.

The contention was advanced that the button-electrode caesium-mirror lamp referred to as the caesium lamp had an electrode of an area of 0.7, less than one-half of the minimum as specified in the Claude patent.

The caesium lamp was considered in the District Court and by us on appeal for the purpose of enabling the defendant to establish the incorrectness of the Claude rule of relationship between the electrode area and current. There we said:

"The argument that the button-caesium of caesium-mirror electrode proved that the patentee's rules of relationship of surface area to current used plays no part in the life of the tube, is also unsound. Machlett's testimony is a refuta-

tion of this claim. The caesium plays a part which is equivalent to additional surface area of the electrodes. It is equivalent to additional electrodes. The button electrode is always and only used with caesium. Without the caesium the button electrode would destroy itself before complete formation of the neon tube. Machlett admits that the caesium has an effect on the cathode drop. The appellee has not proven that the button electrode with caesium is equivalent to an electrode of the same area without caesium. It does not establish the inventor's rule to be erroneous."

**Opinion Misunderstood.**

This reference in our opinion does not justify the claim of the plaintiff that we then held that the button caesium electrode type of lamp is an infringement of the claim and that the caesium plays a part which is equivalent to additional surface area of the electrodes. We considered the button-caesium electrode type as an equivalent only on commenting upon the failure to disprove the Claude rule. The district judge, who has been applied to for an extension of the decree of infringement so as to include the caesium lamp as an infringement, has apparently misunderstood what we wrote.

We therefore suggest that since the plaintiff now claims that the caesium lamp is an infringement, the district judge consider the merits of this controversy and not foreclosed by what we have written. This should proceed by supplemental bill or by independent suit for infringement as to the caesium lamp.

We will deny the motion to recall the mandate but express our views as a guide to the district judge or master before whom the future proceedings may come.

Motion denied.

April, 1929.

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# *Wooden Seat With Rubber Cover*

BRUNSWICK-BALKE COLLENDER COMPANY, PLAINTIFF-APPELLANT v. THE SEAMLESS RUBBER COMPANY, INC. CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

PATENT No. 1273703, for a toilet seat composed of laminated wood core with a covering of hard rubber vulcanized on the core and united thereon throughout its entire surface, was found to be valid and infringed, the decree of the lower court (III, U. S. Daily, 1648) being reversed.

The patent device was considered a decided step forward in the trade in that it comprised a sanitary, unbreakable seat having no crevices and the outer surfaces of which were free from germ impregnation. The court concluded that prior art devices consisting of a toilet seat made of rubber, another made of a wood core provided with a celluloid covering, and a third made of wood with rubber vulcanized thereto but with portions of the wood exposed, did not constitute anticipations.

William H. Davis, Merton W. Sage and Henry F. Parmelee, for appellant; William A. Redding, Ambrose L. O'Shea, Arthur L. Shipman, of counsel for appellee.

Before Manton, Swan and Augustus N. Hand, Circuit Judges. The full text of the Court's opinion, delivered by Judge Manton, follows:

This suit for infringement of patent No. 1273703, issued July 23, 1918, on an application filed January 5, 1914, resulted in a finding of the validity of the patent but not infringement. The product constructed under the teaching of this patent is an unbreakable and permanently sanitary toilet seat. It is built up by using thoroughly dried layers of wood veneer cemented together and shaped in such manner as to leave the core with a rough curved pubescent surface. This is covered with a semi-plastic fine rubber which is vulcanized into a hard rubber coating which hermetically seals and covers completely the wooden core.

**Trade Recognition.**

The invention has won trade recognition and now constitutes 14 per cent of the total sold. The sole claim of the patent reads:

"A closet seat comprising a wood core consisting of a plurality of thoroughly dried layers of wood veneer arranged one upon the other with the grain of each layer disposed angularly with respect to the grain of the adjacent layer or layers, said layers being cemented together and said core having a rough pubescent surface, and a covering of hard rubber vulcanized on said core and united therewith throughout the entire surface of the core."

The adhesions of the hard rubber

veneer to the core is so great that the rubber veneer and laminated wood core are an integral mass due to the fact that thorough kiln drying of the core renders the fiber of the core more easy of penetration by the semiplastic rubber veneer and the pubescent surface proves an additional anchorage for the rubber. An integral band is formed which is inseparable and joins the surfaces of the inner and outer portions of the seat to each other.

Thus there is produced a seat of laminated wood core with a covering of hard rubber vulcanized on the core and united thereon throughout its entire surface. This produces a sanitary and unbreakable seat in which there are no crevices of any kind for the reception of germ generating matter and whose outer surfaces are immune from germ impregnation and has been considered a decided step forward in the trade. What the inventor accomplished displayed inventive thought unless there is an anticipation to be found in the prior art. Diamond Rubber Co. v. Consolidated Rubber Co., 220 U. S. 428; Kurtz v. Belle Hat Lining Co., 280 Fed. 277.

### Previous Processes Considered

Of that art we are referred to Stepp, patent No. 219033 relating to covering wooden articles with hard rubber. Among these no mention is made of a toilet seat. This patent is for a process and was granted in 1879. It did not solve this problem which had been pressing for 20 years and solved by the appellant's invention in 1914. The Barnes patent No. 654301 of 1900 suggested hard rubber for toilet seats. The patentee proposed a hollow toilet seat having an upper or operative surface of hard rubber to which is cemented or vulcanized a flat bottom of soft rubber. The operative surface of the seat is segmental in form and is made of hard rubber to give it stiffness and rigidness. The crown formed an interior channel across which were lateral webs perpendicularly disposed and formed intergrally with the crown piece. These webs gave strength and rigidity to the crown piece to reduce its weight and cost. A softened rubber base was vulcanized, cemented or otherwise secured to the base of the crown piece.

In Joralemon patent No. 674166 granted in 1901, there is described a celluloid covered seat. It provides for covering an ordinary wooden seat with a tube-like covering of sheet celluloid. The appellant's inventor, in former patents Nos. 1206186 and 1208869 of 1916, tried a cover, as Joralemon did, except he used hard rubber. It was found that great pressure of vulcanizing forced the rubber into joints between the sections of the wood core and this in turn forced the wood to the surface of the rubber, leaving exposed portions of the wood. A radical difference was found to exist between covering a seat with celluloid and hard rubber. Illustrating the difference in durability, the celluloid cover seat is guaranteed for five years while the seat in patent in suit is guaranteed for the life of the building.

The Romunder patent No. 848690 granted in 1907 disclosed merely a toilet seat of sheets of wood veneer united by cement under heat and pressure. There is no covering of rubber or other materials. Holding the patentee to the limitations of his claim by his specific definitions of the elements thereof which are found in his specifications (I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429), he has made an invention which was not anticipated by the prior art.

### Hard Rubber Covering.

Moreover, the patent is infringed. The appellee's seat has all the elements of appellant's. The covering of hard rubber is united with the core throughout the entire surface. The patent provides for a core thoroughly dried. There is a plurality of cross-grained members of wood veneer constituting the core. It further provides for placing it in a drying kiln under pressure and so super-kiln dried that the last vestige of moisture has been expelled therefrom, and it says "the laminated wood core is an integral mass because the thorough kiln drying renders the fiber of the core more easy of penetration by the semi-plastic rubber veneer and the pubescent surface of the core proves an additional anchorage for the rubber."

An analysis of the wood of one of appellee's seats showed the moisture to have been removed to less than 2 per cent. The method of drying, used by the appellee, brings about the same extraction of moisture and thoroughly dries the wood—at least to the same extent—as is done by the appellant in making its core. But the method of drying is unimportant. The degree of drying is important because the patented seat attains the integral union of rubber covering with the core by practically complete elimination of moisture before the core is hermetically sealed in the rubber and subjected to the vulcanizing heat and pressure. Nothing in the claim justifies a limitation

as to a particular method or type of drying. Mowry v. Whitney, 14 Wall. 620, 647; Claude Neon Lights, Inc., v. E. Machlett & Son, 27 Fed. (2d) 702.

In appellee's seat there is the rough pubescent surface relied on to bind the core and rubber covering. The double bond of rubber with wood is present in both products. In making the appellee's core the turning tool used cuts across the grain of the wood and this leaves a roughened, open-grained surface, into the roughened, open-grain surface, into the pores of which the plastic rubber is forced and to which it is vulcanized for the integral bond which inseparably joins the surfaces of the inner and outer portions of the seat to each other. The pubescence of the cut wood surface is present in both parties' cores.

**Layers of Thin Rubber.**

Below it was thought that using layers of thin rubber as a binder for the building up of the core was not cementing together the layers of wood veneer as "cemented together" is used in the patent. The patent does not provide, as thought below, for super-kiln-drying for evaporating the solvent of the cement. The specification describes "a thin layer of heat-and-moisture-proof glue or cement." The built-up blank is then "placed in a suitable press and layers of veneer comprising the same are squeezed together under great pressure, so as to secure perfect contact of all the surfaces with the cement." The specification says that after the cement is set the completed blank is again placed in a drying kiln under pressure and so super-kiln dried. But cement is any compound which is plastic under certain conditions and under others develops tenacity and can be used for holding together various materials. (Encyc. Amer. Vol. VI, 168, 27th Ed.). The particular kind of glue or cement was not intended to constitute the patented novelty of the appellant.

The appellee's seat has each of the elements of the claim, i. e., a plurality of cross-grained layers of wood veneer thoroughly dried, a roughened pubescent surface with the layers of wood in the core cemented together. Thus there is an infringement of the teaching of the patent.

Decree reversed.

April, 1929.

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# *Valid Claims for Signal Device*

EX PARTE JOSEPH C. FIELD. APPEAL NO. 172, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1709067 was issued, April 16, 1929, to Joseph C. Field for indicating systems, on Application No. 745187, filed October 22, 1924.

Where the original case did not completely disclose the signaling system claimed by the appellant and the examiner rejected the claims as being drawn to an inoperative disclosure, holding that it did not contain a sufficiently clear statement of the operation of the system whereby the structure of the impulse wheel used in the system might be inferred, it was held on appeal that the claims were allowable as it was believed to be within the skill of the worker in the art to fulfill desired requirements.

The rejection of the four claims in the case was reversed.

Dewitt C. Tanner & John G. Roberts, E. W. Adams and J. C. R. Palmer for applicant.

Before Moore, Assistant Commissioner; Henry and Ruckman, Examiners-in-Chief. The full text of the opinion of the Board of Appeals follows:

This is an appeal from the rejection of all the claims, four in number.

Claim 1 is representative and reads as follows:

"1. In a signaling system, a central station, a substation, means at the substation individual to each condition for transmitting to the central station a code of impulses, a pair of signals at the central station, a polarized relay therefor, a pole changing relay at the central station controlled by said impulses, a source of current at said central station, a selector at said central station actuated by impulses of alternate polarity from said source governed by said pole changing relay to select one of said polarized relays, said polarized relay being responsive to the polarity of the last impulse from the pole changing relay to selectively operate said signals."

The claims have been rejected as being draw to an inoperative disclosure.

The manner in which one of appellant's polarized relays, such as 63, operates in one direction or the other for a single position of the selector 61 is an essen-

tial feature of the alleged invention. The operation described is clearly embodied in appellant's original specification at page 2, lines 7 to 25. The operation of the polarized relay and selector is controlled by a cam or impulse wheel 47, originally shown in the drawing only diagramatically.

The examiner holds the case as orignally filed does not contain either in the drawing or in the specification a disclosure of the specific structure of the impulse wheel necessary for the purpose, nor does it contain a sufficiently clear statement of the operation of the system whereby the structure of the impulse wheel may be inferred.

It appears that the original case did not completely disclose the impulse wheel structure necessary for the purpose, and to remedy the deficiency appellant has presented for approval the addition of a new proposed Fig. 5 to the drawing, with corresponding description, of an impulse wheel so shaped as to send the necessary impulses to cause the selector and polarized relay to operate as orignally described.

However, it is obvious from page 2, lines 19 to 23, that the two halves of the impulse wheel must send the same number of effective stepping impulses to the selector 61, but the series sent by each half must end with a polarity opposite that of the other in view of page 2, lines 21 to 25. Since there must be the same number of impulses in each series to reach the same contact of selector 61, as set forth in lines 19 to 20, it is obvious if the two series are to end with opposite polarities they must begin with opposite polarities.

Accordingly, it is obvious for one half of the wheel a tooth must be provided to secure the necessary reversal between series by sending an impulse, which, however, is not included in the code causing the stepping of the selector to a selected position. The form and location on the impulse wheel of a tooth for that purpose is believed to be within the skill of the worker in the art acquainted with producing impulse wheels for sending impulses to operate known selector systems to fulfill desired stated requirements.

For the reasons stated, it is believed the original disclosure is sufficient to enable a skilled worker in the art to which the invention covered by the claims relates, to practice that invention.

The action of the examiner is reversed.

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## APRIL 30

# *Apparatus for Electrical Control and Misdescription of Claims*

EX PARTE EDGAR E. LITTLEFIELD.. APPEAL NO. 225, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1709083 was issued April 16, 1929, to Edgar Littlefield for electrical controlling apparatus, on application No. 328305, filed October 3, 1919. The appeal was dismissed as to claims 6, 7, 8, 19, 21, 22, and 24, and the examiner's rejection of claims 4, 5, 9, 10, 11, 12, 14, 18, 20, and 23 was affirmed.

It was found that claims 5, 9, 10, 11, 12, 14, 18, 20, and 23 did not properly define the invention because they were drawn to a protective device or system in a transformer whereas the primary purpose of appellant's system is to control the operation of the valve and the protective feature is only incidental.

A rejection of claims 5, 9, 11, 12, 14, 18, 20, and 23 as being misdescriptive for the reason that they stated that a predetermined voltage is maintained in the secondary, whereas it is not apparent that the voltage is maintained constant or given any particular predetermined value, was sustained.

Appellant's use of the word "normally" in claims 9 to 12, 14, and 18 was found to be proper and the rejection on grounds of indefiniteness was not sustained.

Claims 4, 5, 9, 10, 11, 14, 18, 20, and 30 were deemed not to be patentable over a plurality of references which disclosed the various features set forth in the claims.

James T. Newton for applicant.

The opinion of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Ide and Landers) follows in full text:

This is an appeal from the action of the examiner finally rejecting Claims 4 to 12, inclusive, 14, and 18 to 24, inclusive. Claim 4 is illustrative, and is as follows:

"4. An electrical system including a transformer having fixed primary and secondary windings, a translating device located on the primary side of said transformer, energizing means common to said transformer and said translating device, a secondary circuit connected to be fed wholly through said transformer, said circuit functioning when energized to independently cause an actuation of said translating device."

The references relied upon are: Thomson, No. 397616, February 12, 1899; Spencer, 677605, July 2, 1901; Burgess et al., No. 720884, February 17, 1903; Van Swaay et al., No. 1321342, November 11, 1919.

The appeal has been withdrawn as to claims 6, 7, 8, 19, 21, 22, and 24. Accordingly it will be dismissed as to these claims.

Appellant has illustrated in Figures 1, 2, and 3, respectively, three different circuits. The specific claims in the case, however, are drawn to the circuit illustrated in Figure 1. The element 15, which is referred to in the claims on appeal as a translating device, is a magnetically operated valve for controlling the passage of water through the pipe 13.

The coil of this valve is connected in series with the source of current 3 and the primary winding of the transformer 7. Current is therefore continuously supplied to this coil but due to the inductance in the primary winding of the transformer when the circuit for the secondary winding of the transformer is not closed the amount of current in the primary circuit is not sufficient to cause the valve to be opened. When the secondary circuit is manually closed the inductance in the primary winding of the transformer is supposed to be diminished to such an extent that there will be sufficient current in the primary circuit to cause the valve to open.

**Drawn to Protective System.**

Several of the claims have been rejected as being indefinite or misdescriptive in various particulars which have been pointed out in the examiner's statement. Appellant proposes to amend claims 4, 5, 10, 11, 12, 14, and 18 in such manner as to overcome some of these rejections. As to the others, however, he takes issue with the examiner.

Claims 5, 9, 10, 11, 12, 14, 18, 20, and 23 were rejected as not clearly defining the invention because they are drawn to a protective system. Appellant points out that in this system a low secondary voltage is supplied by the transformer and therefore the danger of shocks incident to a high voltage has been eliminated. It is generally true of electrical systems that they are so constructed as to be rendered as safe as possible in use. Since the primary purpose of appellant's system is to control the operation of the valve and the so-called protective feature is only incidental we agree with the examiner that it is not proper to designate the device as a protective system.

Claims 5, 9, 11, 12, 14, 18, 20 and 23 were rejected on the ground that they are misdescriptive in stating that a predetermined voltage is maintained in the secondary. Appellant urges that he always has a low safe voltage in the secondary. It is not apparent, however, that the voltage is maintained constant or given any particular predetermined value. We believe the rejection of these claims to be well taken.

Claims 9 to 12, inclusive, 14 and 18 were rejected as being indefinite in the use of the word "normally." It is believed the word is not improperly used and that the claims are readily understood when read in the light of appellant's disclosure.

As to the references, the patents to Van Swaay et al. and Thomson are deemed the most pertinent. We believe claim 4 to be clearly unpatentable over Van Swaay et al. taken in connection with Thomson. The former shows a tarnsformer 2 having fixed primary and secondary windings 3 and 4, respectively, a translating device 18 located on the primary side of the transformer 3, energizing means common to said transformer and said translating device, and a secondary circuit connected to be fed wholly through the transformer 2.

This circuit functions when energized by closing the switch 14, 15 to decrease the inductance in the primary coil and as a result cause increased flow of current through this coil and the translating device. Thomson's transformer is provided with primary and secondary windings C and S, respectively, which are movable with respect to each other. Otherwise, however, the claim reads on his device, which has a translating device L in the primary circuit and a switch W in the secondary circuit which is manually opened and closed for the purpose of increasing or decreasing the inductance in the primary winding C, and as a result varying the amount of current in the primary circuit. The operation of this switch is described in line 77

et seq., page 1 of the patent. Attention is especially called to line 81 et seq., reading as follows: "* * * the effect of coil C is further enhanced in dimming the lights or in exerting a self-induction, which checks the current in any device with which the apparatus may be put in circuit."

It is, therefore, quite apparent that there would be no invention in using some other form of translating device as a relay or a magnet in lieu of Thomson's lamps L and in utilizing the difference in current for the purpose of controlling the operation or actuation of the translating device. In view of the Thomson disclosure we believe there would be no invention in the provision of manual means for closing the secondary circuit of the transformer 2 in the patent to Van Swaay et al.

Claims 5, 9, 10, 11, 14, 18, 20 and 23 are deemed unpatentable over the patent to Van Swaay et al., taken in connection with the patent to Thomson, for the reasons stated in the discussion of claim 4. Furthermore, the claims of this group are deemed unpatentable over Thomson, taken alone, since they do not require the primary and secondary windings to be fixed with respect to each other.

We approve the proposed amendments to claims 4, 5, 10, 11, 12, 14 and 18 in the event appeal is taken from this decision.

The appeal is dismissed as to claims 6, 7, 8, 19, 21, 22 and 24.

The decision of the examiner is affirmed as to claims 4, 5, 9, 10, 11, 12, 14, 18, 20 and 23.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

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# *Expansion Joints for Paving Uses*

EX PARTE LESLIE M. SWOPE AND JOHN C. ZULAUF. APPEAL NO. 411, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1709692 was issued April 16, 1929, to Leslie M. Swope and John C. Zulauf for expansion joint boards, on Application No. 728901, filed July 29, 1924.

Appellants' preformed bituminous expansion joint strip reinforced relatively thin side-surfacing sheets of asbestos, to be used as an expansion joint between bodies of paving, was found to be unpatentable over a prior patent disclosing such a joint consisting of an asphaltic composition provided with side-surfacing sheets of elastic fibrous felt, it being stated that there is nothing inventive involved in substituting for the relatively thin side-surfacing sheets "of elastic fibrous material, such as felt" sheets of material well known to possess the properties desired by applicant.

**Rejection of Two Claims.**

The rejection of claims 3 and 4 was affirmed.

Howson and Howson for applicants.

Before Moore, Assistant Commissioner; Skinner and Ide, examiners-in-chief. The full text of the Board's decision follows:

This is an appeal from the decision of the primary examiner finally rejecting the following claims:

"3. As an article of manufacture, an expansion joint strip comprising a body of relatively thick cross-section of asphalt or suitable bituminous material, having relatively thin side-surfacing sheets of asbestos.

"4. A preformed bituminous expansion joint strip reinforced by relatively thin side-surfacing sheets of asbestos."

The references relied upon by the examiner are: Hassam, 1365687, January 18, 1921; Fischer, 1503942, August 5, 1924; Riehle, (Re.) 15840, May 13, 1924; and an article entitled "Felted Fabrics" on page 386 of Abraham's "Asphalts and Allied Substances," and a dictionary definition of the term "felt," as follows: (3) a thick fabric made of asbestos by weaving or other process."

The invention relates to a preformed strip to be laid between bodies of paving to permit the bodies to expand.

The construction needs no further explanation than that stated in the claims.

The patent to Riehle shows an expansion joint strip formed of a body 8 of elastic and adhesive material and layers 9 of an elastic and protective material disposed on opposite sides thereof.

The body 8 may be composed of a substantially pure asphaltic bitumen and finely divided particles of infusorial earth, combined in proper proportions to form a mass sufficiently rigid or solid to maintain its shape and sufficiently plastic and flexible so as to spread under pressure and to permit the filler to readily conform to the shape of a joint. The patent of Riehle says:

"The layers 9 are preferably made of a suitable elastic, fibrous material, such as felt."

The patent to Hassam shows strips of asbestos extending through the composition 4 of the paving to "divide it into separate rectangular blocks which, when the composition has become hardened, form rectangular monolithic blocks." On page 2, lines 67-77, Hassam says:

"The strips of asbestos felt may be omitted and a felt strip saturated with asphalt be substituted, or wooden partitions can be employed which may be removed and the space filled with a moisture resisting material. The material of the strips is not important so long as they perform the function of separating the plastic material used in the pavement into blocks of limited area which can be removed and replaced after the pavement has become set."

The patent to Fischer "relates to improvements in means permitting expansion and compensating for contraction of street paving." Fischer's specification, page 1, lines 59-78, says:

"My invention consists in using an insulating material, such as mineral fibre, asbestic fibre, or the like, which is proof against street acids and rotting processes, saturated in a waxy or paraffinous waterproofing compound and thoroughly compressed in to a block-like structure, preferably wedge shaped with the base of the wedge at the bottom of the strip, the upper part of the strip or slab being further immersed in an asphaltic waterproofing compound which gives it a solid but pliant consistency for several inches downward from the top of the joint, leaving the base light in weight and composed only of the fibres coated and compressed with a waterproofing material, which is light in structure and yields by compression to pressure from below instead of rising out of its seat, and thus remains in place under the adverse conditions of use."

The patent to Riehle discloses a preformed expansion joint strip of asphalt of relatively thick cross-section having relatively thin side-surfacing sheets of elastic fibrous felt.

### Lack of Invention.

Applicants find the use of "elastic fibrous felt" such as used by Riehle to be objectionable due to the properties of the felt. Felt is liable to absorb and retain moisture and become rotten.

We think there is nothing inventive involved in substituting for the relatively thin side-surfacing sheets "of elastic fibrous material, such as felt" sheets of material well known to possess the properties desired by applicant.

The properties of asbestos were not only well known generally but they had been recognized in the paving art, as a separator strip in the patent to Hassam and as an elastic and expansible joint filler, in the patent to Fischer.

The decision of the examiner is affirmed.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

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# *Process for Cellulose Products*

EX PARTE HARRY P. BASSETT AND THOMAS F. BANIGAN. APPEAL NO. 106, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1709513 was issued April 16, 1929, to Harry P. Bassett and Thomas F. Banigan for processes of forming cellulose products, on application No. 5638393, filed May 11, 1923.

Claims 1 to 3, directed to a process for forming cellulose products which may be used in the manufacture of artificial silk, were held to be unpatentable over a basis reference disclosing appellants' process but including a purification step which appellant did not employ, taken in connection with a teaching reference which indicated that it was usual to omit such step.

Claims 3 and 4, limited to the steps of bringing the acetylizing solution containing acetyl-nitro-cellulose to a point just above the precipitation point of the acetyl-nitro-cellulose and then finishing or spinning, were found to be patentable and the examiner's rejection was reversed.

C. L. Parker for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Henry and Ruckman) follows:

This is an appeal from a final rejection of all claims of the application, five in number. Claims 2 and 3 are reproduced for illustrative purposes:

"2. The process of forming cellulose products which comprises bringing an acetylizing solution containing acetyl-nitro-cellulose to a workable consistency

and then spinning the acetyl-nitro-cellulose without removing it from the solution.

"3. The process of forming cellulose products which comprises bringing an acetylizing solution containing acetyl-nitro-cellulose to a point just above the precipitating point of the acetyl-nitro-cellulose, and then submitting it to a finishing step to produce a desired product."

The references relied upon are: Lederer, 1028748, June 4, 1912; Knoll & Co., Ger., 274260, May 14, 1914; Swiss patent, 90874, October 1, 1921.

Appellants are claiming a process of forming cellulose products which may be artificial silk. The prior art is quite close to the process claimed in the appealed claims. Thus the Lederer U. S. patent selected by the examiner as a basic reference in the rejection of the appealed claims employs the same starting material that appellants employ, i. e. acetyl-nitro-cellulose, purifies it and then spins it into thread which may be used in the manufacture of artificial silk. In its broader aspects appellants' process differs from the process of the Lederer patent in that appellants do not employ a purification step but when the acetyl-nitro-cellulose has ben brought to a workable consistency it is converted into threads without removing it from its solution.

It is the view of the examiner that the omission of the purification step is obvious and uninventive. The examiner urges that whether the purification step be employed or not depends largely on the presence or absence of impurities in the starting material. The examiner points out further that the German patent and the Swiss patent relied on in this appeal show that it is not new to convert cellulose compounds into thread or similar material without purification of the starting material.

In the German patent cellulose acetate may be regarded as the starting material and there is a suggestion in the patent that the material is converted into thread without any purification. Appellants argue that since cellulose acetate, employed in the German patent, is not the same as the acetyl-nitro-cellulose employed in their process the reactions would not be the same and the German patent would not teach the modification of the Lederer process to meet certain of the appealed claims.

We are impressed by this argument. It is our view that the starting material of the German patent is sufficiently analogous to the material employed by appellants to justify a holding that the German patent is good as a teaching reference.

**Broad Nature of Claim.**

Appealed claim 1 is so broadly drawn that it does not distinguish from the Lederer patent or for that matter from what appellants admit to be prior art procedure. There is nothing in this claim which excludes a purification step. Claims 2 and 5 are held to be lacking in invention over the combination of the Lederer U. S. patent and the German patent. As pointed out above the German patent would teach the omission of the purification step of the Lederer patent.

Claims 3 and 4 are limited to the steps of bringing the actelylizing solution containing acetyl-nitro-cellulose to a point just above the precipitation point of the acetyl-nitro-cellulose and then finishing or spinning. The examiner has not cited any prior art showing this feature but says that it is obvious. In the absence of prior art we are not convinced that the limitations just discussed are obvious or uninventive. As claims 3 and 4 are presented to us they should be allowed.

The decision of the examiner is affirmed as to claims 1, 2 and 5 and reversed as to claims 3 and 4.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

## MAY 1

# *Method for Forming Bearings*

AMERICAN BEARING CORPORATION, APPELLANT, V. MILWAUKEE DIE CASTING COMPANY. No. 4085, CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

IN its defenses of prior use, noninfringement and lack of invention against the suit for infringement of Patent No. 1302584, for a method of forming bearings, the defendant prevailed, the decision of the District Court being affirmed.

Regarding the question of lack of invention, the Court found the product itself was old and that patentee's claim

for novelty resided in a time element, in his contention that he applied the babbitt metal to the bronze bearing very rapidly, within a period of about three seconds after the application of a tin coating thereto, so as to prevent oxidization of the tin, but that the specification did not support this contention.

The defendant was relieved from a charge of infringement in view of the evidence which indicated that about 15 to 18 seconds were required in its process to apply the babbitt to the tin-coated bronze bearing.

### Case of Public Use.

The decision of the District Court holding that the evidence submitted made out a case of public use of the method by the International Harvester Company was not disturbed.

Appeal from the District Court for the Eastern District of Wisconsin.

Before Alschuler, Page and Anderson, circuit judges. The full text of the opinion of the court, delivered by Judge Page, follows:

Appellant charged infringement of the first eight claims of Olsen Patent No. 1302584, issued May 6, 1919, for method of forming bearings. The defenses were prior use, noninfringement and lack of invention, and defendant prevailed.

The method, so far as here important, is quite simple. A metal shell is immersed in a bath of molten soldering tin. After the tin is wiped from the outside of the shell, it is placed in a machine, on a base plate that closes one end of the shell. Molten babbitt metal is poured into the shell, which is then rotated so that the molten metal, being thrown outwardly and upwardly, forms a lining on the inside of the shell. Further processes are not important.

It was developed, and admitted on oral argument, that the centrifugal casting of a babbitt metal lining upon bronze or other metal, with the soldering tin between, is old, but it is claimed that Olsen discovered that the only way to secure a perfect union or bonding between the metal backing and the metal lining was by introducing the babbitt metal into the shell and starting the coating process before oxidation of the soldering tin begins, which time Olsen fixed at five, six or ten seconds after removal of the shell from the molten tin bath.

If it is to be conceded that that was Olsen's discovery and was the basis for his very excellent results, there yet remains a very grave question as to whether that necessary step in his method is in any way disclosed or claimed in his patent. The specification says:

"The object of the invention is to provide a method whereby a bearing composed of babbitt metal or similar metal and a backing of bronze or other metal may be produced with great rapidity and in which the lining is of uniform density and the two metals are integrally and firmly united by a tight bond with uniform adherence throughout their entire surface."

Speaking of the shell, the specification says:

"It is then treated with a suitable acid and dipped in a tank of solder or molten tin so as to completely cover the same, both interiorly and exteriorly, and thereby provide a more effective adhering surface for the babbitt metal which is to be applied thereto. The shell is then wiped on the exterior to remove excess solder and preserve the shell and its coating substantially concentric."

And, again:

"After the coated shell has been clamped onto the machine the driving mechanism of the latter is connected so as to rotate the carrier, * * * and then the molten babbitt metal is poured into the shell * * *. In the rotation of the machine, the babbitt metal will be thrown by centrifugal force against the inner surface of the bronze shell and will effectively cover the entire surface thereof and form a lining, the close coalescence or adherence of which to the surface of the casting will be uniform throughout."

### Rapidity of Method.

And, further, it is said:

"The present method also enables stock to be turned out with great rapidity."

Although the words "great rapidity" are used twice, their use does not seem to be even remotely connected with or have any relation to the time element between the withdrawing of the shell from the solder tank and the introduction of the babbitt metal into the shell. The following from the specification is the only language that seems to have any relation to rapidity of production, viz.—

"On the shaft is mounted a brake member 18 which may be manipulated in any suitable manner for the purpose of checking the momentum of the shaft and bringing the parts to a quick stop when the power is thrown off."

The only reference to the handling of the shell in and out of the soldering tank, and into the machine, and the introduction of the babbitt metal therein,

in no way indicates a quick succession of steps, and there is not the slightest intimation that the lapse of time between the removal of the shell from the bath and the introduction of the babbitt metal is of any importance whatever, or in any way differs in time from any other step.

It seems not possible for appellant to claim, or for the Court to hold, that the element of speed in question is covered by the patent.

If it should be conceded that the speed element is covered by the patent, there is the question of infringement.

Olsen testified for plaintiff:

"It is absolutely necessary to consume the least time possible in the interval of time between the taking of the bushing out of the tin bath and placing it in the machine and casting the metal into it; * * * because in the time that is lost there accumulates a film of oxide over the tin which makes it impossible for the molten babbitt to make a perfect union between the liner and the bronze."

**Question of Infringement.**

He said the maximum time allowed should not exceed three seconds from the time the tinned bronze shell was lifted out of the tin bath, placed into the machine, and the babbitt poured into it. He also fixed the time within which dangerous oxidation occurs as the fourth, fifth or sixth second. The evidence shows a lapse of 25 seconds between the removal from the solder bath and the introduction of the babbitt metal in defendant's practice. The steps detailed on cross-examination indicate that probably that much time was consumed. That would be 15 to 18 seconds after dangerous oxidation would occur, and 22 seconds after the maximum time fixed by Olsen. Obviously, plaintiff could have no protection against a practice that occupied a time far beyond the time of dangerous oxidation. Such a practice could not have infringed.

There was evidence concerning a use by the International Harvester Company by witnesses that appeared before the District Court, and from which the District Court, was convinced that a prior use had been established. We see no reason, from an examination of the evidence, to disagree with the conclusion of the District Court thereon.

The decree of the District Court should be, and is, affirmed.

April 8, 1929.

## MAY 2

# *Different Purposes and Uses of Hand-operated Can Openers*

STAR CAN OPENER COMPANY, PLAINTIFF, v. BUNKER-CLANCEY MANUFACTURING COMPANY, C. A. BUNKER AND JAMES A. CLANCEY. IN EQUITY NO. 924, DISTRICT COURT FOR THE WESTERN DISTRICT OF MISSOURI.

PATENT No. 1360256 for a hand-operated can opener designed to remove the tops from tin cans containing foodstuffs was held not to be infringed.

The court concluded that defendant's device, which was so designed that it could be successfully used only to cut out the top of a can in much the same manner as the prior art devices were used, did not come within the terms of plaintiff's claims since the patent apparatus depended for validity upon those features which adapted it to perform a different function, to remove the tops of cans by cutting through the wall of the can below the flange of the top.

The full text of the opinion of the court, delivered by Judge Otis, follows:

The plaintiff seeks an injunction and other relief on account of the alleged infringement by the defendants of a patent issued November 30, 1920, to one Edwin Anderson and by him assigned to the plaintiff. The patent office number of the invention in question is 1360256. The contrivance patented is a hand-operated utensil designed to remove the tops from tin cans containing foodstuffs. In its bill of complaint the Star Can Opener Company, the plaintiff, alleges that the defendants are and have been infringing this patent and have manufactured and sold large quantities of the infringing can opener. The bill of complaint alleged infringement of two patents, No. 1528178, in addition to that before mentioned, but as to this last-numbered patent the bill was dismissed at the trial of

the case. The bill was also dismissed as to James A. Clancey, one of the three defendants originally joined in the case.

In the answer defendants set up two defenses and upon the trial introduced evidence for the purpose of proving both: first, that the article manufactured by the defendant Bunker-Clancey Manufacturing Company did not infringe plaintiff's patent, and second, that plaintiff's patent was not valid because it contained nothing not already known and in use in the prior art more than two years before the issuance of plaintiff's patent.

The commercial embodiment of plaintiff's patent is a contrivance simple in appearance, although impossible of adequate description in words unaccompanied by models and drawings, a contrivance designed and sold chiefly for one purpose, to-wit, removing the tops of cans by cutting through the wall of the can below the flange of the top. It cannot be used for cutting out the top of a can and is not designed for such use. The alleged infringing article manufactured and sold by the defendants is a utensil also simple in appearance but equally difficult of adequate verbal description. It is designed for the purpose of cutting out the top of a can as distinguished from cutting off the top of the can from the wall of the can below the flange. It is possible also to use defendants' utensil for cutting off the top of at least some cans through the wall of the can and below the flange thereof, but it can not be well used for that purpose and can be so used only by the exertion of considerable physical force. The conclusion is inescapable from the evidence and inspection of the two utensils and demonstrations of the manner of their use that the plaintiff's tool is designed and can be used successfully only for cutting off the tops of cans and defendants' tool only for cutting out the tops of cans. Directions issued by the plaintiff with its utensil restrict its use as here indicated and the directions issued by the defendant, Bunker-Clancey Manufacturing Company, with its utensil similarly restrict its use to the purpose here indicated. The inadaptability of one utensil to the use of the other is due to differences in their construction which, although not strikingly apparent on casual inspection, are easily noticeable when pointed out by an expert in mechanics.

It is important to determine what it is in plaintiff's patent that was new and novel and therefore capable of being patented and then to determine whether defendants' utensil utilizes these new and novel and patentable features. If defendants' utensil utilizes only features that were already known and used and upon which plaintiff could not lawfully receive a patent, then there is no infringement, whatever may be the outward and seeming resemblance of the two utensils.

**Earlier Types of Openers.**

There was introduced in evidence by the defendants numerous American and foreign patents of can openers of earlier dates than plaintiff's patent. Some of these earlier types of can openers were bench operated and some were in the form of hand tools. The evidence was conflicting as to whether certain of these earlier can openers were operative. My conclusion from this conflicting testimony is that at least certain of the earlier forms, especially the Wolfer patent and the Weigel (a German) patent, were practical and operative utensils. Both of these last-named utensils, however, were, like the defendants' device, designed solely to cut out the top of a can. The principles employed in those patents were essentially those used in the defendants' device. I think it is to be doubted that plaintiff's patent is valid except to the extent that it incorporates new and additional principles to those already well known and used in can-opening devices.

It was shown in evidence that a number of can-opening devices had been held to be infringements of plaintiff's patent by various district courts in the United States. These can-opening devices were introduced in evidence in the case. Most, if not all of them, like plaintiff's device, were designed to cut off the entire top of the can and not to cut out the top of the can. Whether it was on that account that it was held by the district courts referred to that they infringed the plaintiff's patent did not appear, since there were no opinions of these district courts offered showing the reasoning supporting the decrees. One case, however, involving the plaintiff's device and alleged infringement thereof, has been decided by the Circuit Court of Appeals of the Second Circuit and another by the Circuit Court of Appeals of the Seventh Circuit. A consideration of these cases will be helpful here.

The case of Star Can Opener Company v. Owen Dyneto Company, decided by the Circuit Court of Appeals for the Second Circuit, December 24, 1926 (16

Fed. (2d) 353) was an appeal from the District Court of the United States for the Northern District of New York, affirming a decision of that court holding that the defendant in that case had infringed the plaintiff's patent. The defense there, as here, was non-infringement and invalidity of the patent. Apparently there was no showing in that case that the alleged infringing article was designed and could be successfully used only to cut out the top of a can. The only distinction between the two utensils involved in the case was that the alleged infringing device had a somewhat different arrangement of the levers from the patented article. That distinction was held immaterial. The chief insistence of the defendant was based on the prior art. As to that, and particularly as to the wolfers and Weigel patents, the Court of Appeals said:

**Effect Familiar Result.**

"Of these patents we first note * * * that both were not devices for removing the whole top by severing the wall of a can, but of cutting out the cover to effect the result familiar in many forms of hand can openers in current use. The Wolfer patent distinctly says that its 'rotary cutter smoothly cuts out the cover in a complete circle. A can so opened can be used again after suitably flanging over the upper edge, as no bends of any kind are formed in the cutting.' The Weigel patent, in the translation in evidence, declares as its result 'that the knife is guided along the border of the can and that the cover of the latter is thus cut out.' A study of the diagrams attached to these patents confirms the disclosure statement.

"Whether a disc cutter driven by a knurled roller in a circular path near the periphery of a can cover would ever be mechanically successful may perhaps be doubted. But there are in evidence here (and wholly without contradiction) embodiments of the devices revealed and described by the Weigel and Wolfer patents, and we are satisfied by this evidence that both patents are inoperative. In the light of this evidence we do not think it necessary to consider whether it was 'merely a matter of the positioning of the cutter,' and therefore involving no invention, to change the combination of advancing roller and cutting disc calculated to 'cut out' the top of a can, into a combination capable of cutting off the whole top including the flange. An inoperative patent seldom gives to the public anything beyond its own inoperativeness, and these patents are no exception to the rule."

It appears from this quotation that the Court of Appeals for the Second Circuit distinguished the Wolfer and the Weigel patents from the plaintiff's patent by the fact that the earlier patents were designed to cut out the top of a can, whereas the plaintiff's patent was designed to cut off the top of a can; and it appears also that the Circuit Court of Appeals held that in any event the Wolfer and Weigel patents were inoperative, this latter finding being based upon the evidence in that case.

The case of Star Can Opener Company v. Ace Manufacturing Company et al. was decided by the Circuit Court of Appeals for the Seventh Circuit December 13 ,1927 (22 Fed. (2d) 977), reversing a decision of the District Court of the United States for the Northern District of Illinois, holding the plaintiff's patent invalid as having been anticipated by the Wolfer and Weigel patents. As to this holding the Court of Appeals said:

"The extent to which the Wolfer and Weigel patents anticipated or restricted the field for Anderson depends somewhat upon our construction of language of the claims and the disclosures of the specifications and drawings of these two patents. They were, we think, intended to cover a can opener that cut down through the lid of the can. Basing our conclusion upon an examination of the two patents, as well as the demonstrations in open court, we conclude that:

"(a) Neither intended to describe an implement that would cut through the wall of the can.

"(b) Neither implement, constructed according to the disclosures of either patent, could be made to satisfactorily cut through the wall of the can.

"(c) Anderson's implement was not anticipated by the prior art.

"Whether the novelty representing Anderson's advance over the citations of prior art was more than mere mechanical skill presents a different question. Upon the entire record, we conclude that it does."

**Non-infringement of Patent.**

It appears from this quotation that the Circuit Court of Appeals for the Seventh Circuit held that the plaintiff's patent was valid, notwithstanding the earlier Wolfer and Weigel patents, because those earlier patents were of utensils designed to cut out the top of a can and not to

cut off the top of a can and that the novelty in plaintiff's patent making it valid was its adaptability to this entirely different use and purpose.

It should be added in connection with this last mentioned case that it was shown in evidence in the present case that the alleged infringing can opener manufactured by the Ace Manufacturing Company was designed, like plaintiff's device, to cut off the top of the can.

It is in line with these decisions of the Court of Appeals for the Second and Seventh Circuits to hold, as I do hold, that the defendant's device here, which was designed and could successfully be used only to cut out the top of a can very much after the manner and in accordance with the principles involved in the Wolfer and Weigel patents, does not infringe the plaintiff's patent, the validity of which depends upon those features which adapt it to an entirely different purpose and use. Plaintiff's bill is dismissed.

April, 1929.

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# *Anticipation in Air Cooling For Artificial Refrigeration*

FRIGIDAIRE CORPORATION, PLAINTIFF, v. GENERAL NECESSITIES CORPORATION. IN EQUITY, NO. 1611, DISTRICT COURT FOR THE EASTERN DISTRICT OF MICHIGAN.

CLAIMS 10, 15, 16 and 18 of patent No. 1337175 for a refrigerating apparatus were held invalid as being anticipated by the prior art.

The decision states that the fundamental principle of patentee's apparatus comprises the use of a refrigerating coil, a condensing coil and a compressor which draws gases from the refrigerating coil and compresses them, after which they are cooled to form a liquid in the condensing coil; and the feature upon which reliance was placed to distinguish the apparatus from the prior art was that of cooling the condenser coil by air rather than by passing water over the coils. It was found that air cooling was old per se and old in the combination, in the prior art.

### Intention of Disclaimers.

A disclaimer, entered in claims 10 and 15, specifying that ⅜-inch copper tubing or copper tubing of less than ½ inch in diameter be used, a specification which had not been presented and considered during prosecution in the Patent Office, the Court intimated was proper, and explained that disclaimers were intended to save only the things which were contemplated by the broader claims; that is, where the patentee indicated a desire to claim a certain feature and the Patent Office had intended to give him a patent covering that feature, but the claims as issued were broad enough to cover more than that feature or thing. But in accordance with the decisions in the circuit court regarding disclaimers, the disclaimer in this instance was held proper.

Cooper, Kerr & Dunham, by Drury W. Cooper and Thomas J. Byrne, of New York City, and Harry W. Lindsey, Jr., of Chicago, Ill., attorneys for plaintiff; Swan & Frye, by George Rex Frye, of Detroit, Mich., attorneys for defendant.

The full text of the opinion of the court, delivered by Judge Tuttle, follows:

This case originally involved seven patents, but each of them has been withdrawn without prejuduce, with the exception of the patent to Wolf, No. 1337175 of April 13, 1920, the application for which was filed December 23, 1913. Claims 10, 15, 16, and 18 are alleged to be infringed.

The patent relates to the subject of artificial refrigeration. The fundamental principle of refrigeration which is described in the patent is admitted by both parties to be old. This fundamental principle comprises the use of a refrigerating coil, a condensing coil and a compressor which draws gases from the refrigerating coil and compresses them, after which they are cooled to form a liquid in the condensing coil. It was usual in such systems to employ an expansion valve between the refrigerating coil and condensing coil for the purpose of releasing refrigerant into the refrigerating coil and it was, of course, also customary to provide some motive power for driving the compressor. Various kinds of refrigerants were used in these systems, such refrigerants having the characteristics of changing from liquid to gas when subjected to approximately atmospheric pressure, and from gas to liquid when highly compressed

and cooled. It was customary to compress these refrigerating gases to a pressure the corresponding boiling point of which was above the temperature of the atmosphere.

This general principle was in use for many years in the making of ice and in cooling rooms and large refrigerator boxes in hotels as well as in refrigerator cars.

These larger systems were followed by smaller ones which could be used in the home. Such smaller systems were constructed and described prior to any date which can be claimed for the patent in suit, and if there was any bridge to cross in making the smaller machines, for househould use, Wolf was not the first to cross it.

### Definition of Scope of Claims.

The thing which is attempted to be covered by the claims in suit is the cooling of the condenser coil by air, as distinguished from cooling by passing water over the coils, as was practiced to a great extent prior to the patentee's date. Plaintiff has, by disclaimer, limited the broader of the claims in suit, namely, claims 10 and 15, to a condenser coil made of ⅝-inch copper tubing (claim 10) or to a metal tubing of not more than ½-inch size (claim 15.)

The claims in suit, as allowed by the Patent Office, were as follows:

"10. A refrigerating apparatus comprising in combination, means to compress a refrigerating gas to a pressure the corresponding boiling point of which is above the temperature of the atmosphere, an atmospherically cooled condenser for condensing the compressed gas, and an expansion chamber into which the liquid is expanded, said parts being connected to form a closed circuit for the refrigerant.

"15. A refrigerating apparatus including in combination, a compressor, an air-cooled condenser, and an expansion chamber, said parts being connected to form a closed circuit for the refrigerating agent, and a fan mounted to effect a circulation of air around the condenser and against the compressor.

"16. A refrigerating apparatus including in combination, a compressor, an air-cooled condenser, and an expansion chamber, said parts being connected to form a closed circuit for the refrigerating agent, a motor having a shaft connected to the compressor to drive the same, and a fan mounted to effect a circulation of air around the condenser also driven by said motor.

"18. A refrigerating apparatus including in combination, a compresssor, atmospherically cooled condenser means, an expansion chamber, a motor to drive said compressor, and a fan mounted to rotate about an axis parallel to the motor and driven thereby to effect a circulation of air around the said means."

After filing of the bill in this suit, during pendency of the case, a disclaimer as to claims 10 and 15 was made by plaintiff, which disclaimer read as follows:

"Your petitioner, therefore, hereby does disclaim from the scope of said Claim 10 all refrigerating apparatus which does not have an atmospherically cooled condenser for condensing the compressed gas composed of a considerable length of tubing made of copper of about ⅜ of an inch diameter and having a comparatively thin wall; and does disclaim from the scope of said claim 15 all refrigerating apparatus which does not have an air-cooled condenser composed of a considerable length of metal tubing of not more than ½ of an inch diameter and having a comparatively thin wall."

### Question of Infringement.

Taking up first the question of infringement, I have no difficulty in finding that any fair interpretation of the claims in suit finds response in defendant's construction. I hold, therefore, that defendant's construction does infringe the claims in suit.

Defendant has raised a question of double patenting because of a disclosure in another patent to Wolf, but here I again hold with plaintiff, as I do not find a condition warranting a holding of double patenting.

Defendant also questions the right of plaintiff to enter the disclaimer which it has entered with respect to claims 10 and 15. In accordance with the rule which has been established in this circuit in the case of Permutit Company v. Wadham, 13 F. (2d), 454, and in Michigan Carton Company v. Sutherland Paper Company, 29 (2d) 179, I hold that plaintiff was entitled to make the disclaimer. In connection with that holding, however, I point out certain dangers, which do not appear to have been present in the previous cases considered in this circuit, on the subject of disclaimers. I realize my duty is to follow the rulings established in this circuit—and I cheerfully do so—but I feel I should, with modesty and respect, point out some dan-

gers which are brought to light in this case.

My original thought with respect to disclaimers was that they were intended to save only the things which were contemplated by the broader claims. That is to say, if a patentee had indicated a desire to patent a certain thing or feature, and the Patent Office had intended to give him a patent covering that thing or feature, but the claims as issued had actually been broad enough to cover more than that feature or thing, it was my thought that by disclaimer the patentee could limit his claims so that they did not cover more than he had intended.

The patentee, Wolf, at no time asked for claims covering ⅜-inch copper tubing or copper tubing of less than ½ inch in diameter; there is no evidence or indication that he ever urged any novelty or particular advantage in the use of that size tubing and, therefore, the question of whether or not it was new to use such tubing or whether it was useful or patentable was never brought to the attention of the Patent Office and, therefore, was never passed upon by the Patent Office. The only foundation for the disclaimer is a statement in Wolf's specification that he preferred to use copper tubing of that size. Statements of that kind in patent specifications are common. In patenting a wooden wheel one might say that he preferred to use a certain kind of timber, but that statement, used in the specification of the patent, would not ordinarily lead one to believe that any claim of patentable novelty was made with respect to the use of that particular kind of wood.

Plaintiff has taken this statement in the specification as a basis for the disclaimer with the result that claims 10 and 15 are brought before this Court with the presumption of validity which all claims carry, but without the particular sizes and kind of tubing to which the claims are now limited having ever been passed upon, from the standpoint of novelty and utility, either in substance or in terms, by the Patent Office. The Patent Office never had an opportunity of determining whether or not it was new or patentable to use tubing of that type. It is much more difficult at this date—fifteen years after the application for patent was filed and nine years after the patent was granted—to determine the question of novelty or patentable invention in a thing that has to do with the kind and size of metal used in the condenser coil.

Another danger in permitting disclaimers such as this one is that of imposing a hardship upon one who, in good faith, interpreted the claims as issued to be invalid. It requires some stretch of the imagination to foresee the entry of a disclaimer limiting the claims to a feature such as the size and material of the tubing used and to enjoin one from continuing in business because he did not foresee that possibility is likely to be inequitable. If stress or importance had been placed upon that feature during prosecution of the application, the patentee might be expected to so disclaim, but such is not the case here.

As I have already stated, I gladly follow the holdings of this circuit and treat the disclaimer with respect to claims 10 and 15 as a perfectly good and proper one, but I make these remarks because it seems to me that the dangers are such that it is well for the courts to construe the statute with respect to disclaimers in a limited way rather than to give the same a very broad interpretation.

We come then to a consideration of the validity of the claims in suit. Defendant has introduced five patents which appeal to me as disclosing the invention of the claims in suit. These patents are Nos. 463036 to Leslie; 716091 to Palmer; Re-issue 4992 to Martin and Beath; 328784 to Johnson; and 898400 to Audiffren.

Some of these patents read better upon certain claims than do others, but all of them disclose generally the invention attempted to be covered by the patent in suit.

The claims in suit read on the patent to Leslie without difficulty and without putting any strained construction thereon. Some of the claims in suit carry the limitation of a fan for forcing air over the condenser coil and Leslie unquestionably has that feature.

The patent to Palmer, No. 716091, is the best reference as concerns proof before the Court on the subject of its construction having been put into actual use. Mr. Palmer testified in open court and told of the building of something like ten freight cars in which the device of his patent was used. It is true that the device did not go into extensive use, but there were reasons for the failure to put them into such use. There was the factor of the lack of capital, organizations opposing the device and the fact that the device did not run when the car was stopped. The whole proposi-

tion of changing from using ice for refrigeration has been a slow process for many reasons. I suppose with freight cars, much the same as in kitchens, the railroad equipment was built for refrigerating with ice, and one could hardly expect them to go gradually into artificial refrigeration. They would either wholly adopt the new idea or not at all.

Railroads do things that way. There is no evidence that the Palmer device was inoperative or unsatisfactory. In fact, Mr. Palmer testified that his devices were satisfactorily operated. He made an operative, useful and good device which operated the way he claimed it would operate and which air cooled the condenser coil in the same general way as Wolf did.

### Value of Prior References.

I believe the most valuable of these five prior references, in so far as what it taught the world was concerned, was Martin and Beath, Reissue No. 4992. Martin and Beath not only taught that the condenser might be air cooled, but taught also that the most advantageous movement of refrigerant gas through the congealer and condenser was not in excess of 16 feet per second, and that seems to be the rate of movement generally accepted today. It seems to me that, being informed as to the rate of movement desired, it became a simple, mechanic's job to decide the size of the condenser tubing to be used when considering the size of the machine employed. There are some things about the Martin and Beath disclosure which make a little more difficult the reading of the claims in suit upon it, but I really believe that Martin and Beath is the reference which contains the most worth-while information, and I think it alone is enough to defeat the patent to Wolf.

I have not the idea that Martin and Beath or the other anticipating patents, or Wolf, tell how to build a complete refrigerating mechanism which would be commercially satisfactory today without the work of skilled mechanics in that field. It is a sort of thing that, if all of the figures and drawings which have been collected over the years were destroyed and a man was sent out to produce a marketable device, would cause him no difficulty in making an operable machine, but he would probably make several machines and several drawings and tests before it would be in final or marketable form. I feel that he would have no particular difficulty in working the thing out from the teachings of the art. At least, he would have no difficulty in cooling the condenser coil, either by water or by air.

The evidence shows that plaintiff's engineer went at the job in about that way. He testified that he had received no help from Wolf and he decided what size of tubing to use by using his own mechanical skill and general knowledge, independent of any teaching from Wolf.

Evidence has been produced as to the amount of money paid for the patent in suit. It appears that $17,000 was paid for some 25 patents and 25 applications, including the patent in suit, and I am not minimizing that amount; nevertheless, it was not substantial, considering the number of patents acquired and I do not think that any great weight or importance was attached to the patent in suit when it was purchased. There is nothing about the investigation made of the patent at the time it was purchased, along with the large group of other patents, which ought to cause any unusual importance to be attached to the patent in suit.

I am not unmindful of the large sale which air-cooled refrigerating machines have had or which domestic refrigerating machines have had. I do not think that the patent in suit had anything to do with the development of air-cooled machines. The patent was applied for, years elapsed, the patent was granted, more years elapsed, and the art was not revolutionized. Plaintiff is a subsidiary of one of the great, if not the greatest, selling organizations in the world. Its sales of machines having this type of condenser cooling have developed, but not in any startling way. The sales have grown with the development of the household machine. Its sales of refrigerators having water-cooled condenser coils have also increased.

### Factors Entering Into Sales.

There has been a battle between artificial refrigerating devices. There has been no particular battle between the competing companies who were manufacturing these devices or between air-cooled and water-cooled machines. Instead, the battle has been between the manufacturer of machines and the manufacturer of ice. The machine possesses very many niceties that, independent of the patented combination, would account for the sales made and that, added to the selling force placed behind it, contributes to the number of them which have been sold. Many things were required to make the machine a success, such as the motor which runs it and the thermostat which

controls it. If these devices were not good the machine would not stay sold and I think that more effort was required in working out these various points in the making of a good, workable machine than was required in working out the condenser coil or in deciding whether the coil should be water-cooled or air-cooled. I can see many things that tell the story of why there has been a demand created, but I cannot trace any of it to Wolf; I do not find that Wolf has any part in it whatever.

As to the claims which have been restricted by disclaimer to particular sizes of copper tubing, I hold that those particular sizes of tubing were old. The prior art is full of all the different kinds of condenser coils and expansion coils that we have today, in various kinds of material, using various kinds of refrigerants. I cannot help but feel that it would be unfair and improper to allow Wolf to control the ⅜-inch size of copper tubing in that old combination just as it would be unfair to permit a carpenter to control nails or well-known materials and sizes to be used in building houses.

### Invalidity of Claims.

The designer should be permitted to use such size of tubing as the capacity of his machine requires. Something must be left to his judgment in meeting varying conditions as he meets them.

I find many instances of copper tubing being used and instances where the specific sizes in question have been mentioned for refrigerating coils. I find air cooling was old per se and old in the combination. The use of a fan for air cooling is old, these fans being placed in many different positions and cooling all the different parts.

I conclude, therefore, that the claims in suit are invalid and decree may be entered dismissing the bill with cost to defendant.

March 23, 1929.

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# *Improvement in Powder Boxes*

EX PARTE DONALD L. COMPTON. APPEAL No. 1713, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1709840 was issued April 23, 1929, to Donald L. Compton for a powder box, on application No. 629673, filed April 3, 1923.

The single claim in the case, relating to the arrangement of the lining in a powder box, was held patentable on appeal, the decision of the examiner being reversed. It was found that appellant's device presented novelty as the lining used in the box covered the bottom and sides and did not extend over the top, as in the references, and therefore did not require fracture of the lining in gaining access to the powder. Also, it was noted that the references did not disclose the bent over lips for holding the lining in place.

### Single Claim in The Case.

C. A. Snow & Co. for applicant.

The full text of the decision of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Ruckman and Landers) follows:

This is an appeal from the rejection of the single claim in the case, reading as follows:

"In a powder box, a rectangular body portion including a cover section and a bottom section of like construction, a rectangular inner section of a width equal to the combined widths of the cover section and bottom section, a lining of paper material fitted within the inner section and having side sections contacting with the inner section, lips at the ends of the side sections and bent over the upper ends of the inner section to hold the lining in position, said lips being held between the inner section and cover section, a lining retaining member having side sections engaging the side sections of the lining to hold the lining in position, and inwardly extended lips formed at the free ends and the side sections of the lining retaining member to guard the upper portion of the box."

The references relied upon are: Palmer, 1221900, April 10, 1917; Buedingen, 146800, September 18, 1925; Brieger 1468000, September 18, 1925; Brieger (Swiss), 36082, March 14, 1906.

The invention is a powder box and reference is made to the examiner's statement for a clear and concise description thereof. The claim stands rejected on Palmer in view of Buedingen and Brieger, the examiner holding:

"The claim was rejected on the ground that nothng more than mechanical skill would be required to invert Palmer's liner to cover the bottom instead of the top, as suggested by Buedingen, and to

provide the lining retaining member with inwardly projecting flanges as shown by Brieger."

**Reversal of Examiner.**

In appellant's device the liner covers the bottom and sides for preventing the sifting out of the powder; it does not extend over the top as in the references, and does not therefore require fracture of the lining before access can be gained to the powder. Moreover, appellant's means to secure the lining in place by the bent lips is not shown in the references.

We are not prepared to hold with the examiner that appellant's device could be constructed, in view of the references, without invention.

The decision of the examiner is reversed.

## MAY 3

# *Improvement for Weir Meters*

EX PARTE GERALD D. DODD. APPEAL NO. 717, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1710474 was issued April 23, 1929, to Gerald D. Dodd for weir meters, on application No. 551647, filed April 11, 1922.

In specifying that the "passageway" of claim 1 is a "deep, narrow passageway," it was held that claim 2 patentably differentiated therefrom. Claims 4 and 7, containing further limitations, also were allowed.

Claim 6 was allowed along with claim 5 as patentably defining thereover in specifying that a "valve M be added with a passage which, when the valve is open, does not obstruct the thoroughfare."

**Justification of Statement.**

The examiner's rejection of claims 5 and 6, as being misleading, also was not sustained, it being held that the statement in the specification to the effect that the valve opening "may well be 3 or 4 inches in diameter" justifies the statement in the claim that the valve is of "substantial vertical depth and width."

John E. Hubbell for applicant.

Before Kinnan, First Assistant Commissioner; Henry and Ruckman, examiners-in-chief. The full text of the Board of Appeals' decision follows.

This is an appeal from the rejection of claims 2, 4, 5, 6 and 7. Claims 2 and 5 are representative and read as follows:

"2. In a weir meter comprising a still water chamber and a weir over which liquid flows out of said chamber, the combination of a separate level measuring chamber spaced away from the still water chamber, and means for maintaining the same liquid levels in said chambers, comprising a deep narrow passageway which connects the interiors of the two chambers and extends between levels as high and as low, respectively, as the maximum and minimum liquid levels normally prevailing in the still water chamber.

"5. In a weir meter comprising a still water chamber and a weir over which liquid flows out of said chamber, the improvement comprising a zero level chamber external to the still water chamber, and means connecting said chambers providing a thoroughfare between the chambers of substantial vertical depth and width and projecting above and below the lowermost level of the flow over the weir."

The reference relied upon is: Anderson, 1161279, Nov. 23, 1915.

The invention relates to weir meters and the rejected claims are directed to specific improvements therein.

Claims 2, 4 and 7 cover a construction in which the still water chamber G and the float or measuring chamber I are connected through a port K in the form of a narrow vertical slot extending between the high and low levels of the water in the still water chamber, for the purpose of insuring the same liquid level in the two chambers under varying conditions of operation and temperature.

The examiner has allowed the broader claim 1 directed to the same invention, but rejects claims 2, 4 and 7 as "substantial duplicates thereof." Claim 2 differs from claim 1 in specifying that the "passageway" of claim 1 is a "deep narrow passageway." This additional limitation renders the claims of different scope. Claims 4 and 7 contain other substantial limitations differentiating them from claims 1 and 2 and from each other. Claims 2, 4 and 7 are deemed allowable.

Claims 5 and 6 relate to the still water chamber, the zero chamber L and the "thoroughfare between the chambers of substantial vertical depth and width and

projecting above and below the lowermost level of the flow over the weir."

Claim 6 adds the valve M with a passage which when the valve is open, does not obstruct the thoroughfare. In view of this valve feature the examiner's rejection on the ground that these claims do not patentably differ is not well taken.

The examiner also rejects claim 5 and 6 as inaccurate and misleading. His criticism that the passageway through the valve is not of "substantial vertical depth and width" is not justified in view of the statement in line 5, page 6 of the specification, that the valve opening "may well be three or four inches in diameter." The valve M is believed to satisfy the valve construction called for in claim 6.

The decision of the examiner is reversed.

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# *Non-Infringement of Patent On Device for Waving Hair*

THE LEMUR COMPANY, APPELLANT, v. W. G. SHELTON COMPANY, APPELLEE. No. 3394, CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

THE decision of the District Court, holding plaintiff's patent for a steaming tube for hair-waving invalid in view of prior references and the defendant not guilty of unfair competition, was affirmed.

The article in suit, the opinion states, consists of sheets of white paper and a sheet of metal foil rolled into a little tube with foil projecting beyond the paper at the ends, and in use it is slipped over a strand of hair which has previously been wound around a rod in corkscrew fashion and wrapped about with a flannel wetted in a certain chemical solution, after which the entire assembly is inserted in the chamber of an electric heater for which the patent article is adapted.

This structure, the Court found, was anticipated by the prior art and the patent void notwithstanding the showing of the volume of trade under the patent, "the reactions of others in the trade, and the changes of practice in the rapidly extending field of the art."

As to the issue of unfair competition, it was decided that, although the defendant used an article consisting of a sheet of white paper and one of metal foil rolled into a tube and shaped to fit an electric heating chamber, and the directions for use corresponded to those issued by plaintiff, yet it did not palm off its goods as those of the plaintiff, since it marked its goods plainly with colored paper for its wrapping, putting special and conspicuously different markings thereon, and plainly marked them with its name.

F. O. Richey (Lawrence C. Kingsland and Richey & Watts were with him on the brief), for appellant; Rodney Bedell (Eugene V. Myers was with him on the brief), for appellee.

Appeal from the District Court for the Eastern District of Missouri. Before Lewis, circuit judge, and Woodrough and McDermott, district judges.

The full text of the opinion of the court, delivered by Judge Woodrough, follows:

This is a suit joining the causes of patent infringement and unfair competition. Upon the trial the patent was held invalid because anticipated by the prior art, and the issue as to unfair competition was determined in favor of the defendant against the plaintiff. The plaintiff appeals.

Having been duly allowed in the Patent Office, the presumption of validity must be accorded to the patent. It relates to a steaming tube for hairwaving, and the drawings, specification and claims cover 15 pages of printed matter very closely set up. But the article itself, as shown to the Court, is made up of sheets of white paper and a sheet of metal foil rolled into a little tube some ¾ of an inch in diameter and about 5 inches long, with the foil projecting beyond the paper at the ends. The foil and the paper are rolled together so that the foil remains inside between the layers of white paper.

It appears that in the use of this article in the operation of hairwaving a portion of the hair is gathered into a strand and the strand is wound around a rod, corkscrew fashion. Then the strand of hair on the rod is wrapped about with a flannel wetted in a certain chemical solution; the patented tube is slipped over all and the foil at the ends of the tube is crimped with a crimper. A felt washer is fitted around the strand at

the scalp and a fiber clip is clamped above the washer. The tube conforms to the size and shape of the heating chamber of an electric heater for which it is adapted, and on being thus arranged about the wet flannel, the hair and the rod, and inserted into the chamber and the proper amount of heat applied, the conditions are present to produce waves in the hair.

**Salient Features of Invention.**

The advantages and points of novelty and invention claimed for the patented article are entirely too numerous to set out in detail. Many pages of the specifications and claims of the patent are taken up with them and they have been greatly elaborated by able counsel at the bar and in the briefs. However, the single patent expert called by plaintiff on the trial to support the patent says that the salient features of the invention, "so far as the mechanics of the invention go," are—

"(1) The provision of a wrapper of discolorable material, which will serve as a warning signal to the operator (i. e., in regard to the heat).

"(2) The provision of a foil of such strength that when it is crimped it would practically seal the ends of the tube about the hair or the curling rod."

Such condensation in regard to a patent having 39 allowed claims and voluminous specifications may be extreme. It does not mark the limits of our search of the record, but, as it is the summing up of the expert employed to study the patent and called to inform the Court of any merits, reference to his condensation may aid to bring this opinion within reasonable limits.

Concerning the discoloration of the white wrapping paper (under the heating process) to serve as a warning signal to the operator, the proof is clear and satisfies us that the claim is without foundation in the facts. It is shown that there are many kinds of human hair, each kind more or less differently affected by different degrees and quantity of heat; that skill is developed in some operators in the matter of determining the proper amount of heat for different operations; that the time measure—that is, the time the heat is kept on—is the measure that is mostly depended on and is the one which is enjoined upon its own customers by the appellant, and that in practice no dependence is or can be placed upon the discoloration of the paper as a warning signal. The discolorable feature of the ordinary white paper wrapped around the tube therefore lacks usefulness. It also lacks novelty because paper was long used for hair-waving tubes, and paper generally tends to char and discolor under heat.

Neither do we find any merit of useful novelty or invention in "the provision of a foil of such strength that when it is crimped it would practically seal the ends of the tube about the hair, or the curling rod." The evidence clearly shows that the crimped foil is not adapted to and does not perform the function of sealing the ends of the tube about the hair or the curling rod either actually or practically. Whatever the word may be which is most apt to describe the kind of contact that a metal foil maintains when crimped about a rod or a strand of hair, the word "seal" is obviously inapt and strained. On the contrary the crimped foil merely makes a more or less form-sustaining wrapping about such objects when crimped upon them, and thus serves the usual purpose to which foil is commonly put, in view of all its uses, very frequently wrapped about cigars, candy, and many other articles.

The same form-embracing, nonresilient and form-sustaining qualities of the foil are depended upon in all of these uses as in the use made of the foil in the article in question. There is no suggestion of either novelty or invention.

The evidence also shows clearly that no pressure of steam is permitted to gather in the tube during the waving operation, but the leakage of the heated liquid in the felt wrapping through the bottom of the tube to the head is to be avoided. Such leakage is prevented in whole or in part by the action of the fiber clip and the presence of the fiber washer, and there is no proof that foil crimped about the rod or hair accomplishes the results.

**A Comprehensive Study.**

It appears to us, therefore, that the provisions of the article pointed out and relied upon by the expert as features of invention are plainly not such, even without much reference to the particular prior art. But we have before us a book of the prior art, other applications for patent, principal papers in interference in the Patent Office and many references and examples all directly applicable. Our study has included all of the record, and confirms the conclusion that the trial court was right in holding the patent void. The convolution of metal foils and paper into tubes for hair waving

was disclosed in the British patents issued to Aldworth, and appliances embodying the teachings of his patents were extensively used in commerce throughout this country some years before the patent in suit was applied for or invention claimed in regard thereto. The first British patent to Aldworth anticipated the plaintiff's patent and each of the claims thereof relied on this case, and his second British patent accentuated it.

We do not ignore appellant's many claims concerning the use of strings in the prior art for tying the waving tube upon the curl. Aldworth did use a string for that purpose and nowadays no such tying with a string in generally done by hair wavers. But we are not persuaded that the change in practice is attributed to the teachings of the patent in suit. It has more probably resulted from more general use of some such washers and clamps or clips as are exhibited with the record and used by the plaintiff.

Our conclusion that the patent is invalid and the matter not in doubt obviates discussing in detail many contentions ably urged by counsel. The volume of plaintiff's trade under its patent, the reactions of others in the trade and the changes of practice in the rapidly extending field of the art, have afforded material for forceful arguments. We do not fail to appreciate appellant's faith in its patent. But as we can find neither novelty nor invention, simply old elements applied to old uses, and clear anticipations in the prior art patents, all presumption in favor of the patent is overcome and the patent fails.

In the suit for unfair competition the plaintiff asserts an actual intent to trade upon the good will belonging to it, and also such a trespass resulting from defendant's acts regardless of intent.

It is apparent that when the defendant rolls a sheet of white paper and one of metal foil into a little tube adapted in size and shape to fit into the same heating chamber for which the plaintiff's tube is manufactured there is bound to be kinship in the appearances. It is equally apparent that when instructions are given out for operators, identical steps to be taken whichever article is used, are likely to be similarly described. So also in advertising and selling methods. The courts are jealous to protect good will in equity against spoliation and are fully aware of the vast increment brought to this kind of intangible property by modern advertising and methods. On the other hand this equity power of the court must not be stretched to confer by indirection upon one who has no patent and no special right of priority a better and more enduring monopoly than has a patentee. A manufacturer, therefore, must be admitted to have good right to make and vend any unpatented article embodying therein the necessary functional parts so that the whole will function. If he goes beyond and incorporates what is purely distinctive, ornamental, fanciful or otherwise merely peculiar to the product of another he may trespass.

### Lack of Unfair Competition.

Applying these elemental rules to the very numerous details and circumstances pointed out and argued from the record we are not persuaded either that the defendant intended to palm off its goods for those of its competitor or that in fact any such confusion was occasioned by the defendant's conduct of its business. Its goods are plainly marked with its name, and by adopting a colored paper for its wrapping, putting special and conspicuously different markings thereon, and otherwise identifying its product for its own trade, it appears to us that the defendant has not only disproved any intent to trade on plaintiff's right, but that the plaintiff is not in fact suffering any such wrongful invasion by reason of the defendant's manufacture and trade. As to a very insignificant number of tubes manufactured by defendant there were some markings and dressings which approximated the appearances so closely that a confusion might have been brought about. Likewise in the printed matter there was such a possibility. But the drastic steps promptly taken by defendant plainly prove its determination to trade on its own product and its own reputation, and the charge of unfair competition is not sustained.

The decree of the trial court is therefore affirmed with costs.

March 29, 1929.

# Folder for Edges of Shoe Uppers

BEACON FOLDING MACHINE COMPANY, PLAINTIFF-APPELLANT, V. ROTARY MACHINE COMPANY ET AL. No. 2289, CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

ON rehearing the court vacated its decree of March 16, 1929 (IV, U. S. Daily, 338), in so far as it related to infringement of patent 1527395, covering machines for folding edges of shoe uppers, and affirmed the District Court in holding this patent not infringed.

In view of the demonstrations made by the parties at the rehearing it was concluded that the curved notches in the disks of defendant's fold presser did not press the fold at its edge, and that the court's former decision holding that these notches did press the fold at its edge and constituted the equivalent of plaintiff's construction comprising a curvilinearly-faced hammer and an extension toe, the toe being adapted to press the edge of the fold while the rolling operation was performed, was wrong.

Appeal from the District Court for the District of Massachusetts.

Before Bingham, Johnson and Anderson, Justices. The full text of the opinion of the court, on rehearing, follows:

Per Curiam. Since handing down our opinion in this case on March 16, 1929, a rehearing has been granted as to the question whether the curved notches of the defendants' disks do or do not press the fold of the binder at its edge. A hearing has been had covering a day's time, at which full opportunity was given the parties to present their respective contentions and make demonstrations on machines embodying the defendants' device, for the purpose of determining the question above stated. These demonstrations satisfy us that the conclusion reached in our opinion of March 16, 1929, that the notched disks press the fold at its edge, was wrong; that we were led into error by a demonstration made at the time the case was originally heard, which did not in fact disclose what it purported to do; and that our previous finding on this question must be reversed.

Our decree of March 16, 1929, so far as it relates to the first patent and to costs, is vacated, and is modified to read:

The decree of the District Court is affirmed, with costs in this Court to the appellees. April 25, 1929.

## MAY 4

# Procedure in Suit by Nonresident

LEWIS PENGILLY, PLAINTIFF, V. KOOLFAST RADIATOR COMPANY. IN EQUITY No. 855, DISTRICT COURT FOR THE NORTHERN DISTRICT OF OHIO.

IN OVERRULING a motion to strike out defendant's counterclaim the Court holds that a plaintiff, in bringing suit for patent infringement in a district in which he is not an inhabitant, consents to be sued by counterclaim on an independent and unrelated cause of action.

In this case the complainant brought suit on a patent covering "a lighter for cigarettes and the like," and the defendant set up in counterclaim another patent covering "certain new and useful improvements in cigar lighters." The motion to strike the counterclaim was denied.

The opinion states that in some courts counterclaims are allowed only on subject matter connected with or growing out of the plaintiff's cause of action, this allowance being based on the interpretation of Judicial Code, section 48, attributing to the plaintiff only a limited intent, from a jurisdictional standpoint, in coming into another jurisdiction to set up a cause of action; but this Court ruled that plaintiff in coming into a district waives many rights as to venue.

Percy S. Webster, Stockton, Calif.; Miller, Brady & Yager, Toledo, Ohio, counsel for plaintiff; George E. Kirk, Toledo, Ohio, counsel for defendant.

The full text of the opinion of the Court, delivered by Judge Hahn, follows:

The bill of complaint herein is for infringement of a patent. To the bill of complaint the defendant filed an answer and counterclaim. The counterclaim alleged that the plaintiff is infringing another patent which is owned by the defendant. Apparently the patent named in the bill of complaint covers "a lighter for cigarettes and the like." The patent set up in the counterclaim covered "certain new and useful improvements in cigar lighters." Upon the filing of the counterclaim, plaintff, appearing specifically for that purpose, moved to strike out the counterclaim. The motion to strike out the counterclaim coming on for hearing, it was ordered "that amend-

ment to counterclaim setting up prosecution limitations of Pengilly patent in suit, 1608615, by counterclaimant Morrill patent is hereby allowed. The motion to strike out counterclaim is denied and leave is given plaintiff to file any new motions against the amended counterclaim." The defendant, under the order of the court above, on September 27, 1928, filed an amended counterclaim. Plaintiff, under a special appearance, has renewed his motion to strike the amended counterclaim.

The main reliance of the plaintiff is on the case of Durabilt Steel Locker Company v. Berger Manufacturing Company, 21 Fed. (2nd) 139, a decision by Judge Westenhaver. An examination of this decision reveals that there is a conflict of authority in the district courts as to the applicable rule. Under the decision of Judge Westenhaver, the counterclaim in a patent suit is limited "to the subject matter of that bill and all other matters connected with or growing out of that subject matter." Under this line of decisions the defendant may not litigate a counterclaim "unconnected with and independent thereof (meaning the subject matter of the bill) which may be the subject of an independent suit in equity cognizable in a Federal court." This limitation is suggested by this line of cases because of the supposed effect of Judicial Code Section 48, 28 U. S. C. A. Section 109, which is in part as follows:

"In suits brought for the infringement of letters patent the district courts of the United States shall have jurisdiction, in law or in equity, in the district of which the defendant is an inhabitant, or in any district in which the defendant, whether a person, partnership or corporation, shall have committed acts of infringement and having a regular and established place of business."

The limitation upon the kind of counterclaim which may be litigated under the above decision is based upon the limited intent attributed to a plaintiff in coming into a jurisdiction other than the one in which he is an inhabitant, or in which he shall have committed acts of infringement and have a regular and established place of business. However, the decision in Durabilt Steel Locker Company v. Berger Manufacturing Company, supra, has not been followed in the Western Division for the Northern District of Ohio. In Alliance Securities Company v. The DeVilbiss Manufacturing Company, Judge Killits, in a memorandum opinion, followed the contrary line of decisions, citing American Mills Company v. American Surety Company, 260 U. S. 360, 67 L. Ed. 306; Wire Wheel Corporation v. Budd Wheel Company (4 C. C. A.) 288 Fed. 308. Judge Westenhaver was of the opinion that the exact point involved was not presented in American Mills Company v. American Surety Company, and he stated that he was unable to concur in the reasoning of the opinion in the Wire Wheel Corporation case. Comity requires us to follow the decision of Judge Killits, and after an examination of the authorities, we agree with his conclusion. The decision in the Wire Wheel Corporation case was by the Fourth Circuit, with Chief Justice Taft sitting as Circuit Justice. In that case reliance was placed upon the American Mills Company case, which theretofore had been decided by Chief Justice Taft.

The Circuit Court of Appeals for the First Circuit, in Krentler-Arnold Hinge Last Co. v. Leman, 13 Fed. (2d) 796, came to the same conclusion as did Judge Killits. This is a carefully considered case, and the second paragraph of the syllabus is as follows:

"A complainant, by bringing suit for infringement in a district of which he is not an inhabitant, and in which he has no regular and established place of business, consents to being sued thereon on a counterclaim based on an independent and unrelated cause of action, as for infringement of another patent."

This decision does not seem to have come to the attention of Judge Westenhaver.

As we have stated the contrary line of decisions is based upon the supposed limited intent of the plaintiff to waive a venue statute. But a plaintiff in coming into a district is held to have waved many of his rights as to venue. See Commercial Casualty Company v. Consolidated Stone Company, United States Supreme Court Advance Opinions, January 15, 1929, No. 5, decided January 2, 1929 (III U. S. Daily, 2706); and many cases cited in the margin of that case. Further, see Rose's Federal Jurisdiction and Procedure, third edition, sections 390, 406, 417; Dobie on Federal Procedure, page 478.

It is doubtful if the amended counterclaim is proper under Durabilt Steel Locker Company v. Berger Manufacturing Company, supra. However, it may properly be litigated under the decision of Alliance Securities Company v. DeVilbiss Manufacturing Company, which we follow. The motion to strike out the amended counterclaim is overruled.

## MAY 7

# *Novel Plan of Broom Stitching*

EX PARTE RALPH K. THOMSON. APPEAL No. 300, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1711433 was issued April 30, 1929, to Ralph K. Thomson for brooms, on application No. 112073, filed May 27, 1926.

The arrangement of stitches in the brush head of a broom was found patentable over the prior art. All the claims in the case, directed to a broom having the stitching more compacted and closer together at the margins of the brush head than is the case in conventional practice, and farther apart in the intermediate portion, the Board decided, were allowable since the reference relied upon did not disclose this arrangement of stitching.

Lancaster & Allwine for applicant.

Moore, Assistant Commissioner, Skinner and Ide, Examiners-in-Chief. The full text of the decision of the Board of Appeals follows:

### Two Typical Claims.

This is an appeal from the decision of the primary examiner finally rejecting all of the claims of the application. The following claims are typical of those rejected and are repeated for purposes of illustration:

"1. As an article of manufacture a broom including a brush head secured together by means of transverse stitching, the stitches of said transverse stiching being disposed appreciably closer together at the side edges of the broom than at the intermediate portion thereof.

"2. As an article of manufacture a floor broom including a conventionally shaped flat brush head formed of a plurality of pieces, and stitches traversely disposed across the thickness of the brush head comprising rows of stitching extending from side to side of the brush head, the stitches of said rows being disposed closer together adjacent the side edges or margins of the brush head than is conventionally the practice and closer than the stitches at the intermediate portion of said brush head."

The references relied upon by the examiner are: Crandall, 104834, June 28, 1870; Lewis et al., 184879, Nov. 28, 1876; Wagner et al., 227139, May 4, 1880; Metzger (Fr.), 380013, Nov. 27, 1907; Andrews, 1017069, Feb. 13, 1912.

As stated in appellant's brief:

"It will be noted from the claims that the inventive concept is the provision of a broom which has a conventionally-shaped flat brush head with tranverse stitches holding the straws together; the stitches being so arranged that they are more compacted and closer together at the side edges or margins of the brush head than in conventional practice; the stitches being farther apart at the intermediate portion of the brush head."

Of the patents cited by the examiner not one describes the arrangement of stitches specified in the claims.

The examiner, in his answer to the appeal, discusses only the French patent to Metzger and the domestic patent to Lewis. He says:

"The French patent shows every feature of the claims save the condensed edge stitching. It is an everyday mechanical expedient to strengthen stitching by forming the stitches closer together, as may be observed by inspecting ordinary wearing apparel, and it is thought the same expedient would be availed of in the stitching of the French patentee's broom, were it found to fray, without drawing upon the inventive faculty."

### Condensed Edge Stitching.

The feature of condensed stitching which admittedly is not shown in the French patent is the feature which constitutes applicant's invention and in the absence of any reference showing this to be old we think the claims should be allowed. The drawing of the patent to Lewis shows stitching across the head of the broom and the stitches appear to be irregularly spaced apart; some of the stitches distant from the marginal portions of the broom appear to be nearer together than some that are nearer to the marginal portions, indicating to us, in the absence of description that there was no apparent intention by the patentees to disclose applicant's invention in the drawing.

The drawing in the patent to Crandall apparently shows stitches closer together at the marginal edges. This appearance, however, may be due to such stitches appearing upon a convex portion of a broom. There is no description in this patent to indicate any peculiarity in the spacing of the stitches.

The decision of the examiner is reversed.

# Noninfringement of Radio Tube With Patent for Electric Light

WESTINGHOUSE LAMP COMPANY, PLAINTIFF, v. C. E. MANUFACTURING COMPANY, INC. IN EQUITY NO. 261, DISTRICT COURT FOR THE DISTRICT OF RHODE ISLAND.

PATENT No. 1180264, covering a thoriated tungsten filament for an incandescent lamp, was held to be of doubtful validity and not to be infringed by the radio tube employed by the defendant.

The opinion states patentee's invention resided in the use of filaments made of tungsten with the addition of small percentages of oxygen-containing thorium, the addition of this rare earth metal being for the purpose of retarding or preventing change of the filament structure to a chrystalline form, causing faulting or offsetting and burning out of the filament when subjected to the heat that is usual for incandescent lamps, and that the filaments were made from a paste forced through a die, the only method of filament making known at the time the patent issued.

### The Use of Thoria.

The prior art established beyond question that the patentee was not the first to use thoria in conjunction with other metals, including tungsten, in the manufacture of incandescent bodies, the court found, but that he was the first to point out the phenomena of offsetting, a result of a combination already present in the art. It was also stated that the patentee neither taught nor knew about the effect of thoria in a drawn wire such as employed by defendant.

Infringement, the court concluded, did not exist because the thoriated tungsten filament used in defendant's radio tube did not present a mechanical problem due to offsetting, that it was made of a drawn wire and contained a small, but scientifically exact, quantity of thorium and was operated on a current sufficient only to produce electronic emission.

Defendant's counsel contended that plaintiff had not shown good title to the patent due to a seizure of the patent by the Alien Property Custodian and conveyance by him to the Chemical Foundation, Inc., and that under the trust provision of the charter of the Chemical Foundation, Inc., there was no power to convey any interest in the patent to the plaintiff, but owing to the lack of evidence submitted to support this contention it was not sustained.

Cooper, Kerr & Dunham, John Kerr and Victor Beam, all of New York, of counsel for plaintiff; Horatio E. Bellows, of Providence, for plaintiff; Charles J. Holland, of New York, and George F. O'Shaunessy, of Providence, for defendant.

The full text of the opinion of the court, delivered by Judge Letts, follows:

The Westinghouse Lamp Company brings this suit in equity against the C. E. Manufacturing Company, Inc., for infringement of Letters Patent No. 1180264 issued to Anton Lederer, of Vienna, Austria, April 18, 1916, upon an application filed December 20, 1906. The bill contains the usual prayers for relief by injunction and for damages.

The plaintiff company at Bloomfield, N. J., is a manufacturer of electric lamps and radio tubes. It claims to be the owner of said letters patent and alleges that the defendant company, which is also engaged in the manufacture of radio tubes at Providence, R. I., has infringed and is infringing upon said patent in making its Type A tube. No other product of the defendant company is involved in this suit.

It is agreed that the general design and performance of the 201-A tube of the plaintiff and the Type A tube of the defendant are substantially the same. Each tube embodies a "hair pin" filament, taking the form of an inverted V surrounded by an elliptical plate with a grid interposed between the filament and the plate. Both tubes operate on a five to six volt one-quarter ampere current and give an emission of approximately 50 milliamperes. In fact, this type of tube appears to be made by many manufacturers. In the trade the design 201-A has become substantially a generic or descriptive designation of a tube of a given type.

### Neither First in Field.

Neither the plaintiff nor the defendant was the first in the field in its manufacture. The plaintiff began the manufacture of radio tubes in the year 1921 and the defendant began its manufacture sometime in 1925. The plaintiff complains, however, that the patent here involved covers the thoriated tungsten filament used by it and that the defend-

ant is also using a thoriated tungsten filament of substantially the same structure and composition.

A word should here be interposed in explanation of the structure of these filaments and the reason therefor. In the construction of a radio tube of the type involved in this controversy the principal object to be attained is that of electronic emission, together, of course, with necessary durability. In the development of the radio tube industry it was found that most pure metals and carbon when heated at varying temperatures emitted electrons.

The original De Forest tube was constructed with a substantially pure carbon filament. It was found, however, that the efficiency of a tube was infinitely increased by employing a filament composed of tungsten with an admixture of a very small percentage of thorium. Thorium is a rare earth metal which is found to be used commercially, both in its metallic form (Th) and as an oxid ($ThO_2$), in which latter state it appears as a gray powder.

The presence of $ThO_2$ in the body of the filament does not increase the electronic efficiency of the filament, but the emission is greatly increased by the presence of a very slight percentage of thorium; the electronic emission being thereby increased about twenty times.

The patent in question is entitled "Incandescent Body for Electric Lamps." In the introductory paragraph of his specification the inventor states that:

My invention relates to certain improvements in filaments for incandescent electric lamps, in particular such filaments as are essentially composed of metals that tend to alter internally under the influence of electric currents and to the process of manufacturing the same.

It consists generally in the production of more durable and efficient incandescent filaments, containing an intimate mixture of such a metal with another metal or metallic compound which causes the filaments to resist internal alterations during their use.

In the manufacture of filaments for incandescent lamps, and especially of filaments consisting of pure tungsten metal, it has been observed that, after burning for some time, an alteration in the structure of such filaments takes place. This alteration, which manifests itself in a displacement of sections of a filament with respect to its longitudinal axis, is usually designated by the terms "offsetting" or "faulting," and is probably due to the crystallization of the metal. The appearance of this crystalline structure has the deleterious effect that it renders the filaments considerably more brittle than they were before and it thus increases very greatly the liability of the filaments breaking when the lamp is in service or is subjected to shocks.

I have discovered that by the addition of small percentages of suitable substances to the tungsten this crystallization and consequent deterioration of the filament can be largely obviated or entirely prevented. In one of the ordinary processes of manufacturing tungsten filaments it is usual to bring the tungsten metal, or an appropriate tungsten compound, into the shape of a plastic paste by means of an addition of a suitable binding material. I have found that when a small amount of oxygen or oxygen containing compounds of rare earth metals and like materials, such as thorium, zirconium, erbium, cerium, lanthanum, etc., is added to a paste of such a character, or to the materials used in making metallic filaments according to other processes, the resulting filament is structurally different from a filament consisting only of tungsten and that the change-over of the filament into the crystalline structure is considerably delayed or altogether prevented.

The presence of a binding material is, of course, immaterial, nor does it matter at what time during the process of manufacturing these additions are made to the tungsten metal or tungsten compound, as long as they produce the desired result in the finished filament.

The inventor, after indicating that he has in mind a squirted filament, that is, a filament made from a paste forced through a die, which was in fact the only method of filament-making known at the time, further states:

It will, of course, be understood that my invention is not limited in its application to use in connection with any particular process of producing the filaments, but that, if desired, it may be employed in connection with any other process than that specifically set forth. It is also to be understood that my invention is not alone applicable to tungsten filaments but that it is also applicable to all filaments suitable for incandescent lamps and subject to offsetting or faulting in use.

### Introduction of Oxids.

In the concluding paragraph of the specification the inventor says:

I am aware that it has been proposed to make lamp filaments consisting of a mixture of a metal and an oxid, but, in such cases, the oxid forms a large part of the finished filament, whereas, in my process, the oxid or other metallic compound is added only in sufficient quantity to accomplish the desired result. This result is essentially the prevention of harmful internal alteration of "offsetting," and the fact that the addition of other substances than the filament metal will produce this result has never, so far as I am aware, been suggested prior to my present invention.

The patent embraces a total of some

16 claims. Seven only of these are relied upon by the plaintiff. These seven claims are as follows:

I claim as my invention: 1. A filament composed mainly of a metal that tends to offset when utilized as a conductor of electricity and containing an offset resisting material.

2. An essentially metallic filament for incandescent electric lamps which consists mainly of a metal that tends to offset, but which resists offsetting.

3. A filament for incandescent electric lamps which consists mainly of tungsten and which resists offsetting.

4. A filament for incandescent electric lamps consisting mainly of a material that tends to develop structural alterations when utilized as a conductor of electricity and containing an additional material for resisting such development.

5. A filament for incandescent lamps composed mainly of a material that tends to crystallize when utilized as a conductor of electricity and containing an additional material for delaying such crystallization.

6. A filament composed of an intimate mixture of a refractory metal of the tungsten type and such a quantity of an offset resisting material as will resist deleterious alteration within the said filament when the said filament is utilized as a conductor of electricity.

9. A filament for incandescent electric lamps composed of an intimate mixture of a refractory metal of the tungsten group and an additional material which comprises at least one of a group of substances including thorium, zirconium, erbium, cerium and lanthanum, and the oxygen compounds of the said metals, the said additional material being present in substantially sufficient quantity to prevent deleterious alteration within the said filament during use.

The plaintiff contends that its filament is manufactured by the introduction or admixture into the tungsten body of a small percentage of thoria and that in the process of manufacturing the tube, its seasoning and flashing, so-called, a portion of this thoria is reduced to thorium distilled to the surface of the filament, giving to it the desired electronic efficiency.

The residue of the oxid, not so reduced, remains, it is claimed, in the body of the filament to retard its crystallization, functioning as described in the patent involved in this suit.

The plaintiff further contends that whatever may be the process by which the filaments employed by the defendant are manufactured, substantially the same result in the end is reached and that the residual nonmetallic inclusions of thoria retard crystallization, thereby infringing upon the rights of the plaintiff under its patent.

This contention is based upon the assumption that the radio tube filament presents the same mechanical problem as the incandescent lamp filament, namely, the problem of forestalling rupture or offsetting of its crystal structure.

The defendant contends that its tubes are manufactured by a process which reduces at the outset all of the oxid to metallic form and that it is not important that there should be a residue of ThO2 to serve as a retarding agency of crystallization which, is is claimed, presents no mechanical problem in connection with a filament for a 201-A type tube. It is contended that the low temperatures at which these tubes are operated, employing a direct current only, creates no mechanical problem incident to the crystallization. It is contended that the life of the tube for practical purposes is terminated by the exhaustion of its electronic emission, rather than by its breakage or burning out because of offseting.

### Claimed Difference in Process.

The record which has been made is not satisfactory in so far as a determination becomes important of the structure and composition of the alleged infringing filaments. To a large extent the testimony of the witnesses of the respective parties relates to an examination of materials and filaments, the identity of which is not established. The result of the chemical, X-ray and photographic examinations, while seemingly in conflict, are not in general necessarily so.

Most of the plaintiff's expert testimony relates to the examination of two lots of Ceco Type A tubes purchased from the defendant April 14, 1926, and June 17, 1926, respectively. It appears that about this time, and before the institution of this suit, the defendant company turned to another source, namely, to the Callite Products Company, for the purchase of its filament wire and that from and after that date its wire was purchased exclusively from that company. Mr. Kauer, manager of the defendant company, testified that in his opinion no one could with certainty tell who made the filament wire which was utilized in the tubes purchased by the plaintiff and examined by its experts. It was this Callite Products Company wire, lot No. 267 (which will hereafter be referred to as the Laise wire), its structure and composition, to which the expert testimony on behalf of the defendant relates.

There are, apart from the structure of the filaments, other questions raised by the pleadings and record which neces-

sitate an inquiry into plaintiff's ownership of, and the meaning and scope of, the patent, and in the light of that interpretation to consider, first, the question of its validity and, secondly, the question of infringement both in reference to the filaments used in the tubes purchased by the plaintiff from the defendant in May and June, 1926, and in relation to the Laise filaments exclusively used as of the date of the bringing of this suit.

The parties introduced in evidence a stipulation, together with certain exhibits annexed thereto, relating in part to the ownership or title to this patent. From this stipulation it appears that shortly after the issuance of the patent, to wit, on May 9, 1916, Anton Lederer acknowledged before the United States Consul General in Vienna as assignment of the patent to the plaintiff, the Westinghouse Lamp Company. This assignment was received in the United States Patent Office August 28, 1919, and there recorded.

It was further stipulated that a copy of this assignment, signed only in typewriting, was legalized before a notary at Aarau, Switzerland, April 12, 1918. On March 3, 1922, the Chemical Foundation, Inc., by its president, acknowledge an assignment of the patent to the plaintiff, which assignment was received and recorded in the United States Patent Office on April 22, 1922.

### Silent As To Delivery Date.

The stipulation and record are silent as to the date of delivery of the assignment of May 9, 1916, and likewise silent in respect to the date and manner in which the Alien Property Custodian purported to effect the seizure of this patent as referred to in the assignment by the Chemical Foundation, Inc., nor is there any evidence in the record as to whether Anton Lederer, during the period that a state of war existed between the United State and Austria, was an enemy alien within the meaning of the statute under which the Alien Property Custodian acted.

The assignment by Lederer acknowledges receipt of consideration and contains a convenant that he will at any time, upon request:

"Execute and deliver any and all papers that may be necessary or desirable to perfect the title to said invention or any letters patent that may be granted therefor in said Westinghouse Lamp Company."

It was orally contended by counsel for the defendant at the time of trial that good title to this patent had not been shown resident in the plaintiff; that there had been a seizure of the patent by the Alien Property Custodian and conveyance by him to the Chemical Foundation, Inc., and that under the trust provision of the charter of the Chemical Foundation, Inc., there was no power to convey any interest in this patent to the plaintiff. No evidence was, however, introduced in respect to any such limitation upon the corporate powers of the Foundation.

The plaintiff contended that title was vested in the Westinghouse Lamp Company by virture of the assignment of May 9 and that the subsequent action by the Chemical Foundation, Inc., was merely a recognition on its part of the rights of the plaintiff in and to the patent.

This Court is well aware of the technical difficulties that defendant could have interposed to plaintiff's title, considering the complexities of the provisions of the statute under which the Alien Property Custodian acted, but, in the absence of any evidence as to when the Custodian acted or as to how he acted and in absence of any evidence as to the provisions of the Charter of the Chemical Foundation, Inc., and in view of the provisions of the assignment of May 9, 1916, and the acknowledgment therein of the receipt of the consideration for the assignment of the patent, this Court is of the opinion that a prima facie case of good title in the plaintiff has been established to the rights, if any, acquired by Lederer by virtue of the letters patent here involved.

We come now to a review or interpretation of the scope and meaning of Lederer's claim of invention. The original application was filed with the Commissioner of Patents on December 2, 1906. In this application, which was for an "Improvement in Incandescent Bodies for Electric Lamps," the applicant presents eight claims of invention.

At the time this application was filed there were in existence several patents and some scientific literature, which are here considered only in relation to the prior state of the art.

The Welsbach patent, which antedated Lederer's application by about eight years, describes the use of the oxid of thorium in conjunction with osmium in the manufacture of an incandescent filament for an electric lamp.

The Just and Hanaman patent issued by the French Republic in May, 1906, describes a method of manufacturing

filaments for incandescent lamps having for its object the attainment of tungsten filments or wires in which the addition of other metals furthers the formation of elongated crystals and procures adequate resistance. Among the more fusible metals suggested to accomplish this effect upon the crystallization of the wire are enumerated thorium and zirconium, which are also referred to by Lederer in the process which he describes.

While the Just and Hanaman patent refers to the inclusion with tungsten of the enumerated more fusible metals, including thorium, in their metallic state, it does include in a latter paragraph the following significant statement:

"Instead of adding to the tungsten metals themselves in an easily pulverizable condition, it is possible also to use their oxids or their other compounds, reducible by carbon. For in this latter case also, the metal is returned to a pure state in the wire after carbonization."

This situation is apparently substantially what Lederer had in mind when in his amended application under date of May 27, 1911, under the title of "Remarks" appended to that amendment he states:

"Applicant does not believe nor does he claim that the oxid which he adds to the paste from which he squirts his filaments remains as such in the finished filament. On the contrary, he claims that instead of remaining conductors of the second class they are converted into conductors of the first, either by a reduction to the suboxid, which is more likely, or by reduction to the metal."

The Belgian patent of 1904 to Siemen's & Halske Corporation was for an incandescent body made of molybdenum, of thorium, of tungsten, of zirconium, or alloys of these metals.

The Belgian patent of 1906 to the Societe Anonyme Reunie D'Electricite related to a partially fused mixture of metallic tungsten with small additions of other metals, among which enumerated classes was included thorium. The patent related to an incandescent body for electric lamps and the admixture of the specified metals was claimed to induce fusing in order to make the filament sufficiently solid and elastic.

The Kellner British patent of 1899, to which repeated reference is made by the Patent Examiner in the file wrapper, was for "Improvements in Incandescent Bodies for Incandescent Electric Lamps and in the Process of Manufacturing the Same." Kellner in his specification states:

Incandescent bodies, according to the present invention, enable the greatest portion of the electric energy supplied to be converted into light, because they can be raised by the electric current to the brightest white heat without becoming deteriorated. These incandescent bodies consist of infusible metals, which are not very good conductors of electricity and which have a high capacity for emitting light, such as thorium, or of almost infusible metals, such as titanium (in the form of pure titanium or nitrid of titanium), chromium, or Wolfram, or alloys of such metals, incandescent bodies made of these infusible or almost infusible metals or alloys being oxidized at their surfaces, or of mixtures of (a) almost infusible metals or alloys of the same, or (b) graphite of the kind which offers the very greatest resistance to conversion into graphite acid by potassium chlorate and nitric acid (graphite of high density up to 2.25 specific gravity) with metallic oxids that are infusible or are fusible with difficulty and capable of emitting light, such as thorium oxid, with or without an addition of cerium oxid.

A review of the patents and scientific literature offered in evidence by the defendant established beyond question that Lederer was not the first to teach the use of either thorium or thoria in conjunction with other metals, including tungsten, in the manufacture of filaments for incandescent bodies. The review of the file wrapper, and particularly the remarks appended by Lederer to his repeated amendments to his specification and claims, indicates this clearly.

### Effect of Mixed Metals.

Lederer was not the first to suggest that the addition of one of the rare earth metals has an effect upon crystallization.

The Just and Hanaman patent, already referred to, specifies as one of its objects the attainment of a tungsten filament "in which the addition of other metals further the formation of elongated crystals."

A study of the prior art indicates that while Lederer, by his patent, was not the first to teach the use of thoria or thorium in conjunction with tungsten, nor the first to disclose the fact that there was a resultant effect on the crystallization of the filament, he was probably the first to emphasize the fact that when the crystal structure of the filament takes a certain form it permits offsetting similar to the effect that would be accomplished by taking a broken wire, or other conductor, and unevenly butting the broken ends together so that at this point the actual area of the conductor would be made small, the resistance to current and heat increased, causing the conductor at that point to burn out.

Lederer added no new element; created no new combination of elements. He observed specifically a result of a combination already taught in the art, which result was only generally suggested in the Just and Hanaman patent where reference is made to the "formation of elongated crystals."

In the remarks appended to the amended application of November 21, 1914, appears the following:

"In asking that this application be reconsidered, applicant requests the examiner to bear carefully in mind the fact that applicant was the first investigator in the metallic lamp filament art to recognize the troublesome phenomenon known as 'offsetting' and to propose a remedy for it."

The remedy proposed was, however, already being employed and its remedial effect partially understood. Lederer investigated further, observed more specifically and procured his patent upon his more specific observation. The most liberal construction must limit Lederer's claim of invention to the prevention of offsetting and within the limits of the teachings of his patent. These teachings are somewhat confused by the contention of counsel that the thoria used in the making of a filament, under Lederer's patent, remains in the wire largely as a nonmetallic inclusion, namely, as ThO2; whereas, the file wrapper discloses that in the course of procuring his patent the inventor's contention was that ThO2 in the finished product did not remain as such, but is reduced to its metallic form or at least a suboxid.

Under date of May 27, 1911, Lederer wrote the patent examiner as follows:

"Applicant does not believe nor does he claim that the oxid which he adds to the paste from which he squirts his filaments remains as such in the finished filament."

The value to the art of the teachings of Lederer's patent is further circumscribed by the fact that as of the time the application was presented all filaments were "squirted" or "extruded" filaments.

**Small Percentage of Thorium.**

Shortly thereafter other patents, including the Coolidge patent, were granted teaching methods of making drawn-wire filaments. These soon superseded, for all commercial use, the "squirted" or "extruded" filaments. No commercial use of Lederer's patent, or information given therein in connection with squirted filaments, appears ever to have been made. If any, it was exceedingly limited.

It is conceded that in the manufacture of drawn wire filaments the percentage of thorium, whether in oxid or metallic form, must of necessity be very small. In commercial use filaments for illuminating purposes employ less than one-half of one per cent and filaments for radio tube purposes not over one and one-half per cent. No one skilled in the art could learn from the specification of Lederer's patent what proportion of tungsten and thorium, in either metallic or nonmetallic form, should or could be used in a drawn wire filament. That problem remained to be solved in the art.

In fact, the discovery of the process by which tungsten could be rendered sufficiently ductile to be drawn is the subject of another patent issued in 1913, the invention of William D. Coolidge. General Electric Co. v. De Forest Radio Co., 28 Fed. (2d) 641.

So far as the patent disclosed, Lederer neither taught nor knew anything about the use or effect of thoria in a drawn wire. He was acquainted only with the action of this ingredient in connection with tungsten when admixed in paste form and extruded as a porous, fragile filament.

To accredit to him the teaching of the effect of using a small and scientifically exact percentage of thoria as now employed in making a wire drawn from tungsten rendered ductile by the Coolidge process would attribute to Lederer knowledge which he did not have and most certainly did not disclose in his patent In fact, there appears to be some basis for the contention that the use of thoria in a drawn tungsten filament to control offsetting is covered by the Coolidge patent. General Electric Co. vs. Independent Lamp Co., Inc., 267 Fed. 824.

The Lederer patent is not a product patent. The possibility of this claim was precluded by the Just and Hanaman patent. General Electric Co. v. Alexander, 277 Fed. 290; 280 Fed. 852; General Electric Co. v. P. R. Mallory & Co., Inc., 294 Fed. 562; 298 Fed. 579.

It is exceedingly doubtful if what Lederer did was invention. It was probably scientific observation without the employment or suggestion of any new combination of materials or the use or adaptability of known elements to a new or different purpose, amounting to a discovery of new characteristics.

But assuming that plaintiff's patent

embodies limited invention and assuming that its specification and claims could be related to the drawn wire filament and the action of thoria thereon of which Lederer knew nothing, still, to establish any basis for a claim of infringement, the plaintiff must show the presence of two factors. First, that a tungsten filament used in a radio tube presents a mechanical problem due to offsetting; and, second, that the wire used by the defendant contains a residue of the oxid of thorium sufficient to obviate to some tangible degree that problem.

**No Mechanical Problem.**

From a review of all the testimony and exhibits, this Court is satisfied that under the conditions which a radio tube of the 201-A type is operated, there is no mechanical problem of offsetting of tangible importance.

Lederer in a paper which is included in the file wrapper as an exhibit to Paper No. 18, which appears to have been published in the Electric Journal in November, 1913, at page 1175, says:

"In the case of tungsten incandescent filaments, which are exposed to very high temperatures, crystallization takes place in a comparatively short time. When used with direct current the thickenings and wrinkles appear only in a longitudinal direction. When burned on alternating current circuits, the adjacent surfaces, owing to the dynamic influence of the surrounding magnetic field, are subjected to a sliding movement which, if it takes place in a direction perpendicular to the axis of the filament, causes considerable displacements of some parts of the filament, which eventually lead to their being separated, as shown in Fig. 10."

The life of the tube under normal conditions is determined by the exhaustion of its electronic emission, not by the rupture of its crystal structure.

The evidence, as was pointed out earlier in this opinion, bearing upon the question of the metallurgical composition of the filament wires used by the defendant, is not satisfactory. From the testimony, this Court is compelled to find, in resepct to the two lots of tubes purchased from the defendant in the spring of 1926, that the filaments contained thoria. It will be recalled that there was no testimony presented by the defendant as to the analysis of the fiia-ments of these or other tubes made from the same wire.

The weight of the evidence in respect to the Laise wire used by the defendant, from a time prior to the institution of this suit, would indicate that its thorium content was in the metallic and not the oxid form. In respect to this wire there was very little testimony presented by the plaintiff, and it of a character which was not convincing in the face of the positive testimony of Mr. Laise, who manufactured the wire, corroborated by the additional expert testimony presented by the defendant.

Lederer, knowing nothing of drawn wire or radio filaments, taught in his patent that an uncertain amount, but not in excess of 7 to 10 per cent, of thoria used with powdered tungsten, with other constituents, as a binder in forming a paste from which to make a squirted filament for an incandescent lamp to be operated with alternating current at the high temperatures necessary for illumination, would so influence the crystal structure of the filament as to retard or prevent offsetting of the crystal segments.

The defendant uses a drawn wire filament which contains a small, but scientifically exact, quantity of thorium (excepting herefrom tubes purchased in June, 1926, made from another filament wire) in the manufacture of radio tubes which are not lamps but mechanical parts of a radio receiving set. These tubes are operated on a different current at only sufficient temperatures to produce electronic emission. Electrons, not ions or light, are the results desired.

**Dismissal With Costs.**

This electronic emission is accelerated by a metallic thorium content and unaffected by thoria. Any incandescence present in the operation of the tube as an incident to the necessary heating of the filament is not utilized in its functioning. If there be present to any degree the so-called phenomenon of offsetting, it is not sufficiently marked to constitute a mechanical problem or, generally speaking, to affect the life of the tube.

The plaintiff asserts, nevertheless, that the use by the defendant outlined constitutes an infringement of its patent. To uphold such a contention would not further, but impede, the progress of the art. It would necessitate a disregard of the intendment of the patent law.

The bill of complaint will be dismissed with costs and an appropriate draft decree may be presented for entry.

April 20, 1929.

## MAY 9

# *An Improvement in Union Suits*

EX PARTE MARY D. NEILSON. APPEAL NO. 13, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1711362 was issued April 30, 1929, to Mary D. Neilson for Union Suits for Men, an application No. 671139, filed October 27, 1923.

Claims 2 and 3, covering men's union suits provided with the usual front and rear closures, and having as a novel feature shoulder straps so designed as to function not only as supports for the garment but as means to effect closing of the openings, were held patentable on appeal. The examiner's rejection on grounds of aggregation was not sustained.

Since no functional relation between the shoulder straps and the closure members were set forth in claim 1, the rejection of this claim for the reason that it presented an agreement was affirmed.

### Means for Adjusting Straps.

The rejection of claims 4 and 5 as being anticipated by references, were sustained. Claim 6, however, relating to special means employed for adjusting the shoulder straps, was held to be patentably differentiated from the art.

Whiteley & Ruckman for applicant.

The full text of the opinion of the Board of Appeals (Assistant Commissioner Moore, Examiners-in-Chief Henry and Landers) follows:

This is an appeal from a final rejection of all claims of the application, six in number.

Claims 1, 4, and 6 are reproduced for illustrative purposes:

"1.—A union undergarment without fastening devices for closures, comprising body and leg portions provided with a self-closing rear opening and provided with a self-closing front opening, and elongated shoulder straps adjustable to the form of the wearer.

"4.—A union undergarment without fastening devices for closures, comprising body and leg portions, the rear part of the body portion being constructed of two extended members each of excessive width sewed together in overlapping relation at the top and bottom only where said pieces join the waist portion and the leg members of the garment, respectively, so as to leave a long central, normally self-closing lateral opening extending down the rear of the garment from the waist and through to the center line of the front of the garment.

"6.—A union undergarment comprising body and leg portions, shoulder straps of excessive length attached at their respective ends to the front and rear of the body portion, said straps being provided with a plurality of buttonholes along their length and the body portion adjacent one of the respective ends of the straps being provided with buttonholes, and fastening devices adapted to cooperate with the last-mentioned buttonholes and selected buttonholes of the straps for supporting the garment in an adjusted position on the wearer."

The references cited are: Cluett, No. 625718, May 23, 1899; Hogan, No. 1116-891, November 10, 1914; Thornton, No. 1198488, September 19, 1916; Heber, No. 1254593, January 22, 1918; Leszczynski et al., No. 1291343, January 21, 1919; Rood, No. 1458547, June 12, 1923.

The claimed construction is a union undergarment having the usual front and rear closures, no fastening devices for the closures being employed. Associated with the undergarment are elongated adjustable shoulder straps, such straps functioning not only to support the garment, but also to effect closing of the openings.

### Rejections by Examiner.

The examiner rejects claims 1, 2, 3, and 5 as aggregative. As to claims 1, 2, and 3 he holds that there is no patentable cooperation between the rear opening and the shoulder straps. Touching claim 3, the examiner holds that there is no cooperation between the rear opening and the front opening.

Appellant urges that there is a necessary and patentable cooperation between the adjustable shoulder strap feature and the self-closing front and rear openings. Thus referring in the brief on appeal to the hang of the garment it is said:

"This hang, so effected, not only permits the garment to be suspended in substantially straight-hanging relation of front and back, but in so doing that pulls the flaps into position so that the openings are held closed, and become in fact self-closing openings."

It is our view that claims 2 and 3 are not aggregations.

Claim 1 is broadly for a union undergarment having front and rear self-closing openings and adjustable elongated shoulder straps. No functional relation is set up between the self-closing openings and the shoulder straps.

If the claim were amended by the insertion of a "whereby" clause at the end of the claim setting up a functional relation, this claim also might be allowed.

We think claim 5 is not an aggregation because it includes both front and rear self-closing openings. Both openings are essential in a garment of the character specified.

The examiner further rejects claim 5 on each of the patents to Thornton, Rood, Hogan, and Leszczynski. Claim 4 is also rejected on the same references.

We think the claims in question are not patentably distinguished from the disclosure of the Leszczynski reference by the statement that the openings are self-closing. No construction is involved in these claims which makes the openings in the garment self-closing.

Nor do we think patentability can be predicated in the particular location of the lines of stitching by which the rear opening is formed.

**Suggestion of Amendment.**

Claim 6 is directed to the special means employed for adjusting the shoulder straps. The claim is not met by the Heber patent, and it is not obvious that the Cluett patent would teach a modification of the Heber adjusting means to produce a construction responding to the claim.

The rejection of claims 1, 4, and 5 is affirmed, attention being directed to the suggestion of an amendment to claim 1 which would render it allowable. The rejection of claims 2, 3, and 6 is reversed.

Limit of appeal to Court of Appeals, 40 days. Rule 149.

## MAY 10

# *Noninvention in Radio Panel*

MARTIN COPELAND COMPANY, APPELLANT, v. PILOT ELECTRIC COMPANY; SAME v. S. S. KRESGE COMPANY. No. 260, CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

THE decree of the District Court holding Design Patent No. 68818, for a panel for radio dials valid but not infringed, was affirmed by the Circuit Court of Appeals for invalidity.

The mechanical parts were found to be functional only, and the general outline and form of the panel was held to be uninventive, not being beyond the range of journeyman designers.

Appeal from the District Court for the Eastern District of New York.

Worthington Campbell, of New York City, for appellant; Asher Blum, of New York City, for appellees.

The full text of the opinion of the court follows:

**Milled Surface of Panel.**

The design is for a panel to cover the dial used in tuning a radio set, and represents a circular plate with a central opening for the condenser shaft, an opening at the top through which to read the dial, and a lower knob, or opening for a knob, to be used for a vernier to turn the shaft. The surface of the panel is represented as milled or cross-hatched, except at the periphery and around the openings. In practice the panels are made of bakelite, and the evidence shows that in pressing this substance it is regarded by many as more convenient and better factory practice not to try to finish the surface smooth, but to leave a rough or hatched surface.

The earlier art disclosed a circular panel with a smooth surface throughout, an opening at the top through which to read the dial, and a vernier knob at the bottom. This was made by the Amrad Company. It was also shown to have been customary upon the surface of the bakelite panels to use a milled or cross-hatched finish. No panel for a radio dial was proved to have been so finished, but the method had been used on ammeter cases, voltmeters, and similar covers. The milling in all these cases stopped short of the edges, which were smooth.

We cannot agree with the learned district judge that the defendant's panel does not infringe, if the patent is valid at all, but we do not think that it is valid. Some parts are clearly functional, and cannot be considered as contributing to the design. We refer to the opening for reading the dial, to the central opening for the knob of the condenser shaft, and to the opening for the vernier knob.

These were conditions imposed upon the inventor by the structural details of the dial which he meant to cover, and not esthetic variations produced by him. There remained only the general outline and form of the panel and its surface finish.

While we should, of course, not assent to the notion that design might not rest in simplicity of outline and proportion, or that a circular panel, though conforming to the shape of the dial, might not display esthetic imagination, perhaps just because of its avoidance of ornament, the shade and proportion of the patent were completely disclosed in the Amrad dial, a more pleasing and expensive one than the design in suit. Nothing was left for invention, except milling or cross-hatching a part of the surface; the Amrad panel being smooth throughout.

It is disputed whether this was more than a convenience in shop practice. The defendant has been at pains to show that to make a smooth bakelite surface is technically troublesome. The plaintiff denies it. We regard the issue as irrelevant in any case. Such surfacing was extremely common in the use of bakelite for not very alien purposes, and we cannot think that its transference to this panel was an example of aesthetic invention. It was no more than a variant which might have occurred to any one, which represented rather convenience than taste, or in so far as it did involve a deliberate aesthetic choice, was not beyond the range of journeymen designers.

Decree affirmed for invalidity.

April 1, 1929.

## MAY 13

# *Insufficiency in Change of Form of Packing Poultry in Boxes*

GEORGE F. HINRICHS, INC., APPELLANT, v. L. C. HENDERSON ET AL. No. 8232, CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

PATENTEE'S claims in Patent No. 1516012 for an article of commerce consisting of poultry packed in boxes in a certain manner and also claims for the method of packing the poultry were found invalid in view of the prior art.

The court ruled that the evidence submitted was conclusive of the fact that patentee's method was substantially the same as that which had been known and used for years in the packing industry, and that plaintiff, in placing the chickens in a slightly more upright position in the box, had merely carried forward an old thought, amounting to a mere change in form, proportion or degree, which is not sufficient as a general rule to constitute invention.

**Decree Below for Defendant.**

Appeal from the District Court for the Eastern District of Missouri.

William Houston Kenyon (Douglas H. Kenyon, Kenyon & Kenyon, and Eliot, Blaney & Bedal were with him on the brief), for appellant; Carl S. Lloyd (Carr, Carr & Gravely were with him on the brief), for appellees.

Before Booth, Circuit Judge, and Johnson and McDermott, District Judges. The full text of the opinion of the court, delivered by Judge Booth, follows:

This is a patent suit in the usual form, involving United States Patent No. 1516012, issued to appellant, plaintiff below, November 18, 1924, application filed September 23, 1922, for poultry packing. The decree below was for the defendant, on the ground that the alleged invention lacked patentable novelty.

The patent has fourteen claims. The first eight relate to an alleged "manufacture," the last six to an alleged "art" or method of packing. Claim 2 may be taken as typical of the first eight claims, and Claim 14 as typical of the last six. They read respectively as follows:

"2. As an article of commerce, a package comprising a container containing a plurality of birds in sitting position placed in opposite rows, thereby providing a free open space between two rows of birds, the tail ends of the sitting birds in engagement with the bottom of the container, and the neck ends in engagement with the top of the container, parts of said birds being placed in engagement where-

by the birds will be maintained in sitting position."

"14. A method of packing poultry consisting in arranging a plurality of fowls in sitting position in opposite rows, whereby leaving a free open space between the breasts of opposite fowls, placing the tail ends of the birds in engagement with the bottom of the box, and sustaining the bodies of the fowls in substantially upright position, said fowls being sustained in part by the mutual relation of the opposite rows of birds."

The elements of Claim 2 are:

1.—A container or box.

2.—A number (usually twelve) of birds (poultry), arranged in the box, (a) in a sitting position; (b) placed in opposite rows, six in a row, with an open space between the two rows; (c) the tail ends of the birds resting on the bottom of the box; (d) the neck ends in contact with the cover of the box; (e) the heads and necks hanging down behind the backs of the birds; (f) the legs of the birds in each row being placed under and in contact with the legs of the birds in the opposite row.

The completed package represents the "manufacture," and the making up or arranging of the package represents the "art" or method of packing.

The defenses are:

1.—Want of patentable novelty in view of the prior art.

2.—Prior use.

3.—Subject matter not patentable under the patent statutes of the United States.

4.—Non-infringement.

**Established Methods of Packing.**

Taking up the first defense, we learn from the evidence that there were a number of different methods of packing poultry in common use, years prior to the application for the present patent. There were so-called "wet pack," and the so-called "dry pack." There was also a "side pack," which consisted in packing the birds on their sides.

Finally, there was the "breast up pack." This "breast up pack," according to the evidence, contained the following elements:

A box with the birds arranged in two rows opposite each other; six in each row; the tail ends resting upon the bottom of the box; the neck ends or upper part of the breasts being in contact with the cover of the box; the heads and necks hanging behind the backs or along the sides of the birds; and the legs of the birds in each row being placed beneath the legs of the birds in the opposite row.

The evidence does not show conclusively that all of the so-called "breast up packs" had all of these elements, but it does show that some of them had all of these elements.

Appellant contends that there are numerous vital differences between the Hinrichs' pack under the patent and the "breast up pack" of the prior art.

First, in the Hinrichs' pack the birds are placed in the box in a sitting posture with their bodies substantially vertical, while in the "breast up pack" the birds are not placed in a sitting posture with their bodies substantially vertical.

Second, in the Hinrichs' pack the birds are locked in place by the bottom and top of the box by reason of their substantially vertical position, while in the "breast up pack" the birds being more nearly in a horizontal than a vertical position, and not so locked.

Third, in the Hinrichs' pack air spaces of notable size occur between the upright breasts of the opposite rows of birds, while in the "breast up pack" there is no such provision of air spaces.

Fourth, in the Hinrichs' pack there is a combination of birds locked in place and of notable air spaces, while in the "breast up pack" there is neither of these elements.

Fifth, the Hinrichs' pack provides an excellent display package, while the "breast up pack" cannot and does not make such a display.

When the foregoing contentions of the appellant are analyzed, they reduce themselves to this: That the pith of the Hinrichs' invention is the angle at which the birds are positioned in sitting posture in the box; that this angle is greater than the similar angle involved in the "breast up pack" of the prior art.

The contention is that this difference causes the birds to be held firmly in position so that they will not shift during transportation, and also provides better air space.

It is to be noted, however, that the plaintiff's patent, neither in the specifications nor in the claims specifies the angle at which the birds are sitting in the box. The term "sitting position" is indefinite. It might range from an exact perpendicular to an angle of forty-five degrees or perhaps even less.

Figure 2, accompanying the patent, apparently shows the birds sitting at an angle of approximately sixty degrees. It is, of course, evident that if the angle

were reduced much below forty-five degrees the pressure of the cover upon the neck ends of the birds would have a tendency to make the birds slide on their tail ends toward the opposite row of birds; whereas if the angle were considerably larger than forty-five degrees the pressure of the cover against the neck ends would have a tendency to hold the birds in an upright position.

### The "Breast Up Pack."

The evidence shows that in the "breast up pack" of the prior art the angle at which the birds were positioned in the box varied from thirty to approximately fifty degrees. It is apparent also that the thrust of the legs of the birds in each row against the legs of the birds in the opposite row would of itself have a tendency to keep the birds in a somewhat upright position, even though the sitting posture varied considerably from the vertical.

This is recognized in Claim 14 of the patent, where is says:

"Placing the tail ends of the birds in engagement with the bottom of the box, and sustaining the bodies of the fowls in substantially upright position, said fowls being sustained in part by the mutual relation of the opposite rows of birds."

It may be conceded that the sitting posture of the birds as disclosed by the patent in suit is more nearly vertical than the sitting posture of the birds in the "breast up pack" of the prior art, as ordinarily adopted. It must be remembered, however, that it is not every change, even though it constitutes an improvement, that is necessarily patentable.

There must be a product or a method which amounts to invention or discovery. The mere carrying forward of an old thought, the mere change in form, proportion or degree is not sufficient as a general rule to constitute invention.

In Smith v. Nichols, 21 Wall. 112, 119, the Court said:

"But a mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent. These rules apply alike, whether what preceded was covered by a patent or rested only in public knowledge and use."

See also Atlantic Works v. Brady, 107 U. S. 192, 199; City of St. Louis v. Prendergast, 29 F. (2d) 188 (C. C. A. 2), and cases cited.

It must also be borne in mind that an inventor is presumed to have had before him all of the prior art at the time he made his alleged invention. Railroad Supply Co. v. Elyria Iron Co., 244 U. S. 285, 291; Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 485; Duer. v. Corbin, &c., Co., 149 U. S. 216, 223; City of St. Louis v. Prendergast, supra.

In view of these principles we think that the slight step taken by appellant in increasing the angle of the sitting posture at which the birds in his boxes were placed did not amount to invention. See City of St. Louis v. Prendergast, supra.

### Lack of Patentable Novelty.

In dismissing the bill the trial court used the following language:

"A consideration of the evidence submitted in the case is conclusive to the effect that substantially the same method of packing poultry as is exhibited by the patent in suit has been long known and widely used by leading packing concerns. Every essential element of this method has been extensively employed by large and responsible concerns at least since 1913 and 1914—10 years prior to the granting of the patent.

"The plaintiff only claims to have placed the chickens in a slightly more upright position in the box. If true, this is not of such significance as to make the result patentable. We find no novelty in either the method of packing or in the package itself."

We think the conclusions thus stated are amply supported by the evidence.

In view of the result reached relative to the defense of lack of patentable novelty, it is unnecessary to take up for discussion the other defenses.

The decree is affirmed.

April 24, 1929.

## MAY 17

# *Refrigerating Devices for Beverages*

EX PARTE THURMAN J. BIXLER. APPEAL No. 1200, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1711581 was issued May 7, 1927, to Thurman J. Bixler for cooling and dispending cabinets, on application No. 129030, filed August 13, 1926.

An apparatus for maintaining bottles of beverage in cold condition during the delivery was held unpatentable in view of the prior art.

Appellant's device, as covered by claim 9, consisting of U-shaped passageways so arranged that the bottles are placed in one of the upper branches of the U and withdrawn from the other branch in a dry condition, was found not patentably different from a prior device in which one passageway was provided with holes permitting the refrigerant to enter the compartment with the bottles, it being stated that it would be merely a matter of choice to stop up the holes so as to dispense the bottles in dry condition, and that duplication of passageways would not amount to invention.

### Citation of Claim 9.

Bennett S. Jones for applicant. Before Kinnan, First Assistant Commissioner; Redrow and Thurber, Examiners-in-Chief.

The full text of the opinion of the Board of Appeals follows:

This is an appeal from the action of the examiner finally rejecting claims 9 and 10. Inasmuch as claim 10 has been recommended as allowable by the examiner, this claim will not be deemed as on appeal.

Claim 9 reads as follows:

"9.—A combined refrigerating and dispensing apparatus comprising a cabinet having a refrigerant containing chamber, and a series of U-shaped dispensing racks disposed in said chamber and independently insertible therein and withdrawable therefrom, each rack being of unitary construction and of noncircular form in cross section and comprising imperforate top, bottom and side walls, whereby said racks are closed against communication with the refrigerant containing chamber of the cabinet, said racks being arranged side by side in the refrigerant chamber with their adjacent walls spaced for the flow of the refrigerant between them."

The references cited are: Britton, No. 1507366, September 2, 1924; Frick, No. 1557578, October 20, 1925; Bell, No. 1638-181, August 9, 1927.

This application relates to an apparatus for maintaining bottles of beverage in cold condition as they are to be delivered and involves U-shaped passageways so arranged that the bottles may be placed in one of the upper branches of the U and withdrawn from the other branch. The passageways are imperforate, so that the refrigerant cannot enter them and the bottles will be delivered in dry condition.

The patents to Frick and Britton show similar apparatus. In Frick the plurality of passages is not independent and cannot be independently removed. In Britton there is only one passage.

### Question as to Openings.

There are openings in both of these structures to permit the refrigerant to enter the bottle chamber. The examiner raises some question about this in the Frick patent, but it is held that his point is not well taken as it seems clear from the specification, page 2, line 92, that the refrigerant enters the chamber.

It is held that there would be no invention in duplicating the structure of Britton so as to employ a plurality of dispensing passageways for handling bottles of different characters. It is further held that if it is desired to dispense the bottles in dry condition it would be merely a matter of choice to stop up the holes for this purpose.

The decision of the examiner is affirmed.

## MAY 18

# *Validity Despite Variation in Design*

ARTHUR DORSEY, APPELLANT, v. PILOT ELECTRIC COMPANY; SAME v. S. S. KRESGE COMPANY. No. 259, CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

DRIGGS Patent No. 1595863, for a dial of a panel board of a radio set, was held not infringed, on the ground that defendant's structure was different mechanically and functionally, the decree of the lower court being affirmed as to this issue.

The court found that the patent device included a knob, washer, cover, disk and scale so associated with a shaft on which the dial was mounted that they would fall to pieces when removed therefrom, whereas the corresponding members in the defendant's device existed as a unit apart from the shaft; also, the patent included a "bearing designed to hold the cover plate against movement away from the panel," a feature not present in defendant's structure.

### Validity of Patent Sustained.

The decree of the District Court holding Patent No. 1618921 void was modified by a holding that the patent was not infringed.

Worthington Campbell, of New York City, for applicant; Asher Blum, of New York City, for appellee.

Appeal from the District Court for the Eastern District of New York.

Before Manton, L. Hand, and Augustus N. Hand, Circuit Judges.

The full text of the statement of facts and of the court's opinion, delivered by Judge L. Hand, follows:

Appeal from decrees in equity of the District Court for the Eastern District of New York holding patent No. 1595863 not infringed, and patent No. 1618921 invalid and not infringed.

The first patent, which issued to one Driggs on August 10, 1925, was for the dial of a panel board in a radio set. It consisted of a circular disk, fitted upon the condenser shaft by an opening in its center. From the center of its outer face projected a threaded boss, upon which fitted a knurled head to screw down upon the boss.

The head had a shoulder, which pressed upon a flanged sleeve, fitting around the boss, likewise having a shoulder. The outer end of this member engaged the shoulder of the knurled head and its inner end pressed upon the paper record blank to hold it tight against the outer face of the disk.

Thus, when the knurled head was screwed upon the threaded boss, the disc, record blank, sleeve, and head constituted a single member, fitted upon the condenser shaft. A set screw or other suitable device held this composite member upon the shaft.

### Cover Provided.

To have left it so would, however, have exposed the record blank and prevented careful observation of the rotation of the condenser shaft. To provide against this a cover was necessary, with an opening having a pointer to register with the scale upon the record blank.

The cover was a circular plate over the record blank and disk, impinging upon the face of the panel or front of the set at its periphery, where it was bent into a flange. The cover was held against the panel by a spring washer, bearing at one edge against the outer face of the cover and at the other against the lower edge of the shoulder of the sleeve.

As the sleeve was pushed towards the panel, when the knurled head was screwed down upon the threaded boss, the washer strained upon the condenser shaft through the set screw and pressed the cover against the panel, thus holding it in place. A bolt in the surface of the panel engaged in a groove in the under edge of the periphery of the cover to prevent its rotation.

The defendant's supposedly infringing apparatus was of the same general character, except that, instead of having a sleeve and a knurled head, it had a unitary head with a shoulder against the under side of which bore a spring washer, the other edge of which bore upon the outer face of the cover. A nut at the inner side of the disk engaged a threaded projection from the head, passing through openings in the cover and disk. An alternative form was to overset the edge of the projection against the inner face of the disk.

### Unified Device Formed.

The cover was thus frictionally held between the inner edge of the spring washer and the disk, so that unless prevented it would turn with the latter. To hold it against rotation after the disk

had been slipped over the shaft it was fastened by a screw at its periphery, which passed through the panel and was fastened by a nut on its inner side. The washer normally exerted no pressure upon the panel, nor strain upon the shaft. The disk, record, head, washer, and cover thus formed a self-subsisting composite member, which was shipped as such.

To set it up it was slipped upon the shaft until the edge of the cover touched the panel. The screw at the periphery was then passed through a hole in the panel and made fast on the inner side, and ordinarily a set-screw fastened the whole to the shaft. In later forms the set-screw was omitted, but only when the section of the shaft was square; the opening in the head being in such cases also square.

Claims 1 and 3 are in suit and read as follows:

"An indicating device for use with a radio instrument having a rotatable shaft extending through a panel which comprises a disk adapted to be fastened to the shaft and rotatable with it, tuning indicia carried with said disk, a cover plate mounted in front of the disk, a knob attachable to the shaft and provided with a bearing designed to hold the cover plate against movement away from the panel of the instrument, and means for preventing the plate from rotating when the knob on the shaft is turned."

"3. An indicating radio apparatus having a panel and a shaft connected to a variable device which aids in tuning to a desired wavelength, comprising a rotatable disk connectable to said shaft, a record blank on said disk, a cover over the disk which has a centrally located aperture, and a knob connected to the shaft through said aperture to turn the same, said knob also serving to exert a pressure which is transmitted to the cover plate for holding it in place."

### Older Apparatus Described.

Patent 1618921 was issued to one Ford, on February 22, 1927, and, so far as here material, consisted of added openings in the face of the cover of a radio dial, whose purpose was to allow the operator to write upon the record the initials of the station corresponding to the graduations upon the scale visible through the first opening. It is not necessary to set out the claims. The defendant had two openings in its cover, a graduated scale appearing in each, one running clockwise and the other in the opposite direction. The purpose of these two was to provide for either right or left handed condensers.

The district judge held the Driggs claims not infringed, and the Ford patent void and not infringed.

L. Hand, circuit judge: The critical question in Claim 1 is the phrase "a bearing designed to hold the cover plate against movement away from the panel," and in claim 3 the phrase "said knob also serving to exert a pressure which is transmitted to the cover plate for holding it in place." It is not enough merely to read the language of the claims; they must be construed with the disclosure. While it is, of course, true that they should not be exactly confined to it, it is equally true that they do not extend beyond its functional significance.

### Meaning of Terms Studied.

There is no high road between these two alternatives, and most patent litigation consists in picking one's way. As in any other written instrument, words are capable of many meanings; we must translate them into the underlying purpose of their user. We have here to ascertain, so far as we can, what Driggs meant, and confine his monopoly to that.

It seems to us that, even literally, the defendant's knob does not hold the cover against movement away from the panel. If the peripheral screw is not set, the dial as a whole is free to move away, except for the set-screw when that is used. Certainly the knob does not so hold it; when properly set, it exerts no pressure on the panel.

The same is true of claim 3. The knob exerts no pressure which is transmitted to the panel to hold it in place. The peripheral screw does that; the only possible pressure is when the whole dial has been pushed down upon the shaft, so as to exceed the existing pressure of the washer. This would be bad practice.

Ignoring, however, merely verbal correspondence, it is obvious that functionally the two devices are wholly different. Driggs established an elastic system anchored at one end to the bearing of the condenser shaft, and at the other against the outer face of the panel. When set up, the thrust of the cover against the panel was equal to the strain upon the bearings of the shaft. The spring washer made the shaft a part of the system. This was not true in the defendant's dial.

We may assume that the washer was essential to the unity of the composite member, made up of the knob, washer,

cover, disk, and scale. But this system did not include the shaft, and was complete without it. When taken from the shaft, it remained a mechanical unit, while Driggs' dial fell to pieces as soon as the shaft and its bearings in the condenser ceased to be an integral part. Manipulation demonstrates, just as speculation would suggest, that unless the pressure between the panel and the cover is very light the leaves of the condenser will be displaced, and perhaps even short-circuited. Nobody disputes that this will have an effect upon the capacity of the condenser.

The claims cannot, therefore, cover the defendant's apparatus, unless we are so far to generalize the disclosure as to include in the invention a quite different combination of parts; that is, unless we omit from the system one of its necessary elements. Driggs suggested nothing of the kind, but by the language of his claims incorporated the specific organization which he disclosed.

The putative commercial embodiments of the patent, Exhibits 8 and 9, are not made in accordance with its disclosure at all. Like the defendant's they are units which subsist independently of the shaft. The patent can gain nothing from their popularity, unless the very question at issue is begged. The actual disclosure has never gone into practical use.

**Issue of Validity Disregarded.**

Of Ford's patent we need say very little. The defendant has not suggested that its second opening shall be used to mark stations corresponding to the other scale. On the contrary, that opening has its own scale, which forbids any such use. It is possible, though extremely unlikely, that some one might clumsily use for such a purpose that scale which he did not need. But it is ill-fitted for the use, and perhaps insusceptible of it. In any case, it would be absurd to forbid the double scale, merely against the chance of such misapplication. We need not pass upon the issue of validity.

Decree affirmed as to Driggs' patent; decree modified as to Ford's, so as to dismiss the bill only for noninfringement.

April 18, 1929.

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## MAY 20

# *Structure of Brush Making Machine*

EX PARTE CONRAD JOBST. APPEAL NO. 1785, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1712216 was issued May 7, 1929, to Conrad Jobst for a patent for Brush Machines, on application No. 10290, filed February 19, 1925.

The feature of transmitting intermittent motion to a work table through the use of a continuously moving cam in lieu of an intermittently moving cam being held to be a common expedient in view of the fact that it is usual in the arts to convert continuous motion into intermittent motion and vice versa, claims 1 to 3, 8 and 9, covering tuft setting mechanism for brush machines, directed to this feature, were found to be unpatentable.

Claim 6, based on the provision of a removable gear mechanism to permit setting of a reciprocating tool and cams in a certain timed relation, was held to be unpatentable for lack of invention.

The decision of the Examiner was affirmed.

Whittemore, Hulbert, Whittemore & Belknap for appellant.

Before Moore, Assistant Commissioner, Examiners-in-Chief Skinner and Ide. The full text of the decision of the Board of Appeals follows:

The applicant appeals from the decision of the Examiner finally rejecting claims 1 to 3, inclusive, 6, 8 and 9.

The invention relates to brush machines. Claims 1 and 6 are quoted as illustrative of the subject-matter on appeal:

"1. The combination with tuft setting mechanism, of a laterally movable work support, an exchangeable cam for operating said work support step-by-step with a predetermined number of steps in the cycle, timed mechanism for continuously operating said cam from said tuft setting mechanism, and a change gear in said timed mechanism corresponding to the number of steps in the cycle of said cam.

"6. In a brush making machine the combination with a reciprocable tool for operating on a brush back, of a laterally movable work support, a pair of cams cooperating to impart, during a complete cycle thereof, a predetermined

number of step-by-step movements in transverse directions, mechanism for operating said cams in timed relation to said tool, and removable gear in said mechanism having teeth proportioned in number to said predetermined number of steps and means for adjustably connecting said removable gear mechanism from said tool operating mechanism to permit the setting of said tool and cams in predetermined timed relation."

The references are: Winkler, No. 1081709, December 16, 1913; Abbey, No. 724231, March 31, 1903; Abbey, No. 724232, March 31, 1905.

**Contention of Appellant.**

It appears to be admitted that the essential elements of the organization claimed are disclosed in equivalent functional relationship by the cited patents. As to Claims 1 to 3, inclusive, 8 and 9, the appellant contends that they are distinguished from said patents in that they recite that the cams are "continuously" rotated.

The appellant points out the desirability of giving to the brush back momentary periods of rest while the tufts are being inserted and admits this is done both by himself and the prior art patents. He contends, however, that in his organization the cams move continuously while the work support has a step-by-step movement, whereas, in the references the cams themselves are intermittently operated. The question for decision, therefore, is whether it involved invention to impart to the work table an intermittent motion through the agency of a continuously moving cam in lieu of an intermittently moving cam. It being common in the arts generally to provide means for converting continuous motion into intermittent motion and vice versa, we are of the opinion that no invention was involved in imparting intermittent motion to the work supports of the patents through the agency of continuously operating cams.

**Invention Not Involved.**

Relative to claim 6, the appellant contends that the references do not disclose—

"means for adjustably connecting the removable gear mechanism from the tool operating mechanism to permit the setting of said tool and cams in predetermined timed relation."

In most all machines the gear mechanism is "removable," and the parts are arranged so as to perform the subordinate functions in a predetermined order or timed relation. Assuming that in the references no special provision is made for the removal of the gear mechanism to permit the setting of the reciprocating tool and cams in predetermined timed relation, still no invention was involved in providing the references with such instrumentalities as may be necessary for properly adjusting the relationship of the gear to the other elements for the stated purpose.

We are of the opinion that the appealed claims define nothing of a patentable nature over the cited patents.

The decision of the Examiner is affirmed.

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## MAY 24

# *Violation Despite Changes in Design*

GORDON FORM LATHE COMPANY, APPELLANT, V. WALCOTT MACHINE COMPANY. No. 5111, CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

PATENT No. 1542803, relating to lathes for turning irregular bodies of metal such as cams, cheek pieces of cranks, etc., was held to be valid and infringed, the decree of the District Court being reversed as to the question of infringement.

The invention, the court stated, resided in means for oscillating the cutting tool of the lathe in synchronism with its reciprocatory movements and the revolution of the work, by the use of an appropriately shaped cam, movable frame and ball crank lever tool support. This structure was found not to be anticipated by the prior art devices as they did not disclose the purpose, the means and the mechanism for accomplishing the end of the patent in suit.

Reference was made to a proposed reorganization of the two prior patents such that the appellant's structure would be evolved but it was concluded that such a structure was not conceived by either patentee and the reorganization "indicated inventive thought."

Claim No. 2 of the patent was found to be readable upon defendant's machine, and a comparison of the operative parts of the two machines indicated that the

same essential elements and the same principle of operation were present in each one. Weight was also given to the fact that defendant's device was not built up until after defendant's patentee had seen plaintiff's apparatus operate, noted its defense, and as a result of his observations redesigned another prior art machine with a view to perfecting it in the light of the defects of the plaintiff's structure.

Before Moorman, Hicklenlooper and Knappen, Circuit Judges. The full text of the opinion of the court, delivered by Judge Hicklenlooper, follows:

The appellant originally instituted its action in equity in the District Court for an injunction and accounting for alleged infringement of patent No. 1542803, issued June 16, 1925, upon application of Charles Gordon and Alfred W. Redlin, filed July 19, 1920, for a lathe. The District Court found the claims in issue valid but not infringed. The parties to this appeal will be referred to by the designations of complainant and defendant, by which they were known in the court below. Claims 1, 2, 12, 23, 24, 28-30, 33, 34 and 39-42 are in issue.

### Relates to Lathes.

The patent in suit relates particularly to lathes for turning irregular or non-circular bodies of metal such as cams, cheek pieces of cranks, etc., otherwise referred to by counsel as nongeometric figures. The separate units of the machine are designed with a view to arrangement in rank and the turning, in one operation, of the multiple cams on an automobile cam-shaft. The patent is here attacked as void for want of invention and, if valid, lack of infringement is urged in defense. The claim of invention is predicated both upon the aggregate organization of the separate units in rank and upon the combination of means for the operation of the single unit. It is apparent, however, that unless invention exists in organizing the single unit, the mere arrangement of such units in rank so as to work simultaneously upon a number of different cams mounted upon a single shaft, would not constitute such invention. We are therefore primarily concerned with the question of invention as it relates to the separate unit of the complainant's machine and, if the patent be found valid, then with the question of infringement by the defendant's machine.

Prior to about 1920 such cams were cast and then rough-ground to approximate dimensions. They were then case hardened and reground to accurate dimensions. Such grinding operations were expensive, dirty, and to some extent dangerous, and Gordon conceived the idea of substituting a turning operation for the initial rough grinding. After hardening, the steel cannot be turned and the final or finishing grinding operation is still practiced. In order to successfully accomplish the turning operation upon a revolving blank, the work being revolved and moved transversely of the cutting tool, the tool must of necessity be moved forward and back in a plane transverse the axis of the work, so as to trace the outline of the finished cam or other work; and such tool must likewise be oscillated in the plane of its reciprocating movement so that it may always maintain the substantially normal cutting angle in relation to the surface of the work and neither skip and scrape nor gouge or "hog" such work.

### Two Cams Provided.

To accomplish these results Gordon and Redlin provided two cams adjacently mounted upon a shaft turned in synchronism with the revolution of the work. Independent of these cams, but suitably placed, a plate or flat rocker arm, referred to as the frame, was pivotally suspended from a supporting shaft. This permitted of a swinging movement to and from the work. To this frame was affixed a roller bearing contacting with one of the cams, and a spring tending to draw the frame toward such cam and to hold said roller in contact therewith. The tool holder was also mounted on the frame adjacent the work and the angularity of the tool to the work was controlled by the other cam and a ball crank lever with roller bearing and spring adapted to hold such bearing upon its cam. Neither of the controlling cams were replicas of the work to be cut but both were more or less arbitrarily designed to accomplish the dual purpose of swinging the tool to and from the axis of the work and of oscillating the tool at or near its cutting edge so that the normal angle of the tool to the work might be continuously maintained.

Of the claims in issue, claims 1, 2, 28, 29, 30, 33, 34, 39, 40, 41 and 42, relate to the tool moving and tool tilting mechanism above described. Claims 12, 23 and 24 relate to matters of general organization and automatic stopping means, and the subject-matter of these claims was not pressed upon argument, is said not to be incorporated in de-

fendant's machine, and is not here considered. Of the claims relating to tool moving and tilting mechanism claim 2 is admittedly typical and reads:

"2. In a lathe the combination of a rotary work holder, a tool holder provided with a cutting tool, movable towards and from the axial line of the work holder and angularly adjustable in a plane transverse to the axis of the work holder, cams adapted to vary the distance between the point of the tool and the axial line of the work holder and to vary the adjustment of the tool for maintaining proper cutting and clearance angles of the tool to work of noncircular contour, means for synchronously rotating the work holder and cams, and means for simultaneously causing relative movement between the work holder and tool holder axially with relation to the work holder."

**Limitations Held Obvious.**

The Gordon and Redlin lathe obviously has its limitations and its disadvantages, if not defects. The tool is pivoted at or substantially at its point, thus requiring it to turn too rapidly and over too great an arc when cutting long-nosed or sharp-pointed cams. This makes it impossible for the tool to follow at normal angularity the desired contour immediately after turning such sharp nose, and there exists a tendency to leave excess metal on the far side of the point. The necessities of commercial construction and the use of the roller upon the tool-reciprocating cam, in which a depression or hollow is used to withdraw the tool from the center of rotation of the work, likewise limits the extent to which the tool can be withdrawn from the axis of the work and thus limits the length of the nose or irregular projection which the device can cut, as a practical matter. Notwithstanding these defects and limitations, a comparatively large number of the machines have been marketed commercially, a great many cams and crank-cheeks have been successfully turned, and some of such machines are still rendering satisfactory service. The general utility of the device as a commercial and operating machine would seem to be established, and if it has been supplanted it is more probable that this was due to the development of the machine which avoids some of the disadvantages of and does some types of work better than the complainant's machine. On the degree of operability necessary, see Hildreth v. Mastoras, 257 U. S. 27, 34.

The broader claims of complainant's patent, numbered 2, 28 and 29, have been the subject of direct adversary contest between the complainant and H. W Melling, inventor of defendant's machine, in several other tribunals. During pendency of the Gordon application in the Patent Office Melling filed his application for patent upon the alleged infringing machine, February 27, 1923. A patent, No. 1512995, subsequently issued October 28, 1924, and defendant's machine is fully described therein. An interference was declared and the interference proceedings passed successively to decision before the Law Examiner, the examiner of Interferences, the Examiners in Chief, the Commissioner of Patents, and the Court of Appeals of the District of Columbia

In each of these tribunals priority of invention of the claims in interference was awarded to Gordon and Redlin. Melling thereupon, brought action under R. S. Sec. 4915, in the District Court for the Northern District of Ohio, making the complainant here defendant therin. The issue thus raised was again decided io favor of Gordon and Redlin. 14 F. (2d) 437. In all of these proceedings, and especially in the last mentioned, the question of patentable novelty was directly presented to the attention and consideration of the several tribunals. Cf. Palmer Pneumatic Tire Co. v. Lozier, 90 Fed. 732-6 (C. C. A. 6). The prior art was fully considered. The interference was not dissolved for want of patentable novelty and the bill under R. S. Sec. 4915 was not dismissed for that reason. While all this may go no further than to bind the parties upon the question of priority of invention, unless there is "thorough conviction to the contrary" (Haughey v. Lee, 151 U. S. 282-5; Computing Scale Co. v. Standard Scale Co., 195 Fed. 508, 515-6 [C. C. A. 6], yet it greatly strengthens the presumption of patentability which arises from the issue of the patent to complainant. Hildreth v. Mastoras, supra, at p. 32.

A definition of what we conceive to be the true inventive step of Gordon and Redlin, in the light of prior practices and in view of the prior art patents, at once disposes of the question of anticipation and confirms us in the opinion held by all other tribunals considering the question, including the District Court in this action, that invention is disclosed by the patent to complanant. In

determining such inventive step the court must first look to the state of the art. Eibel Co. v. Paper Co., 261 U. S. 45, 63. The prior art patents most strongly relied upon and clearly the most pertinent, are those to Brophy, No. 649905, May 22, 1900, and Montreuil, No. 701217, May 27, 1902.

The patent to Montreuil related particularly to turning articles of elliptical form in cross-section. By the employment of a sliding tool support as a part of two pantographs tied together by link arrangement and moved by an eccentric of proper size making two revolutions to each revolution of the work, the tool was made to traverse a circular orbit in synchronism with the recolution of the work and at the same time to maintain substantially the normal angularity to the work. By the means employed the Montreuil lathe could turn only an ellipse and the patent neither suggests nor discloses means for turning an irregular or nongeometric figure. The patent does not suggest the necessary function of tool movement, reciprocating in a plane perpendicular to the axis of the work, with the maintenance of the normal angularity of tool to work, but manifestly no patent may issue for these functions but only for the means of elements of the machine by which the result is accomplished.

The same observations are applicable to the patent to Brophy. This invention related to an attachment for automatic lathes and had for its object the provision of mechanism for cutting eccentric grooves in a metal blank. During the initial period of operation the Brophy lathe operated as the ordinary engine lathe. Such operation was continued until the point was reached at which it was desired to cut the eccentric, that is, until metal had been cut away from the outer circumference of the blank to the outer point of the circumference of the eccentric, and thereafter crescents were cut from the blank, opposite the outer point of the circumference of the eccentric, by employing a spring and cam to force the tool forward upon rotation of the work. Since the eccentric thus being formed passed in a circular orbit about the axis of the revolving work it likewise became necessary for the cutting edge of the tool to perform an orbit and this was accomplished, and substantially normal angularity to the work was maintained, by the use of an eccentric cam to tilt the tool holder synchronously with its reciprocatory movement and the revolution of the work. This patent also recognizes the necessity of synchronous reciprocatory movement of the tool and an oscillation of the tool to maintain its normal angularity to the work. Brophy neither suggests nor discloses means for cutting other than an eccentric of geometric form.

The patents to Huston, No. 494864, and to Diehl, No. 607,987, more remotely pertinent, are for metal cutting mechanisms of the boring mill type. In Huston the tilting of the tool to maintain the normal cutting angle is not considered a necessary function but the use of cams to control the path of the tool in conjunction with a turning of the tool upon its axis vertical to the surface to be cut is disclosed. The same necessity of turning the tool to cut an ellipse in a plate upon a revolving work table is disclosed in the patent to Diehl and by Diehl this result is accomplished by the use of an eccentric instead of the cams of Huston. Neither Huston nor Diehl discloses the Gordon mechanism.

In none of the patents cited is any effort shown to devise, or disclosure made of, means for oscillating the tool, in synchronism with its reciprocatory movements and the revolution of the work, by the use of an appropriately shaped cam, movable frame and ball crank lever tool support. None contemplates the turning of irregular or non-geometric forms. Those patents cannot be considered as anticipations which do not disclose the purpose, means and mechanism for accomplishing the end of the patent in suit and which are restricted, by the mechanisms disclosed, to the accomplishment only of a substantially different and limited purpose. Eibel Co. v. Paper Co., 261 U. S. 45, 66; Canada, et al. v. Michigan M. Iron Co., 124 Fed. 486, 493 (C. C. A. 6); Munising Paper Co. v. American Sulphite Pulp Co., 228 Fed. 700, 703 (C. C. A. 6); Hobbs, et al. v. Beach, 180 U. S. 383-392; Fulton Co. v. Bishop & Babcock Co., 284 Fed. 774-7 (C. C. A. 6). Cf. Outlook Envelope Co. v. General Paper Goods Mfg. Co., 238 Fed. 877 (C. C. A. 2). It is true that the mechanism of the Brophy patent can be so reorganized as to cut a cam or other non-geometric figure but this is done only by substituting for the eccentrics of Brophy the more or less arbitraily shaped and specially designed separate control cams of the patent in suit. Such reorganization constitutes incorporating into the machine of Brophy the essence of the Gordan invention to accomplish the Gordon result. Such an organization was neither conceived nor

disclosed by Brophy, and the possibility of reorganization so as to reveal in the machine of Brophy the actual disclosures of Gordon will not convert the patent to Brophy into an anticipation. Cf. Topliff v. Topliff, 145 U. S. 156, 161; Clough v. Barker, 106 U. S. 166, 175; Rockwood v. General Fire Extinguisher Co., 8 F. (2d) 682-686 (C. C.A. 2); Block v. Nathan Anklet support Co., 9 F. (2d) 311-2 (C. C. A. 2). As stated by the District Judge, the reorganization itself "indicated inventive thought."

If we are to look to the prior art and the specifications to determine the true nature of the invention, the precise inventive step of Gordon and Redlin would seem to lie in combining with the means for producing reciprocatory movement of the tool, old in the art, the means for controlling the oscillatory movement of such tool by a separate and specially designed cam, spring and ball crank lever, in such organization that the means for both reciprocatory and oscillating movement, working in synchronism with each other and with the rotation of the work, could cut a cam, crank cheek, or other nongeometric form. Although the demand for such a machine tool had long existed, such combination had not before occurred to anyone. The devices of Brophy and Montreuil though adaptable were not accepted by the trade and so adapted. Such facts strongly indicates that the changes were not obvious and involved more than mechanical skill. Plotts v. Creager, 155 U. S. 597; Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 428. The present patent is in a very true sense generic and the patentee a pioneer in this particular branch of the art. The machine had commercial utility and was accepted by the trade and its manufacture was reasonably successful until thrown into competition with the infringing machine which avoided the chief defect, heretofore mentioned, and did not have some of the limitations of the patented device. The claims of the patent in suit were considered as entitled to broad, liberal construction in the Patent Office proceedings, by Judge Westenhaver in the proceedings under R. S. Sec. 4915, and by the District Judge below. We think that such claims are entitled to this liberal construction and concur in the opinion of the other tribunals that the patent discloses invention and is not anticipated, and that the generic claims are valid.

We then turn to the question of infringement. It is in evidence that Melling, the designer of defendant's machine, was called upon as an expert in mechanics to inspect one of the complainant's machines in operation at the plant of the Jackson Motor Shaft Company. Upon arrival he found that the tool left "a lump on the work just below the nose of the cam" by reason of the rapidity with which the tool oscillated on turning the nose, and that the noise and jar of the ball crank lever falling upon the cam controlling this motion was such as to convince him that the design was impractical. Melling then went to his shop and with sketch and model cams, plates and rollers, commenced to experiment for the adaptation of the principle of the Blanchard lathe to supply the reciprocating motion of the tool.

The Blanchard lathe was old in the art and while it itself had been used exclusively in wood turning operations, the principle of the Blanchard lathe had been used in the rough grinding of cams prior to Gordon. In the Blanchard lathes a pattern is used of the precise shape and dimensions of the cross-section of the finished work. The cutting means used is a circular cutter with multiple teeth or, in the grinding operations, a grinding wheel. This cutter is mounted adjacent the work upon one end of a reciprocating carriage or frame. On the other end of this frame is mounted a circular and revolvable guide plate bearing upon the pattern cam. The distances between the axes of the pattern cam and the work is the same as that between the axes of the cutter and the guide plate. The work and pattern are on the same relative sides of cutter and guide. The guide plate is held firmly against the pattern cam by spring tension and the reciprocatory movement of the cutter to and from the work, to produce in the work a replica of the pattern, is thus produced by equality of revolution of the work and pattern cam.

The use of the Blanchard lathe, as such, invloves no question of oscillation of the cutting tool. It is obvious that in order to produce in the work, in cross-section, a replica of the pattern cam, the diameter of the circle traveled by the teeth of the revolving cutter must be exactly the same as the diameter of the circular guide plate. Thus as the pattern cam and work are revolved at equal speed, the cutting edges of the tool successively maintain the same relative position on the work as the point of contact of the guide plate maintains on the pattern cam. It is also obvious that where

the pattern used is cam-shaped or irregular in design, the point of contact between the nose of the cam and the guide plate, and hence the point of cut on the work, will at times be above and at times below the plane of the axes of the work, cutter, pattern and guide.

It is insisted that Melling simply applied the principle of the Blanchard lathe in designing his machine, substituting a single oscillating tool for the revolving circular cutter of the Blanchard lathe; and that by reason of the adoption of the principle of the Blanchard lathe, the tool being pivoted at a point the same distance from its cutting edge as the radius of the circular guide plate (assumed to be substantially remote from the cutting edge), the size of the arc through which the tool must oscillate in passing over the nose of the cam is very materially reduced and the fact that the tool follows the point of the cam from above the horizontal plane, around the point and down below the horizontal plane, so far reduces the time required in making the turn and the jar of the ball crank lever roller upon the control cam, as to make a practical success of the Melling machine and avoid the features of disadvantage in the Gordon machine. Thus it is urged that the Gordon and Melling machines operate upon entirely different principles, the tool of Gordon tilting upon its cutting edge while the tool of Melling oscillates upon a point remote from such cutting edge; the cutting edge of the tool of Gordon reciprocating substantially in a straight line, the edge of the Melling tool traveling in a marked orbit; and the lathe of Melling following the teachings especially of the Blanchard lathe with the orbital movement of the tool of Brophy and Montreuil, while Gordon and Redlin take a step backward in the art by abandoning such orbital movement of the tool except to an infinitesimal, theoretical degree.

The above-quoted claim unquestionably reads upon the defendant's machine and if we go further and compare the operative parts of the two machines we find the same essential elements in both. As said by the law examiner in the Patent Office interference proceedings: "Each machine comprises as its essential elements, a rotary work holder, a cutting tool, a tool supporting member movable transversely to the work holder, a tool holder adjustably mounted on the tool supporting member, work shaping and tool adjusting cams cooperating with the tool supporting member and the tool holder, respectively, to vary the distance between the tool and the axis of the work holder, and to control the angular relation of the tool to the work, and means for rotating the work holder and the cams synchronously. And in each machine the cam that moves the tool supporting member towards and from the work holder is so shaped as to give the desired form to the work." To this definition of similarity of means might be added that in both we find the ball crank lever with its roller bearing as the means of transmitting the oscillatory movement from the control cam to the tool.

### Immaterial in Principle.

The fact that in Melling the tool supporting member is apparently pivoted at a point remote from the cutting edge of the tool is immaterial in principle since the point of pivot is controlled entirely by the size of the circular guide plate which is used. Convert such guide plate into a revolving pin of small dimensions and the point of pivot would be brought substantially to the point of cut. The Melling machine would then be able to cut a design with hollow or dimple which it cannot now do. The fact that the ball crank lever and control cam would then have to be redesigned and the objection that the Melling machine would then be subject to the same disadvantages or defects as the Gordon machine, do not detract from the position that in principle the functions and the elements of the two machines are substantially the same. This is the more apparent when applied to the difference in the pattern cams used to control the line of cut. In the Melling machine the pattern is a replica of the finished work and the spring tension impels the frame toward the work, holding the guide plate firmly against the pattern. In the complainant's machine the work and pattern cam are on opposite sides, respectively, of the tool and the roller member controlling the reciprocatory movement. The spring urges the frame away from the work, thus holding the bearing tightly against the pattern cam. In the complainant's machine therefore the pattern cam is not a replica but substantially the reverse in shape to the pattern of Melling. The principles, however, are identical.

Melling did not pattern his machine upon the Blanchard lathe in so far as the tilting of the tool was concerned for the principle of the Blanchard lathe contemplated only a revolving circular cutter head. The only suggestion drawn by Melling from the Blanchard lathe lay in the observation that in a design of that

type the radius of the circular cutter at the point of cut was always perpendicular to the tangent of the work,—the ideal result,—and that the arc of oscillation of the point of cut from above the horizontal plane, around the nose of the cam, and thence beneath such plane, was of much less degree than the arc of oscillation necessary in complainant's design. The observation did not solve the problem.

**Reciprocal Motion.**

The principle of the Blanchard lathe produced reciprocating movement only, which was inoperative to cut with a single tool a non-geometric figure upon the revolving work unless the tool were also given oscillating movement to maintain the normal angularity of the tool to the work. To produce this oscillation Melling turned to and appriated the cam and ball crank lever construction of the complainant, thus producing the desired end by practically identical means used by Gordon. Morley Machine Co. v. Lancaster, 129 U. S. 263-281; Cimiotti Unhairing Co. v. American Unhairing Machine Co., 115 Fed. 498-504 (C. C. A. 2); Lourie Implement Co. v. Lenhart, 130 Fed. 122, 129 (C. C. A. 8). This fact was suggested by the court below when the witness Melling was asked: "Well, didn't you get the suggestion of mounting the single cutter on an arm that in some way would rock, changing the relation of the cutter to the tangent of the work, from the Gordon and Redlin machine?" This question was not satisfactorily answered and it is at least worthy of note that the means used bear such close functional and physical relationship to those employed by Gordon and Redlin and that the organization involving their use did not occur to Melling until after he had inspected the complainant's machine in operation.

As we have said, the elements of cam and ball crank lever to rock the tool, in combination with means for reciprocatory motion of the tool constituted the essence of Gordon's inventive step. The patent is considered by us as a primary or generic one and the claims are entitled to great liberality of construction. Doubtless the use of the Blanchard lathe principle to produce reciprocatory movement, the use of the circular guide plate of relatively large proportions, as compared with the work, and the resulting pivoting of the tool at a point substantially removed from its point, was a valuable improvement which perhaps was patentable as such. But superiority of operation does not of necessity negative infringement. Schiebel Toy, etc., Co. v. Clark, 217 Fed. 760, 771; Toledo Mach. & Tool Co. v. Bliss Co., 287 Fed. 443, 447 (both C. C. A. 6). Applying the doctrine of broad equivalents properly applicable to generic patents, the variation between the conceptions of Gordon and Melling did not take the machines of Melling out of the domination of the claims awarded to Gordon and Redlin. Hildreth v. Mastoras, 257 U. S. 27, 36; Temco Electric Motor Co. v. Apco Mfg. Co., 275 U. S. 319, 328; Hoyt v. Horne. 145 U. S. 302, 309; Otto Coking Co. v. Koppers Co., 258 Fed. 122-135 (C. C. A. 3).

Tersely expressed, our opinion is that Melling accomplished the same result as Gordon, perhaps more efficiently, mechanically, but nevertheless by the employment of substantially the same means, or their equivalents, operating in substantially the same manner. This has universally been held to constitute infringement and we so hold. Machine Co. v. Murphy, 97 U. S. 120; Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 568-9; Schiebel Toy & Novelty Co. v.. Clark, supra; Allen v. Wingerter, 17 F. (2d) 745-7 (C. C. A. 3).

Such decision is, of course, applicable to both defendant's cam cutting and crank shaft contour lathes, in both of which the patented combination of elements appears.

The judgment is reversed so far as the finding of noninfringement is concerned, and the cause is remanded for further proceedings consistent with this opinion.

April 12, 1929.

MAY 25

# Device Lacking One of Claimed Parts

AUGUSTUS M. ROSSI v. WILLIAM BARCLAY. IN EQUITY NO. 98, DISTRICT COURT FOR THE DISTRICT OF VERMONT.

THE court in this case held that where a patentee claims a device as consisting of a combination of old elements he cannot be allowed, in order to hold the defendant as an infringer, to prove that any part of the combination is immaterial or useless, it being stated that a combination is an entirety and that if one of the elements be given up the thing claimed disappears.

Applying this doctrine to this suit, the court concluded that patent No. 1242983, for a stone sawing machine, including two sources of power, one of which rotates the saws and feeds the stone-supporting cars proportionally toward the saws, and the other source of power rapidly positions the cars to the saws without rotating the saws, was not infringed by defendant's structure which did not read in terms on the patent claim and which did not employ an equivalent of the means covered by the patent for causing cooperative action between car feeding and saw operating means.

John W. Gordon and Deane C. Davis of Barre, Vt., for plaintiff; H. M. Weidner of Boston, Mass., for defendant.

The full text of the opinion of the court, delivered by Judge Thomas, follows:

This suit involves the alleged infringement of Rossi patent No. 1242983 for a stone sawing machine, granted to the plaintiff on October 16, 1917, on an application filed March 21, 1917.

The defenses are noninfringement, and invalidity by reason of anticipation by and lack of invention over prior patents, publications and the prior art.

The single claim of the patent reads as follows:

"In a stone sawing apparatus, in combination, an inverted U-shaped framework, a saw adapted to revolve in a vertical plane between the legs, a pair of cars adapted to travel upon tracks on the opposite sides of the saw, a shaft at the top of said framework, two sources of power associated with the framework and adapted to be connected with said shaft means connecting said shaft and saw whereby they rotate together, means connecting said shaft with the cars for moving the cars with respect to the saw and clutch mechanism for operatively connecting one source of power with said shaft for rotating the saw and feeding the car proportionallly or to connect with the other source of power to rapidly position the car with respect to the saw without rotating the saw."

In the specification the inventor says that this invention relates to a stone sawing machine and that "the apparatus is designed primarily for handling relatively large blocks of stone, and comprises a pair of rotatable saw blades mounted in a suitable frame and adapted to operate upon a block of stone carried by two cars positioned at opposite sides of the plane in which the saw blades lie, the cars being automatically fed as the saw blades revolve."

The patented machine comprises an inverted U-shaped framework upon which are rotably mounted two horizontally disposed shafts, each having fixed to it a circular or disk saw revolving in a vertical plane, the lower saw blade dipping into the usual shot and water pit. A pair of stone-supporting cars is adapted to travel upon tracks on the opposite sides of the saws. In order to obtain the desired speed of the cars with respect to the rotation of the saws each car is provided with a rack member. These rack members mesh with pinions mounted on shaft 47, the latter being journaled in suitable bearings on the frame. These shafts are operatively connected with a countershaft 57, which is constructed in two sections between which is interposed a clutch. One of these sections is permanently yet operatively connected with the pinions which mesh with the racks on the cards, so that when the last-mentioned counter-shaft section is rotated in either direction, the cars will be correspondingly moved along the tracks. The other section of the countershaft is permanently and operatively connected by a speed reduction mechanism to a shaft 70 (shown in Fig. 3 of the patent drawings), which is permanently yet operatively connected to the saws, so that when the shaft 70 revolves the saws will be rotated, and, by action of the speed reduction mechanism, that countershaft section which is conected with the shaft 70 will revolve but at a reduced speed compared with the speed of the shaft 70. An elec-

tric motor 66 is provided for actuating the shaft 70 when power is applied to the motor and the two counter-shaft sections are connected by means of the clutch, the saws are rotated and the cars fed with respect to the saws at a speed proportional to the speed of rotation of the saws. A second motor 61 is connected by a belt 60 to that section of the counter-shaft which is permanently connected with the car feeding mechanism. This belt may be operatively connected to, or disconnected from the last mentioned counter-shaft section by fast and loose pulleys 58 associated with said counter-shaft section. A belt shifter 62 is provided for shifting the belt 60 on either the fast or loose pully. So, when the clutch is set to disconnect the two sections of the counter-shaft and the belt shifter is operated to place the belt 60 on the fast pulley, the motor 61 when in operation, will move the cars rapidly, that is, it will return them rapidly to their initial positions where they receive the stone. It is obvious that if, under these conditions, the operation of the motor 66 is discontinued the saws will not be rotated.

From the foregoing description of operation it is apparent that the patented stone sawing machine is equipped with two sources of power—one of which serves to rotate the saws and to feed the stone supporting cars proportionally toward the saws, while the second source of power serves to rapidly position the cars with respect to the saws without rotating them.

The claim of the patent is one for combination of elements, specifying a singly rotary saw, which, obviously, may be of any suitable construction. There is no claim in the patent for the saw per se and, as appears from the file wrapper and contents of the patent, no such claim could have been embodied in it. It follows, therefore, that the defendant is at liberty to use in the alleged infringing machine the very saw disclosed in the patent in suit, provided all the elements of the combination claimed are not employed. The Corn-Planter Patent, 23 Wall. 181, 224. Rowell v. Lindsay, 113 U. S. 97, 101. In the Corn-Planter Patent case, on page 224, Mr. Justice Bradley said:

"Where a patentee, after describing a machine, claims as his invention a certain combination of elements, or a certain device, or part of the machine, this is an implied declaration, as conclusive, so far as that patent is concerned, as if it were expressed, that the specific combination or thing claimed is the only part which the patentee regards as new."

The saw shown and described in the patent in suit is open to the public for use under the circumstances mentioned, although the record clearly proves that it is highly successful in operation and materially increases the cutting speed and is more durable in use than any other stone cutting saw employed prior to plaintiff's invention.

In the defendant's machine the cars are moved along the tracks by a motor which is operatively connected to the cars through a change speed gearing so that the motor may move the cars at various selected speeds by suitably positioning the gear shift lever. The cars are moved by this motor, and a reverse switch is employed for reversing the direction of rotation of said motor. Defendant's machine has a set of upper and lower saws. The upper saws are rotated by one motor and the lower set of saws by another motor. Neither one of these last mentioned two motors moves or is adapted to move the cars, and the motor which operates the cars does not and cannot rotate either set of saws. From this it is obvious that defendant's machine does not include a single source of power for rotating the saw and feeding the cars proportionally, or otherwise; nor does it include a clutch mechanism or any other means for operatively connecting one source of power with the saw shaft and with means for feeding the car proportionally, or with another source of power for rapidly positioning the cars with respect to the saw without rotating the saw. Consequently the claim of the patent in suit does not read in terms on the defendant's machine.

This is admitted by plaintiff who argues, however, that defendant's machine comes within the terms of the claim if the doctrine of equivalents is applied and he maintains that the defendant's change speed gearing is the equivalent of the clutch of the patent in suit. Defendant, on the other hand, contends that this is not the case and avers that he has omitted certain elements of the combination, among which is the means of mechanism which causes a single source of power to operate the saws and feed the cars proportionally without substituting equivalent mechanism. In other words, defendant contends that he has omitted one or more elements of the patented machine attended by corresponding omission of the function performed by that element or those elements. Plaintiff's

answer to this argument is that the mechanism for causing cooperation between the car feeding means and the saw actuating device is not the essence of the invention.

But it must be remembered that the claim of the patent is a combination claim. In such a claim, if the patentee specifies any element as entering into the combination, he makes such element material to the combination and the courts cannot declare it to be immaterial. It is the patentee's province to make his own claim and it is likewise his privilege to restrict it. If, as granted, a claim is to a combination and is restricted to specific elements all must be regarded as material, leaving open only one question and that is whether or not an omitted part is supplied by an equivalent device or instrumentality. Fay v. Cordesman, 109 U. S. 408; Water-Meter Co. v. Desper, 101 U. S. 332; Gage v. Herring, 107 U. S. 640.

In the Water-Meter case, on page 337, Mr. Justice Bradley enunciated the rule in the following language:

"Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, we cannot declare that any one of these elements is immaterial. The patentee makes them all material by the restricted form of his claim. We can only decide whether any part omitted by an alleged infringer is supplied by some other device or instrumentality which is its equivalent."

The rule is well settled that a patentee, in a suit for infringement of an invention consisting of a combination of old elements cannot be allowed to prove that any part of the combination is immaterial or useless. In Vance v. Campbell, 66 U. S. 427 it was held where a patentee sues for an infringement and declares upon a combination of elements which he asserts constitute the novelty of his invention, he cannot, in his proofs, abandon a part of such combination and maintain his claim to the rest. Much less can he prove any part of the combination immaterial or useless. The combination is an entirety and if one of the elements be given up the thing claimed disappears.

The specification in the patent in suit contains no suggestion that the particular arrangement of the parts causing a cooperation between the car feeding means and the saw operating device may be dispensed with. So when a patentee has in his patent, carefully and specifically pointed out the details of a construction, which details, as he shows them, discharge a stated function, it is not for the courts to declare them immaterial. Philadelphia Novelty Manufacturing Co. v. Weeks, 61 Fed. 405. Each of the elements set forth in this claim is distinct in its character and clearly and specifically described, and there is nothing in its structure to make it an exception to the general rule that every part of a combination claimed is conclusively presumed to be material, so that if one of its elements is omitted the thing claimed does not exist. James Spear Stove & Heating Co. v. Kelsey Heating Co., 158 Fed. 622.

In view of the foregoing conclusions it remains only to be decided whether the change speed gearing of defendant is an equivalent of that means of the patented machine which causes a cooperation between the car feeding mechanism and saw operating device. It is well settled, as was held by Judge Manton, speaking for the Circuit Court of Appeals in Superior Skylight Co. v. August Kuhnla, Inc., 273 Fed. 482, 486:

"that within the rule of equivalents the thing thought to be equivalent must be shown to perform the same function and to do it in substantially the same manner as the thing of which it is alleged to be the equivalent."

I am fully convinced that the two mechanisms above referred to are not equivalents. It may be argued that the change speed gearing in defendant's machine may be set initially so as to advance the cars toward the saws in some proportion to the speed at which the saws revolve. It is obvious, however, that if for some reason the speed of the saws changes the traveling speed of the cars would not be influenced thereby because the saws and cars are actuated by independent motors. Consequently, defendant's mechanism does not perform the function of the plaintiff's device. Even if it did do this initially, when set by hand, it does it in a substantially different manner than the corresponding element of the patented combination.

In view of the foregoing it is unnecessary to go into the validity of the claim. It may be said, however, that the invention, as the record shows, is not a pioneer invention and if the claim is valid at all it must be restricted to the precise combination set forth in the claim of the patent.

Finding that the defendant does not infringe the bill is dismissed with costs to abide the event.

Decree accordingly. May 4, 1929.

# Seamless Drawn Tubular Unit

EX PARTE BARNHART. APPEAL NO. 877, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1711824 was issued May 7, 1929, to George E. Barnhart for tapered drawn structural element, on application No. 121781, filed July 12, 1926.

The rejection of claims 1, 2 and 4 to 7, covering a seamless drawn tubular structural unit, was affirmed, it being found that one reference showed the structure called for, except that the metal was rolled and welded at the adjacent edges, and another patent disclosed the feature of making seamless tapered tubes by drawing.

Franklin L. A. Graham for applicant. The full text of the opinion of the Board of Appeals (First Assistant Commissioner Kinnan, Examiners-in-Chief Henry and Ruckman) follows:

This is an appeal from the final rejection of claims 1, 2 and 4 to 7, inclusive. Claim 1 is illustrative and reads as follows:

"1. In means of the general character described, a seamless drawn tubular structural unit having a uniform longitudinal taper both internally and externally, the ratio of fiber to cross sectional area increasing in the direction of diminishing diameter."

The references relied upon are: Mannesmann, 545901, September 10, 1895; Reynolds et al., 616357, December 20, 1898; Tafel, 765053, July 12, 1904; Duff, 1574563, February 23, 1926.

Claims 1, 2, 4, 5 and 6 are rejected on the patent to Duff in view of the disclosure in Reynolds et al. Duff shows the structure called for in these claims except that the metal is rolled and welded at the adjacent edges.

Reynolds shows that it is old to make seamless tapered tubes by drawing, and in view of this disclosure there is believed to be no invention in forming the structure of Duff by the drawing process. For a similar reason we find no invention in claim 7 over the disclosure of Tafel in view of Reynolds et al.

The action of the examiner is affirmed. Limit of appeal to Court of Appeals, 40 days. Rule 149.

## MAY 27

# Confection Frozen Upon Handle

THE POPSICLE CORPORATION, ET AL, PLAINTIFFS, V. ISADORE WEISS, DOING BUSINESS AS GOODY FROZEN PRODUCTS CO., DEFENDANT. IN EQUITY NO. 46-58, DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK.

THE Burt patent No. 1470524 and Epperson patent No. 1505592, directed to the process of freezing a confection upon a handle, producing a product that is conveniently carried during consumption, were held valid and infringed.

Patent No. 1470524, restricted to a process wherein a stick adapted to serve as a handle is placed in a confection that in fluid at normal temperature and the product is then subjected to refrigeration during which the confection becomes attached to the handle by congelation, was found patentably distinguished from a lollypop in which the confection is a pasty sticky mass and is not liquid at ordinary temperatures, and from a prior patent disclosing a substance frozen to a metal handle having no pores into which water could enter to form a bond and a flexible looped cord to facilitate handling the ice but which could not be used to hold a confection while being eaten.

### Process Held Valid.

The process of Patent 1505592, relating to a "drink on a stick" and consisting of a liquid, including flavoring matter and sugar, frozen to a handle, the confection being eaten by sucking the extract and sugar therefrom leaving a tasteless mass of snow and ice, was also held valid over the prior art which did not disclose the patent process.

The court also ruled that a license to use plaintiffs' process can not be implied from the sale of the mold to the defendant in the absence of evidence that defendant purchased them from someone authorized to sell the molds, without restriction, and in view of the fact that they are capable of use for purposes other than carrying out the process of the patent.

Morris Hirsch, by Clair W. Fairbank,

Irving M. Obreight, Morris Hirsch and Jacob Ansbacher, for plaintiffs; Phillip S. McLean, for defendant.

The full text of the opinion of the court, delivered by Judge Bondy, follows:

This is a suit for infringement of claim 1 of the Burt patent 1470524, dated October 9, 1923, and claims 1 to 5 inclusive of the Epperson patent 1505592, dated August 19, 1924.

Defendant's counsel admitted during the trial that if the patents are valid, they were infringed by the defendant.

Claim 1 of the Burt patent covers: "The process of making a frozen confection which consists in bringing a handle member in contact with a body of edible substance which is fluid at normal temperature, and subjecting the body to refrigeration, whereby it is solidified and thereby attached to the handle by congelation."

In re Burt, 24 Fed. (2d) 273, the Court of Appeals of the District of Columbia held the product to be patentable for reasons which, in my opinion, apply to the process as well as the product. It stated:

"To insert a stick in a small cake of frozen ice cream would break the cake apart and if the cream was less hard the stick would not adhere sufficiently to permit handling. Of course, to be a success the union between the stick and frozen cream must be such as to permit the eating of the cream without breaking the union and to make this result attractive to the public, it must be accomplished without human hands touching the article in the process of manufacture. Finally, Mr. Burt hit upon the idea of freezing the stick in ice cream: that is, by inserting the stick in the cream before freezing and then subjecting the mass to refrigeration. His experiments demonstrate that such a process created desired union between cream and the stick. The product was placed upon the market and has become a great success."

Burt provides a frozen confection which will stay on the stick until entirely consumed, by the application of refrigeration after the insertion of the stick, the frozen crystals of the confection extending into the pores of the stick from the body of the material so as to form an effective bond.

A method of uniting a frozen confection to a stick was unknown to the art of making frozen confections.

Goldberg's patent No. 60136 and McCoy's No. 1506539 relate to candy or lollypops which are not liquid at ordinary temperature. As the Court of Appeals said In re Burt supra: "It is one thing to insert a stick in a warm, soft, sticky substance that by cooling will adhere thereto, and quite another thing to effect a strong union between a stick and frozen substance."

The claim is restricted to the application of a process to an edible substance which is fluid at normal temperature, which is subjected to refrigeration which not only solidifies the body but also attaches the body to the previously inserted handle by congelation. It therefore has not been anticipated by lollypops, which are not subjected to refrigeration and are not attached to a stick by congelation, nor by Lustig's patents Nos. 793453 and 797775 for non-edible cones without handles, nor by Nelson's No. 1404539 for a frozen confection without a handle, nor by Schroeder's No. 850607 for a process of making large blocks of carbonated ice, nor by Kells' No. 284212 for a process of cooling lard and like material for further treatment to obtain paraffin wax.

Holden's patent No. 207278, issued over 50 years ago, is the only prior art patent in evidence which discloses any substance frozen to a handle. It discloses a handle of metal plate which has no pores into which water can enter to form a bond, and a flexible looped cord which cannot be used as a handle to hold up a frozen confection while being eaten. His patent relates to the process of making blocks of ice having a piece of cord frozen into the same to facilitate the lifting and handling of the ice.

Claims 1, 2, 3, 4 and 5 of the Epperson patent relate to the process of subjecting a quiescent volume containing potable liquid, flavoring matter and sugar and of substantial height relative to its base dimensions to intense refrigeration whereby a frozen mass is formed homogeneous from end to end of a character such that the flavoring matter and sugar may be sucked therefrom to leave a tasteless mass of snow or ice (Claim 1), and the process of making a frozen confection which consists in charging a generally cylindrical container, such as a test tube, with a syrup in liquid form inserting a stick thereinto to substantially contact the bottom thereof and to protrude from the top, and subjecting the liquid to refrigeration, loosening the surface of the frozen confection thereby formed with respect to the container wall and drawing it therefrom by the handle, whereby the handle in the withdrawing operation constitutes a core upon which the tension is exerted without breaking the frozen mass and serves

as a core to maintain the mass intact preparatory to and during consumption (Claim 5).

By this process there is produced an article which the inventor described as "a drink on a stick," and which is new and has many distinguishable features.

The confection is a mixture of ice crystals interlocked with each other with interstices containing the concentrated flavored liquid. It consists of frozen and unfrozen parts. Its liquid contents may be sucked from it, leaving a substantially colorless and tasteless mass of ice. The liquid is kept cool so long as the ice lasts. The release of the confection from the mold by dipping the mold in warm water, the thawing of the outer surface and the immediate refreezing of the outer surface by the low temperature of the interior of the confection form a smooth layer of ice on the outer surface which seals the pores and prevents the dripping of the syrup until melted by the application of the lips and continued exposure to heat.

The structure of the confection is rigid and brittle and not spoonable and plastic. It is reinforced by a stick through substantially the entire length of a small diameter body whereby the liability of breakage by pressing lips laterally against the confection is reduced.

The confection may be made and handled without contact of the hands with the portion to be sucked or consumed. It is frozen in individual units of uniform size. Its ice crystals are not broken up by agitation into small impalpable crystals like those formed in frozen confections such as ice cream and water ice from which the syrup or flavoring matter cannot be sucked to leave a tasteless ice mass.

The process is not merely one of freezing but it is of freezing particular material under special circumstances whereby a novel product is produced.

None of the prior art patents (Burt's 1470524, Holden's 207278, Goldenberg's 60136, Born's 1195437, McCoy's 1506539, Kelly's 284212, Schroeder 850607, Lustig's 793453 and 797775) disclose a process for making frozen confection (with or without a handle member) by the application of rapid and intense refrigeration of a potable liquid, flavoring matter and sugar in a quiescent condition, producing a carrier for liquid syrup which may be sucked from the confection and leave a tasteless mass of ice.

The claims relate to a specific mode of treatment of certain material to produce a new useful article, and are therefore valid. Cochrane v. Doener, 94 U. S. 782; P. E. Sharpless Co. v. Crawford Farms, Inc., 287 Fed. 655.

There is evidence that the defendant did infringe plaintiffs' patents before he purchased plaintiffs' molds. Moreover, a license to use plaintiff's process cannot be implied from the sale of the mold to the defendant in the absence of satisfactory evidence that the molds were purchased from someone authorized by the plaintiffs to sell them without restriction and in view of the fact that they are capable of use for purposes other than carrying out the process of the patents, and in view of the fact that the purchaser was notified of the existence of the patents and the necessity of a license if he intended to practice the process. Lawther v. Hamilton, 124 U. S. 1; General Electric Co. v. Continental Lamp Works, Inc., 280 Fed. 846; Davis v. Hall Mammoth Incubator Co., 200 Fed. 958.

Patents for both processes were granted by the Patent Office. The public acquiesced in the validity of the patents. Infringers have consented to the entries of decrees against them. Confectioners are using the patents under licenses and paying royalties.

The plaintiffs accordingly are entitled to a decree. May 15, 1929.

## MAY 31

# *Two Claims for Improved Carbureter*

EX PARTE GEORGE B. SCHLEY. APPEAL NO. 113, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT No. 1711748 was issued May 7, 1929, to George B. Schley for a Carbureter, on application No. 356613, filed February 6, 1920.

Claims 1 and 4, directed to a carbureter having a vane and a gasoline discharge orifice so interrelated that the vane will move the orifice to such a position that it will have a component in the direction of air flow, with the result that the flow of gasoline varies inversely with the

speed of the air, were found anticipated by the reference disclosure.

Claim 2 was held patentably distinguished from claim 3 where it differed therefrom in specifying a fuel nozzle which produced a Pitot-tube effect on the fuel discharged therefrom.

The feature of providing a spring to dampen the oscillations of a nozzle member was held to be nothing more than a mechanical expedient, and the rejection of claim 7 on that ground was sustained.

The examiner's contention that claims 8, 9 and 10 were improper method claims because of inclusion of apparatus, where the apparatus was not specifically included but was implied by reason of the inclusion of the functions of the apparatus, was not sustained. These claims, however, were found anticipated by the prior art.

The examiner was affirmed in the rejection of claims 1, 4, 7 to 10 and reversed in the rejection of claim 3.

Hood & Schley for applicant.

The full text of the decision of the Board of Appeals (First Assistant Commissioner Kinnan, Examiners-in-Chief Ruckman and Landers) follows:

This is an appeal from the action of the examiner finally rejecting claims 1, 3, 4, 7, 8, 9 and 10. Claims 1 and 8 are illustrative and read as follows:

"1. In a carbureter, the combination of an air tube, a fuel nozzle discharging into said air tube, said fuel nozzle being movable to vary its angle of discharge with respect to the direction of air flow to vary the Pitot-tube effect on the fuel discharge, and means responsive to the velocity of air flow through said air tube for moving said nozzle as the velocity of air flow increases to increase such angle from an angle less than 90 degrees to an angle between 90 degrees and 180 degrees.

"8. The method of producing fuel discharge from a fuel jet in a carbureter, which consists in reducing the pressure at said jet by Venturi action, superposing upon such Venturi action a Pitot-tube action, and varying said Pitot-tube action with changes in the air velocity and with changes in the size of the opening through the carbureter."

The references relied upon are: Jourdanet, French, 488177, June 1, 1918; Dufaux, 349422, March 23, 1905.

The claims are drawn to a carburetor and to a method of producing fuel discharge from a fuel jet in the carburetor. The air in passing to the engine travels through a Venturi across which is located a small pipe having a lateral opening. The gasoline enters the lower end of this pipe and is discharged through the lateral opening. The pipe is mounted for rotation about its own axis and is normally biased to a given position by means of a spring connected to its upper end. This position is one in which a vane attached to the side of the pipe extends transversely of the Venturi passage. When in this position the discharge orifice 15 is directed in such manner that the direction has a component extending outwardly toward the side of the Venturi and a component extending in the direction of the air flow through the Venturi. This is accomplished by arranging the orifice at an angle somewhere between 90 degrees and 180 degrees from the vane. As the velocity of the air through the Venturi increases the vane swings toward the downstream side of the tube and the orifice is carried around toward the upstream side of the tube. The discharge of gasoline is accordingly varied inversely to the speed of the air. The abutment for the spring may be connected to the means for operating the throttle valve so that the tension of the spring is controlled in accordance with the setting of the throttle.

The patent to Jourdanet is the principal reference relied upon by the examiner. It corresponds very closely in structure to appellant's disclosure. In the example of the device represented in Figs. 3, 4 and 5 of the patent the discharge opening is illustrated as directly opposite the vane. In this example the discharge opening would never be so directed as to have a component extending in the direction of flow of the air. However, the patent discusses the effect of adjusting the orifice from a position in which it points downstream as shown at X in Figure 1 to a position in which it points upstream as shown at Y in this figure.

Claims 1 and 4 define from the specific example illustrated by Jourdanet by locating the discharge orifice in such position with respect to the vane that it may discharge in a direction having a component in the direction of air flow. In other words, appellant has selected out of the 180 degrees disclosed by Jourdanet in the discussion of his Figs. 1 and 2 views a particular 90 degrees which is not coextensive with the 90 degrees selected by Jourdanet in describing the specific example disclosed in Figs. 3 to 5, inclusive. Appellant earnestly contends that the difference is one which gives better results but it seems to us that the claims define over Jour-

danet in no manner requiring invention.

Claim 3 has been rejected as not patentable in addition to claim 2 which stands allowed. Claim 2 requires a fuel nozzle which produces a Pitot-tube effect on the fuel discharged therefrom. Claim 3 is not so limited. We deem claim 3 patentable in addition to claim 2.

Claim 7 is met in Jourdanet except that it includes means for damping oscillation of the nozzle under the influence of the spring. As stated above, the nozzle is turned by means of a vane. The examiner has cited the patent to Dufaux to show that it is old to provide damping means for vanes of this character. He accordingly holds that there would be no invention in the mere addition of damping means to the Jourdanet device. It is a common expedient to provide damping means where there would otherwise be undesirable oscillations or fluctuations of a movable part and we deem the rejection sound.

Claim 8, 9, and 10 have been rejected as being drawn to improper methods by virtue of their inclusion of specific apparatus. The apparatus referred to is not specifically included but is deemed by the examiner to be implied by virtue of the inclusion of its functions. We do not regard the claims so objectionable in this respect that they should be denied on this ground. These claims have been additionally rejected as failing to clearly distinguish from Jourdanet. They call for varying the Pitot-tube action with changes in the air velocity and with changes in the size of the opening through the carbureter. The examiner points out that the air velocity through the carbureter will vary with the load which will vary the Pitot-tube action, if the throttle opening is kept constant, while variation in the throttle opening will also change the air velocity and thus indirectly vary the Pitot-tube action. It is believed that these claims are readable on Jourdanet for the reasons stated by the examiner.

The decision of the examiner is affirmed as to claims 1, 4, 7 to 10, inclusive, and reversed as to claim 3.

Limit of Appeal to Court of Appeals forty days. Rule 149.

## JUNE 1

# *Adjustment of Flashlight Filament*

EX PARTE LEE J. VOORHEES. APPEAL NO. 1280, BOARD OF APPEALS OF THE PATENT OFFICE.

PATENT NO. 1712368 was issued May 7, 1929, to Lee J. Voorhees for an incandescent lamp, on application No. 473217, filed May 27, 1921.

An incandescent lamp with a filament extending through the focus and along the axis, with means for adjusting the filament along the axis, was found unpatentable over a combination of references, one of which disclosed the arrangement set forth except for the adjusting means, and another illustrated the adjusting means. The examiner's rejection of claims 1 to 4 and 6 on this ground was sustained.

Claim 5, however, being specific to a lamp adjusted by a movable battery element bearing against the lamp socket, was allowed over the prior art.

Byrnes, Townsend & Brickenstein for the applicant.

Before Moore, Assistant Commissioner; Skinner and Ruckman, Examiners-in-Chief. The full text of the opinion of the Board of Appeals follows:

This is an appeal from the rejection of all the claims, six in number. Claims 1 and 5 are typical and read as follows:

"1. In combination, a concave reflector; a lamp having a filament extending along the axis of said reflector through the focus thereof; means extending back of said reflector for supporting said lamp, said reflector and such lamp supporting means being relatively adjustable along the axis of the reflector to alter the spread of the reflected light; and means freely operative at will to effect such relative adjustment, said filament having a part thereof disposed at the focus of said reflector in every adjusted position of said lamp, whereby light is projected from said focus in every adjusted position of said lamp.

"5. A flashlight comprising the combination of a concave reflector having a central aperture; a lamp having an elongated filament; an adjustable holder carrying said lamp and movable at will back and forth along the axis of said reflector and its aperture; a battery in circuit with said lamp; a tubular casing carrying said battery, holder, reflector, lamp and its filament in axial alinement; and means operative at will to

adjust said holder, lamp and its filament along the reflector axis to alter the spread of the reflected light without opening the circuit including said lamp and battery; said filament having a part thereof disposed at the focus of said reflector in every adjusted position of said lamp, whereby light from said filament may be projected at will as a concentrated beam of maximum intensity or as an enlarged diffused beam of uniform intensity."

The references relied upon are: Naul, 1210676, January 2, 1917; Grether, 1286590, December 3, 1918; Anderson, 1389571, September 6, 1921; Roffy, 1441883, January 9, 1923; Besnard et al. (Br.), 10146, of 1912.

Appellant's invention relates to illuminating devices having a concave reflector and an electric lamp having a filament extending through the focus and along the axis of the reflector and means for adjusting it along said axis.

The claims stand rejected on the British patent or the patent to Naul which show rectilinear or elongated filaments, in view of Anderson or Grether who show means for adjusting and focusing the lamp in the reflector. We agree with the examiner that there is no invention in providing the lamps of the British patent or that to Naul with adjusting means in view of the adjusting means of Anderson or Grether, or conversely that there would be no invention in substituting the lamp with elongated filament of the British patent, or the patent to Naul, for the lamps of Anderson or Grether.

Appellant contends that with a concentrated, compact, filament lamp a dark cented or dark ring in the reflected light is produced when the lamp is moved forward or backward since no part of the filament remains at the focus of the reflector; but that with his elongated filament this detrimental effect is avoided since a portion of the filament is always at the focus. In our opinion, this, however, is not an unexpected result but one inherent in the elongated type of filament. This improved result due to the elongated filament is described at the bottom of page 1 and top of page 2 of the British specification.

In the particular construction disclosed in Fig. 1 the lamp is embodied in a flash light and the lamp is adjusted by the movable battery element bearing against the lamp socket, the battery being moved by the threaded screw cap on the opposite end of the casing. Claim 5 which is for a flash light embodying this construction stands rejected on the above art in connection with the patent to Roffy. The latter patent shows the usual flash light construction and does not show "means operative at will to adjust the holder, lamp, etc.," as called for in claim 5. In our opinion, claim 5 embodying this specific construction is patentable.

The rejection of claims 1, 2, 3, 4 and 6 is affirmed and the rejection of claim 5 is reversed. Limit of appeal to Court of Appeals, 40 days. Rule 149.

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# *Tightener for Wood Wheel Spokes*

TUCKER BROTHERS, A CO-PARTNERSHIP, PLAINTIFF, V. A. C. HONEYCUTT, DOING BUSINESS UNDER THE NAME OF HONEYCUTT MANUFACTURING COMPANY. IN EQUITY NO. 862, DISTRICT COURT FOR THE WESTERN DISTRICT OF MISSOURI.

PATENT No. 1411391, directed to a device for tightening wheel rims to wood wheel fellys by providing a shim adapted to be positioned between felly and rim without dismounting the wheel, was held to be infringed by defendant's device which involved the same principle of operation and included equivalent structure, though it varied somewhat as to structural features.

The court also decided that patent No. 1424530, covering a like structure, was not infringed because of the closeness of the prior art employed by both parties, it being stated that "that which infringes, if later, would anticipate if earlier."

The full text of the opinion of Judge Reeves, follows:

This is a suit for an alleged infringement of Letters Patent, numbered 1411-391 and 1424530. It is asserted in the bill that claims one and two of the first numbered patent are infringed and that the only two claims of the second patent are infringed.

Said patents were granted respectively on April 4, 1922 and August 1, 1922. Both relate "to a device for tightening up woodwheel spokes after they have become loose in the felly through shrinkage or wear." The object of the inventions was "to provide a shim designed

and adapted to be slipped between the felly and any spoke without dismounting the wheel."

1. In the first patent such a spoke tightener comprised "a shim provided with an orifice adapted to receive the tenon of a spoke and to be positioned between the spoke and felly of a wheel, and an opening leading to the orifice from the outer edge of the shim, 'said opening being slightly smaller than the tenon at the junction of the opening with the orifice.'"

That portion of the claim single quoted as above constituted the novelty and patentability of the device. It was explained in the patent that the opening to the orifice being smaller when once forced into position over a tenon larger than said orifice, the shim would "not come off itself and is therefore self-locking." It is contended by the defendant that said device was not novel as it had been previously anticipated by numerous and sundry patents.

**Simple Devices Are Patentable.**

An examination of all of the patents in evidence, as anticipatory of the device in question, fails to disclose a single one involving the principle of plaintiff's device The device appears to be simple, but simplicity of a device does not necessarily detract from its patentability. (Emery v. George H. Bowman Co., 11 Fed. 2d 525.)

Previous patents, it is true, contemplated an orifice narrower or smaller than the tenon of the spoke so as automatically to lock the device when forced over said tenon.

2. A different situation, however, obtrudes itself in respect of the last numbered patent. A distinguishing characteristic of the latter was a cut in the annulus on the opposite side from the narrow opening. This cut was made "to a point short of the adjacent outer edge." Its design was to weaken the circumference of the shim so that the opposite opening could be the more readily "pinched" together and thus the more effectually prevent it slipping or becoming misplaced.

The defendant contends that the weakening cut in the shim, which constituted the novel feature of the patent, was one well known to the prior art and much in use immediately prior to the grant of Letters Patent.

An examination of numerous patents, offered in evidence, disclose the truth of this averment. The same principle was involved in a patent granted to T. A. Frakes on February 27, 1877, and being numbered 187838; also patent granted to W. D. Hills, dated March 28, 1893, being numbered 494334; also patent granted to J. Pollock dated December 22, 1896, being numbered 573616; also patent granted to W. A. Porter, dated August 3, 1920, being numbered 1348517. In the patents mentioned, however, the weakening cut or cuts were not positioned as in plaintiff's patent. However, the same principle was involved and whether located in one place or another, or whether there were many weakening cuts, a single purpose was accomplished and that was to facilitate the closing of the shim.

The rule is that the substitution of equivalents in patentable combinations does not amount to invention. (In re Sweetland, 12 Fed. 2d. 163.)

3. The defendant claims to be manufacturing a shim under a license from the patentee of Letters Patent 1425182, dated August 8, 1922, to one Sylvester S. Dubbs. Said device under that patent and as used by the defendant was in every respect similar to the device covered by plaintiff's patent, except that the weakening cuts were two in number, the one in the periphery of the shim and the other in the inner wall thereof. This was but a variance of the same principle involved in plaintiff's patent and a very simple variance from the device covered by numerous other previous patents.

If plaintiff's last numbered patent was valid, there would be no question of infringement. However, the same thought was involved in many patents previous to plaintiff's last numbered patent and, of course, prior to the patent under which the defendant was manufacturing his shims. The rule is "that which infringes if later, would anticipate if earlier." (Superior Skylight Co. v. Zerbe Const. Co., 5 Fed. 2d, 982; 10 Fed. 2d, 710; Kil-Nock Co. v. Chicago Plating Co., 10 Fed. 2d 536.)

4. The defendant insists that the testimony fails to show that the opening in his device to the orifice thereof was smaller than said orifice. On the contrary the evidence shows that his structure or device was exactly similar to plaintiff's except the weakening cut was in the periphery rather than the inside wall.

5. It appears from the foregoing that the defendant infringed plaintiff's first numbered patent, but not the second and that they should have judgment as prayed in the bill.

May 2, 1929.

# Trade Marks Decisions

Chronologically Arranged in the Order of Publication in The United States Daily

*(See Master Index on page 3 and Reference Index on page 317)*

MARCH 8

## *Single Word Common to Two Titles*

TEXTILE PUBLISHING COMPANY, PLAINTIFF, v. ART METAL CONSTRUCTION COMPANY, DEFENDANT. EQUITY 29-194, DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK.

THE defendant, in using the title "The Office Economist" as a trade mark for a publication it issued monthly and mailed free to executives in its line of business, was held not chargeable with infringement of plaintiff's weekly trade journal sold under the title "Dry Goods Economist," on the ground that there was no confusion and that the periodicals were different in appearance, purpose and subject matter.

Where during the opposition proceedings in the Patent Office the defendant had been denied registration of the mark "The Office Economist" for the reason that the question whether confusion in trade would be likely seemed at least reasonably doubtful, the court ruled that this decision as to right of registration was not res adjudicata as to the question of infringement.

O. Ellery Edwards, Esq., solicitor for plaintiff. Prindle, Wright, Neal & Bean, Esqrs., solicitors for defendant, George T. Bean, John Lord O'Brien and Ralph Ulsh, Esqrs., of counsel.

The memorandum giving the opinion of the court, delivered by Judge Coleman, follows in full text:

Plaintiff publishes and sells a weekly trade journal under the title "Dry Goods Economist" devoted to the merchandise and the operation of department stores and other retail dry-goods stores. Defendant is a manufacturing concern making metal office equipment and as a means of advertising publishes monthly a house organ under the title "The Office Economist" which is not sold but is mailed free to executives in all lines of business, including retail dry-goods stores, and which is devoted to office methods and equipment.

### Application to Register.

Plaintiff's magazine was started under its present title in 1857 and the name was registered as a trade mark in 1912. Defendant in 1918 applied for the registration of "The Office Economist" as a trade mark and in 1919 commenced the publication under that title. Though the application was subsequently denied by the Patent Office because of the opposition of this plaintiff, defendant has nevertheless continued the publication to date, and the present action was commenced in 1924 for an injunction.

Two questions are presented, (1) was the decision of the opposition proceeding in the Patent Office res adjudicata on the issue of whether the title "The Office Economist" as applied to defendant's house organ infringes defendant's registered trade mark "Dry Goods Economist"; and (2) if that decision is not res adjudicata, how should the issue of infringement be decided.

(1) In the opposition proceeding the examiner originally denied this defendant's application to register "The Office Economist" on the ground that since the periodical was described in the application as a "magazine or journal issued monthly" it might cause confusion with this plaintiff's. As the decision of the examiner states, "If the goods of the applicant were a trade journal of the same characteristics as those of the opposer, the question whether confusion in trade would be likely seems at least

reasonably doubtful." In accordance with this decision, defendant amended its application so as to describe its publication as a "periodical published monthly as a house organ," and the examiner granted the registration.

Thereafter this plaintiff appealed to the Commissioner of Patents who reversed the examiner and sustained the opposition on the very technical ground that the applicant (this defendant) by acquiescing in the examiner's original decision and amending its application waived its right to claim that the decision was wrong, and that assuming the correctness of that decision, without considering the merits of it, the subsequent amendment was invalid or at least immaterial so as not to justify the examiner in changing his decision. This plaintiff appealed to the Court of Appeals of the District of Columbia which affirmed the Commissioner's decision on the same grounds.

### "No Decisions on Merits."

It thus appears that in the opposition proceeding there was no decision on the merits of the question whether this defendant's title would be likely to cause confusion with plaintiff's, except the two decisions of the examiner, of which the first was adverse to this defendant and the second in its favor.

Plaintiff concedes that the decision in the opposition proceeding was res adjudicata when it was rendered, and that if it is so now it is only because of a statute enacted three years later. The Court of Appeals of the District of Columbia made its decision in 1924 and the present action was commenced almost immediately. So that for the first three years that this action was pending plaintiff concedes the decision was not res adjudicata. In 1927 Congress enacted a statute providing that an applicant who is dissatisfied with the decision of the Commissioner of Patents and who appeals to the Court of Appeals of the District of Columbia thereby waives his right to maintain an independent action in equity under Section 4915 of the Revised Statutes. Plaintiff claims that this statute makes the decision of the Court of Appeals a final determination within the meaning of rules of law relating to res adjudicata.

Even assuming that the statute of 1927 could be construed as providing that the appeal of this defendant, which had been taken three years before the enactment, waived the right which the defendant unquestionably had up to the time of the enactment to maintain an independent action in equity to attack the decision of the Commissioner, still I am unable to see that the rule of res adjudicata is applicable to the present action.

The decision in the opposition proceeding as affirmed by the Court of Appeals was a departmental decision to the effect that the executive branch of the Government would not give this defendant the affirmative advantages of a registration of the name as a trade mark. It is true the reason for the refusal was the similarity to plaintiff's previously registered trade mark, but as stated in the decision of the examiner, the basis of it was that "the question whether confusion in trade would be likely seems at least reasonably doubtful." In other words, the executive branch of the Government refused its sanction because there was some doubt as to whether confusion would arise. In the present action we must determine whether defendant has done an affirmative wrong by using the name. The various tribunals taking part in the departmental decision, including the Court of Appeals, did not have jurisdiction to determine the question now presented and did not in fact purport to do so. Not only is the rule res adjudicata inapplicable, but in this instance I do not find that the decision in the Patent Office is even persuasive.

(2) Coming to the merits of the controversy, the two titles "Dry Goods Economist" and "The Office Economist" are as different as two expressions can be except for the word "Economist." Certainly "Dry Goods" and "The Office" in no way suggest each other. The word "Economist" has frequently appeared in the titles of publications and plaintiff claims no exclusive right to its use with other words in the trade mark of a periodical. Considering the titles in their entirely I can not see how confusion would be possible. Certainly after nine years of use there is no evidence that any actually did occur. Furthermore, the two periodicals are quite different in their appearances; purposes and subject matter; and as a practical matter their readers are entirely different also. Under these circumstances I have no hesitation in holding that there is no infringement and that the bill should be dismissed on the merits.

Settle decree on notice.

January 21, 1929.

# Similarity in Marks Used on Tents

CLIFTON MANUFACTURING COMPANY, APPELLANT, V. CRAWFORD-AUSTIN MANUFACTURING COMPANY, APPELLEE. NO. 5364, CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT.

A TEMPORARY injunction was granted to prevent infringement of appellee's trade mark consisting of the word "Dux-Bak" below which was printed, first the figure in side view of a duck, and then the words "Waterproofed and Mildewproofed."

The court ruled that appellant's mark "Rex-All," underneath which was placed the figure of a crown and the words "Mildewproofed and Waterproofed," when stenciled on articles intended for sale, was similar to appellee's mark and likely to deceive the purchasing public.

Appeal from the District Court for the Western District of Texas.

Nat Harris for appellant; W. W. Naman, (Spell, Naman & Penland on the brief), for appellee.

Before Walker, Bryant and Foster, Circuit Judges. The full text of the opinion of the court follows:

This is an appeal from a temporary injunction issued in a suit by appellee to enjoin the infringement of its registered trade mark.

The parties were competitors in the manufacture and sale of tents, tarpaulins, and wagon covers. Appellee, in order that the purchasing public might identify its goods, adopted and registered as a trade mark the word "Dux-Bak," immediately below which was printed, first the figure in side view of a duck, and then the words "Waterproofed and Mildewproofed." Appellee also adopted a russet-brown color to distinguish its product from the product of its competitors in business. Appellants made use of the word "Rex-All," underneath which was placed the figure of a crown and the words "Mildewproofed and Waterproofed." They also adopted for their product the distinctive russet-brown color. It was shown by the evidence that these two marks when stenciled on articles intended for sale bore such similarity in appearance as that an ordinary purchaser was liable to be deceived, and to accept the product of appellants for that of appellee.

Appellants at first used the word "Dri-Duk," but were enjoined by appellee from doing so, and after that they began to use the mark which they were restrained from using in the present suit. It therefore appears quite conclusively that it was the intention of appellant to use a mark so similar to the trade mark of appellee as to deceive the purchasing public, but with enough difference in appearance to escape the charge of infringement. We have held that infringement was shown in the very similar cases of Vick Medicine Co. v. Vick Chemical Co., 11 F. (2) 33, and Hydraulic Press Brick Co. v. Stevens, 15 F. (2) 312.

Upon the reasoning of those cases, and the authorities therein cited, the order appealed from is affirmed.

February 4, 1929.

## MARCH 9

# Renewal After 20-Year Period

EX PARTE REGAL SHOE COMPANY. PETITION FOR RENEWAL OF TRADE MARK, COMMISSIONER OF PATENTS.

THE Commissioner of Patents denied a renewal of a trade mark registration, request for which was filed after expiration of the 20-year period for which it was issued, upon the ground that renewal would not be an extension of the term of the original registration, but would be granting a new and original registration for the statutory term.

Geo. N. Goddard for applicant.

The full text of the opinion of Commissioner Robertson follows:

This is a petition from the action of the examiner of trade marks refusing to consider an application for the renewal of a trade mark registration, since it was filed after the expiration of the 20 years for which the registration was issued.

It is argued on behalf of the registrant that the law puts no restriction on the time when a request for renewal may be filed other than "such request may be made at any time not more than six months prior to the expiration of the period for which the certificates of registration were issued or renewed."

The same statute (Sec. 12 of the Act of 1905) provides "that a certificate of registration shall remain in force for 20 years," and further provides: "Certifi-

cates of registration may be, from time to time, renewed for like periods on payment of the renewal fees required by this act."

Obviously the purpose of the renewal is to keep the registration in force. It is thought, therefore, to be evident that the intention of the law was that the request for the renewal must be filed before the period for which the registration was issued had expired. Otherwise the registration would not be "renewed," but, in effect, the office would be granting a new certificate of registration.

The period for which the registration had been issued in the present case had expired when the request for renewal was filed. If applicant's argument is correct, then, after this registration had been renewed, instead of the period for which it remained in force being continuous from the date of the original registration, there would be a period of over two months when the registration was not in force.

That the above is the correct construction of the Act is believed to be shown by that portion of the same section which relates to trade marks previously registered in a foreign country. With respect to such registrations it is provided that they shall cease to be in force on the day on which the trade mark ceases to be protected in the foreign country and "shall in no case remain in force more than 20 years, unless renewed."

In the case cited by the examiner, Ex parte Gebruder Avenarius, 135 MS. D. 24, decided May 22, 1920, renewal of registration No. 16788 was refused because the petition for renewal was filed more than nine months after the expiration of the registration.

Applicant's argument, based on analogy to the patent statutes with respect to the so-called renewal of an application where the final fee was not paid within six months from the date of the notice of allowance, is not deemed persuasive, since the statute (4897 R. S.) does not in terms provide for the renewing of an application under the circumstances above noted; but provides that the applicant, or any party having interest in the application, "shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application," and further, provides that "such second application" must be made within one year after the allowance of the original application.

The holding of the Court of Appeals of the District of Columbia in District of Columbia v. Roth, 19 App. D. C. 547, with respect to extending the time for filing the transcript in that case, is deemed to be indicative of the ruling which should be made here.

In that case the court quoted from the rule which provided that it should be the duty of the appellant to file with the Clerk of the Court of Appeals the transcript of the record "within forty days from the time of the appeal entered and perfected in the court below," unless such time, for special and sufficient cause, be extended by the court below or the judge thereof by whom the judgment decree or order was rendered, and held that the court below had no authority to extend the time unless such extension was made before the forty days had expired.

After noting that the judge had undertaken to extend the time after the forty days in that case had expired, the court said:

"This was clearly too late. The application for and obtaining the order for the extension of the time prescribed by the rule should be made within the period of 40 days; otherwise it is not in extension of a current period, but the prescribing of a new and additional period; and if that can be done after the expiration of the first period of 40 days, it may be done at any time, no matter how long after such expiration, and there would be in reality no limit to the time within which a transcript could be filed—that right being made to depend entirely upon the indulgence of the judge below.

"This is clearly not the intention of the rule."

To paraphrase the language above quoted, the granting of the renewal in this case would not be an extension of the term for which the original registration was granted, but granting a new and original registration for the statutory term.

In the case of Ewing v. Standard Oil Company, 203 O. G. 1556; 42 App. D. C. 321, in which the question of the right of the Patent Office to examine an application for renewal, just as in the case of original applications, was under consideration, the court, after referring to Sec. 12 of the Act of 1905, which provides for renewals, said:

"In other words, it is intended that the rights originally acquired shall continue, and not that new rights shall be granted at the end of 20 years as the result of an investigation by the Commissioner."

This intention of the act, as stated by

the court, could not be carried out if the renewal of the registration was granted on an application filed after the original application had expired by lapse of time, since the second obviously would not "continue" the rights originally acquired. The petition is denied.

February 25, 1929.

## MARCH 20

# *A Fanciful Notation for Coal*

EX PARTE PAYNE COAL COMPANY, INC.

ASSISTANT COMMISSIONER OF PATENTS.

A TRADE MARK consisting of a combustible orange-colored disc bearing the words "Orange Disc," used on coal was allowed registration as being arbitrary, fanciful and nondescriptive of the goods to which it was applied.

The examiner's holding that the mark was merely a label or tag of a single color, and as such not registrable, was overruled, and a distinction made between form or color of marks and form, size or color of articles to which they are applied.

The application of the mark to the goods by scattering a few of the discs in the loose coal was found to be a proper use of the trade mark.

Munn & Co. for appellant.

The full text of the opinion of Assistant Commissioner Moore follows:

The applicant appeals from the decision of the examiner of trade marks finally refusing to register its trade mark for coal.

The trade mark consists of a combustible orange colored disc bearing the words "Orange Disc."

The examiner's ground for refusing to register the mark is that "this disk constitutes, in substance, merely a label or tag, and that neither the form nor color of a tag or label, or disk serving the same purpose, may be exclusively appropriated," basing his holding primarily on the decision in ex parte Penley, 123 MS. Dec., 73.

It is believed that the Penley decision is not applicable to the instant case. In that case the mark consisted of "a poster having a picture of a blue tag thereon." The Assistant Commissioner found that "a line of hams marked with a poster having the picture of a blue tag thereon would be almost inevitably confused with another line of hams having the blue tag attached to it;" that the blue tag "is a common article of manufacture on sale as such and used for just such purposes."

In the instant case it is not shown that the mark, consisting of an orange disc bearing the words "Orange Disc" is a common article of manufacture on sale as such and used as a poster.

As to the form and color of the applicant's mark, the examiner appears to have confused form and color of marks with the form and color of goods, which latter are frequently sought to be registered as trade marks. It is a well settled rule that there can be no trade mark in the mere form, size or color of an article used commercially, or the form, size or color of the package containing it. (See paragraph 114, page 280, of Hopkins on Trade Marks etc., Fourth Edition.) But color may constitute a valid trade mark when impressed in a particular design. As was stated by the Supreme Court in Leschen Rope Co. v. Broderick (201 U. S. 166):

"Whether mere color may constitute a valid trade mark may admit of doubt. Doubtless it may be, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star."

In this case the orange color is impressed in a particular design, viz., a disk. The applicant, however, is not seeking to register an orange colored disk alone.

It is believed that the examiner is in error in stating that the applicant's mark is merely a label or tag. A label or tag identifies the goods (see Hopkins on Trade Marks etc., p. 521); a trade mark identifies the originator or owner of the goods. The applicant's mark does not identify the goods. There is no such thing as orange coal, or disc coal, or orange disc coal.

The applicant's mark meets every requirement of a valid trade mark. It is arbitrary and fanciful, and is nondescriptive of the goods. It was originated and appropriated to coal for the purpose of identifying the coal as to its origin or ownership. It could have no other function or effect. The coal no doubt, is or will be known by the commercial title orange disc coal. (California Packing Corporation v. Halferty, 320 O. G. 700; 54 App. D. C. 88; 295 F. R. 229; 1924 C. D. 225.)

Respecting the examiner's contention that the applicant is seeking to protect not only a trade mark, but also the application of such mark, it is not clear in what respect the applicant seeks protection of the application of the mark except in a trade mark sense. The appli-

cation of a mark to the goods in commerce is a necessary prerequisite to any trade mark right.

The applicant does not confine its trade mark right to the disclosed manner of application of the mark to the goods. The applicant applies its mark to the goods by scattering a few of the discs in the loose coal. This appears to be a sufficient compliance with the law. In Lorillard et al. v. Pride (36 O. G. 1150; 1886 C. D. 384), cited by the examiner in this connection, the Court found that the complainants did not brand or mark their goods with the words "Tin Tag"; and that—

"If complainants had from the outset marked their goods with this fanciful or arbitrary designation of "Tin Tag Plug" or "Tin Tag Tobacco" as a trade mark, their exclusive right to its use might be sustained; * * *."

I have carefully examined the other decisions referred to by the examiner, but find that they are not applicable to the facts in this case. They merely decide the obvious fact that a label of a single color, apart from any name, figure, or device with which it may be connected, may not be the subject matter of a trade mark. Otherwise, another person who might adopt a label having a similar color for the same class of goods would be chargeable with unlawful imitation.

The decision of the examiner of trade marks is reversed. March 2, 1929.

## MARCH 21

# *Dissimilarity of 'Renu' and 'Renol'*

S. S. STAFFORD, INC., v. SANDHOP. OPPOSITION NO. 8288, ASSISTANT COMMISSIONER OF PATENTS.

APPLICANT was allowed registration of his trade mark comprising a distinctively shaped panel having the word "Renu" printed in a peculiar manner at its upper portion and a disk depicted at its lower portion, on the ground that it was not deceptively similar to opposer's mark consisting of the word "Renol" set within an oval border line.

Evidence was introduced by applicant to show that "Renu" had been commonly used in prior registrations.

Morris Kirschstein for S. S. Stafford, Inc. Knight Brothers for Sandhop, Ray T. Ernst of counsel.

The full text of the opinion of Assistant Commissioner Moore follows:

The opposer, S. S. Stafford, Inc., appeals from the decision of the acting examiner of interferences dismissing its opposition to the registration by the applicant, Karl Sandhop, of his trade mark for automobile and furniture polish, said mark consisting of a distinctively shaped panel having the word "Renu" printed in a peculiar or distinctive manner at its upper portion and a disk depicted at its lower portion.

Opposition is based primarily on prior adoption and use by the opposer of its trade mark consisting of the word "Renol" set within an oval border line, said mark having been registered September 12, 1922, No. 158818. The opposer contends that the word Renu is deceptively similar to "Renol," and that the two marks are appropriated to goods of the same descriptive properties.

The opposer urges as a second ground for opposition that the word "Renu" is descriptive of the goods, and that its registration is therefore prohibited by the Trade Mark Act of February 20, 1905.

The applicant concedes that the goods of the parties have the same descriptive properties; and does not contest the issue of priority. He is also willing to admit that the word "Renu" is descriptive of the goods; but contends that said mark is common to the trade and, therefore, publici juris.

The applicant also contends that the words "Renol" and "Renu" are not deceptively similar to each other, pointing out that they do not look alike, sound alike, or have the same meaning; also that his mark does not consist of the word "Renu" alone, but that it is a composite mark, of which this word forms but a part. The applicant has several times attempted to disclaim the word "Renu" apart from the mark shown in the drawing.

The applicant further contends that by reason of the common use of trade marks by others consisting of or including the word "Renu" or variations thereof, on goods of the same general characteristics, as evidenced by 15 registrations listed in the fifth paragraph of the applicant's answer to the notice of opposition, the opposer's rights, if any, under

its trade mark "Renol" are restricted to its exact mark.

In view of the facts of record, no error is seen in the decision of the acting examiner of interferences holding that the two marks are not so similar as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. In fact, it is difficult to see how it is possible to extend the opposer's trade mark rights so as to cover the applicant's mark without at the same time infringing upon the trade mark rights of prior registrants.

It may be added that no actual confusion in trade as between the two marks has been established. The testimony of Stafford to the effect that it had been reported to him by salesmen in his employ that customers had actually placed orders for "Renu" believing that they were ordering "Renol" is merely hearsay evidence and of no force.

No good reason is apparent why the applicant may not be permitted to amend his application by entering therein the proposed disclaimer.

The decision of the acting examiner of interferences is affirmed.

March 12, 1929.

## MARCH 22

# *Different Marks on Meat Products*

THE H. H. MEYER PACKING COMPANY V. THE E. KAHN'S SONS COMPANY. OPPOSITION NO. 8550, ASSISTANT COMMISSIONER OF PATENTS.

THE opposition to registration of the trade mark "Pheasant" for meats and meat products, as being similar to opposer's mark consisting of the word "Partridge" and the picture of a partridge, was dismissed, the Assistant Commissioner stating that the two marks are not similar as they do not look alike, sound alike, or convey the same meaning.

The contention that applicant had abandoned its mark "Pheasant" was not sustained where there was merely evidence of nonuse but no evidence of intent to abandon.

The Commissioner also ruled that due to laches on the part of the opposer in interposing no objection to applicant's use of the mark "Pheasant" during a period of several years, its opposition should be dismissed on that ground.

Linton, Kellogg, Robie & Bastion for the H. H. Meyer Packing Company. Murray & Zugelter for the E. Kahn's Sons Company.

The full text of the opinion of Assistant Commissioner Moore follows:

### Appeal From Decision.

The opposer, The H. H. Meyer Packing Company, appeals from the decision of the acting examiner of interferences, dismissing its opposition to the registration by the applicant, The E. Kahn's Sons Company, of its trade mark consisting of the word "Pheasant" for meats and meat products, such as lard, ham, bacon, sausage, etc.

The essential ground for opposition is prior adoption and use of the word "Partridge" and the picture of a partridge as a trade mark for goods having the same descriptive properties, said trade mark having been registered June 13, 1916, No. 110829.

The opposer's contention is that the applicant's trade mark "Pheasant," which was not adopted and used by the applicant or its predecessor until Oct. 1, 1893, is so nearly identical with the opposer's trade mark "Partridge" and the picture of a partridge in appearance, sound and significance as to undoubtedly cause confusion and mistake in the mind of the public and deceive purchasers, to the great and irreparable damage and injury to the opposer.

It appears to have been agreed that the goods of the parties have the same descriptive properties and that the major question presented for decision is whether the opposer's mark, Partridge, so nearly resembles applicant's mark, Pheasant, as to be likely to cause confusion in the mind of the public or to deceive purchasers.

Incidentally the questions of priority and of abandonment have been raised. As to priority, the record appears to establish with reasonable certainty the fact that opposer, or its predecessors, used the mark Partridge prior to the use of the mark Pheasant by the applicant, or its predecessors. Meyer, Huschart & Company, predecessors of the opposer, registered the Partridge mark as early as July 31, 1877 (Registration No. 4973), whereas the applicant does not claim use of its mark prior to 1893.

As to abandonment of the marks, there

is nothing in the record indicating any intention to abandon either of said marks. It appears from the evidece that the applicant's predecessor, The Cincinnati Abattoir Company, used the Pheasant mark up to the time the said company was placed in the hands of a receiver; that it was used from time to time by the receiver while in charge of the business, and that the applicant acquired title to said mark (Registration No. 76275) from the receiver. Mere nonuse of a trade mark for a limited time is not sufficient to prove abandonment. There must be present some act on the part of the owner to show an intention to abandon the mark. Nor does the evidence show any intention to abandon the opposer's mark Partridge.

**No Resemblance Found.**

As to resemblance, a comparison of the two words shows that they do not look alike, sound alike, or convey the same meaning. And a comparison of the pictures of the two birds as shown on the labels of the respective parties shows that their resemblance is so remote as to make confusion wholly unlikely. It may be noted in this connection that neither party appears to have been entitled to the exclusive use of a bird broadly as a trade mark for meat products, in view of the existing "Dove" trade mark for meat products.

While the meaning of each of the two words partridge and pheasant is rather general, yet neither includes the same species included by the other. And while the two marks were used for many years, covering substantially the same territory, yet the evidence does not definitely establish any confusion in trade between them. The testimony of H. H. Meyer does not show confusion. The letters and telegrams (Opposer's Exhibit 17), referred to by Meyer in connection with the Hurst-Boillin Company, do not show confusion. The company's reply to Meyer's letter stating that the "Pheasant Lard" had not been offered to them by any one since the old Cincinnati Abattoir Company went out of business; that for several years they bought this brand of lard, but later bought the "Partridge" brand from Meyer, clearly shows that the said company knew of the sources of the Pheasant and the Partridge brands of lard, On cross-examination H. H. Meyer admitted that he could not recall any instance of confusion between the Pheasant and the Partridge brands of goods during the time the Cincinnati Abattoir Company was using the mark "Pheasant."

According to the testimony of the witness Knauth, the buyer for the Donahue Company of Pittsburgh was not confused as between the Partridge brand and the Pheasant brand. He is reported to have said: "We don't want no Pheasant brand," but, according to Knauth, he accepted the Partridge brand.

The testimony of the other witnessees for the opposer is still less pertinent to the question of confusion.

There is still another reason why the opposition should be dismissed and that is laches on the part of the opposer.

It appears from the evidence that for many years the marks were used respectively by the parties on the same goods and in substantially the same territory without the interposition of any objection on the part of the opposer. If the opposer ever had any right to oppose registration of the mark Pheasant, such right should have been exercised when application for registration of said mark, on which Registration No. 76275 was granted, was pending before this office. (Victor Stove Company v. Hall-Neal Furnace Company, 18 T. M. R. 178).

The decision of the acting examiner of trade mark interference is affirmed.

March 9, 1929.

# *Similarity in Hosiery Marks*

LIGHTFOOT SCHULTZ COMPANY v. COSBY. OPPOSITION NO. 8358, FIRST ASSISTANT COMMISSIONER OF PATENTS.

"SILK-LIF" as a trade mark for a compound designed to be used in the treatment of hosiery and lingerie to prevent runs and fading was held not registrable over opposer's mark "Silk-Life" used on soap intended for cleaning ladies' hosiery and underwear, and which was alleged to lengthen life and improve luster of the goods. The marks were found to be identical in appearance, spelling, sound, and significance.

Howard S. Neiman for Lightfoot Schultz Company; H. W. Wellington and Harold S. Huggins for Cosby.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

This case comes on for review, on ap-

peal of the opposer, Lightfoot Schultz Company, of the decision of the examiner of trade mark interferences dismissing the opposition and adjudging the applicant, Arthur B. Cosby, doing business as Boulevard Sales Company, entitled to the registration for which he has applied.

The applicant seeks registration of the notation "Silk-lif" used upon a compound designed to be used in the treatment of hosiery and lingerie to prevent runs and fading. The opposer sets up ownership of the notation "Silk-Life" used as a trade mark for soaps for use upon silk and has submitted a certified copy of registration No. 185154, issued June 10, 1924, of this mark for such goods.

The specimens of the cartons in which the applicant markets his compound state that such compound is designed to prevent runs, set the color and prolong the wearing qualities, and the directions appearing upon the cartons state as follows:

**Directions for Use.**

"Dissolve a table-spoonful of silk-lif in a pint of warm water, soak the hose or lingerie in the solution for 30 minutes, then let dry thoroughly, when dry rinse in clear water if desired."

Further directions are:

"For Used Hose and Lingerie. Have garment clean and dry, then treat same as new garments."

The specimens of the cartons in which the opposer markets its goods state that the soap "preserves silk—lengthens its life—improves the lustre—increases the service of silk stockings, gloves, underwear, blouses, laces, etc."

A further statement appears that "Silk-Life lathers instantly in cold water."

Since neither party has taken testimony the applicant is restricted for his date of adoption and use to his date of filing, June 17, 1927, while the opposer may be deemed to have established adoption and use of its mark as early as the date of its registration, which date is sufficient for the present proceedings. Under these circumstances it will be deemed the opposer was first in the field with its mark used upon soaps of the character set forth in the registration. The marks are substantially identical in appearance, spelling, sound and significance. The omission by the applicant of the final "e" in the second word of the notation is not deemed to involve any material difference. For all practical purposes it is considered the applicant has adopted the opposer's mark and has used it upon goods which are intended for the treatment of the same kinds of types of feminine wearing apparel. The suggestion is the same in both marks that the use of the respective substances upon stockings, underwear, and so forth, will lengthen the life of such wearing apparel and improve its lustre. The applicant uses on his cartons the words "prevents runs and fading" and "doubles the life" while the opposer uses the words on its cartons "improves the lustre" and "lengthens its life."

**Similar Processes.**

The applicant's directions for using his compound are quite similar to those which would be followed in the use of the opposer's soap. Both materials are to be first dissolved in water and subsequently the articles of wearing apparel are to be placed in the solution although in the one case no rubbing is employed while in the case of the opposer's goods some rubbing to obtain a cleansing effect is adopted. Primarily, it is true, the opposer's material is used for cleansing while that of the applicant is used merely to restore or add lustre and increase the length of life but the opposer's goods is described as accomplishing these same functions.

It is deemed quite clear users of opposer's goods would be confused in seeing the applicant's goods in the same market and would be quite likely to purchase the latter when intending to purchase the former. Even if no error was made as to the particular goods desired by such a customer, the latter would be quite likely to think both goods had the same origin. The products of both parties to this proceeding would be likely to be called for by the name "Silk-Life" and a dealer would not know which goods were desired and would be as likely to sell the applicant's goods as the opposer's. If both marks appeared upon the respective goods in the same market, it is deemed confusion of origin would be inevitable. Fishbeck Soap Company v. Kleeno Manufacturing Company, 216 O. G. 327, 44 App. D. C. 6.

The decision of the examiner of interferences dismissing the opposition and adjudging the applicant entitled to the registration for which he has applied is reversed.

## MARCH 23

# *Preparation For Treatment of Scalp*

LEVER BROTHERS COMPANY v. LUX-GRO LABORATORIES. OPPOSITION No. 8487, ASSISTANT COMMISSIONER OF PATENTS.

THE opposer, owning the trade mark "Lux," which it had used extensively for years in connection with the preparations having detergent, washing and cleansing properties and adapted to be used for the hair and scalp, was sustained in its opposition to the registration by the applicant of its trade mark "Lux-Gro" for a preparation for the treatment of the hair and scalp.

The Assistant Commissioner ruled that under a general grouping of the articles they fall into the same general class and possess the same descriptive properties, since both are considered as toilet articles.

Archibald Cox and William G. Henderson for Lever Brothers Company.

Frederick S. Stitt for Lux-Gro Laboratories.

The full text of the opinion of Assistant Commissioner Moore follows:

The applicant, Lux-Gro Laboratories, appeals from the decision of the acting examiner of interferences sustaining the opposition of Lever Brothers Company to the registration by the applicant of its trade mark "Lux-Gro" for a preparation for the treatment of the hair and scalp.

### Prior Adoption Claimed.

The essential ground on which the opposition is based is prior adoption and use by the opposer of its trade mark "Lux" used in connection with preparations having detergent, washing and cleansing properties and adapted to be used for the hair and scalp.

The following facts bearing upon the questions involved have been stipulated and agreed between the parties, viz, that the applicant's trade mark consists of the word "Lux-Gro," which is used solely for and on a hair tonic and restorative in liquid form; that said mark is a coined word derived from the words "Luxuriant Growth;" that the applicant has been continuously using said mark for said preparation since August 16, 1927; that the opposer is the proprietor of the following United States certificates of trade-mark registrations:

No. 35228, October 9, 1900; No. 59032, January 1, 1907; No. 170676, July 17, 1923; No. 201243, July 21, 1925.

That for more than 25 years the opposer has continuously used the trade mark "Lux" as the name of a compound having detergent, washing and cleansing properties and adapted to be used for the hair and scalp; and that during the last 10 years opposer has expended in advertising "Lux" in excess of $10,000,000, and the sales of "Lux" during that period have been more than 800,000,000 packages.

### Descriptive Qualities.

In view of the stipulated facts and the admissions of the parties, the essential questions presented for decision is whether the goods of the parties are of the same descriptive properties. The applicant states:

"It is believed that the main, if not the sole, point in issue here is, whether or not applicant's goods and the opposer's goods are of the same descriptive properties."

The opposer states: "The issue presented therefore is whether under all the circumstances of this case, particularly in view of the exceptional character of the opposer's trade mark 'Lux,' the use and registration of applicant's mark for a preparation for the treatment of the hair and scalp would be likely to deceive purchasers as to the origin of such goods and lead them to believe that they are products of the 'Makers of "Lux,"' as opposer is known to the purchasing public."

Specifically, the two articles of trade do not possess the same descriptive properties. Toilet soap (opposer's Exhibit B) and hair tonic clearly do not have the same specific descriptive properties, and no one desiring a hair tonic would be deceived into purchasing a cake of toilet soap. But under a more general grouping of the articles they fall into the same general class and possess the same general properties.

### Both Used for Scalp.

They are both toilet articles, and both are used in the treatment of the scalp to promote the growth of the hair. They are found side by side in the salesroom and in the toilet; and, bearing substantially the same trade mark, it is believed that they would be regarded as having the same origin or ownership. This conclusion becomes more evident when it is considered that for more than 25 years

the members of the public have associated the trade-mark "Lux" with the opposer's goods.

The case is not entirely free from difficulty, but it is believed that the rule to the effect that doubts should be resolved against the newcomer, should be applied.

The decision of the acting examiner of interferences is affirmed.

March 14, 1929.

## MARCH 25

# *Applying the Trade-marks Act To Food Products Shipped Abroad*

HECKER-H-O COMPANY, INC., PLAINTIFF, v. HOLLAND FOOD CORPORATION, DEFENDANT. EQUITY NO. 39,-302, DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK.

THE plaintiff's registered trade mark "H-O," used on certain cereal products, was held to be valid and infringed by defendant's mark "Hofood" used upon similar goods. A Patent Office decision in a cancellation proceeding, holding that the marks were so similar as to tend to cause confusion when standing together in the trade, was cited.

The court found that although defendant's goods were shipped from the port of New York and sold in foreign countries, yet the infringing acts were performed in this country in that the mark was affixed to the containers in the United States and the alleged improper acts were brought within Section 16 of the Trade-marks Act.

### A Widely-known Mark.

W. Lee Helms, solicitor for plaintiff; Hunt, Hill & Betts, solicitors for defendant (John W. Crandall, of counsel).

The full text of the opinion of the court, delivered by Judge Winslow, follows:

The plaintiff is a manufacturer of cereal products, its field of operations being both domestic and international. The subject of this particular action is the plaintiff's registered trade mark "H-O", which has been used as the name of one of its principal cereal products, an oat food, and, in addition, has been used as a house mark extensively on practically all of its cereal products.

It is widely known to wholesalers, jobbers and retailers, both in this country and abroad, and large sums of money have been spent in advertising. It has enjoyed the exclusive use of the trade mark for upward of 32 years.

The defendant is using the word "Hofood," also applied to cereal products. In 1921, the defendant obtained a trade mark registration under "Hofood" as applied to certain cereal and other produtcs, and in 1922 the defendant filed an application for registration of the same mark for other cereal products. This resulted, in 1923, in proceedings instituted by plaintiff in the United States Patent Office for the cancellation of the trade mark "Hofood" and that the applied for mark be denied because of priority of use by the plaintiff of the trade mark "H-O" in connection with the word "Food" on its cereal products, which it, the plaintiff, in fact had used from time to time.

The result of this proceeding in the Patent Office was a decision favorable to the plaintiff, and the defendant's trade mark was cancelled and its application was denied. The Patent Office, in substance, held that the goods of the two parties were identical, and that the marks were so similar as to tend to cause confusion when standing together in the trade.

An appeal resulted in the affirmance by the Court of Appeals of the District of Columbia of the decision of the Commissioner.

The record is quite conclusive that the plaintiff and its predecessors have used the trade mark "H-O" since 1887, both on labels and advertising, and connected also with the word "Food." It further appears that it has been a house mark to identify plaintiff's products.

The defendant is an American corporation located in the State of New York. It purchases oats and wheat-flour products and has the containers marked "Hofood" in the United States, and then such containers are shipped to foreign countries to its customers who are wholesalers and jobbers. It is claimed by the defendant that the product is removed from the wholesale packages

and that the retailer does not use "Hofood" on retail packages. I do not think this is material. The goods are known and described generally as "Hofood."

I am of the opinion that the record sustains the plaintiff's exclusive right to use "H-O" in connection with "Food" on bulk goods, as well as on its retail packages in the United States. A very valuable part of plaintiff's good will is among those of the wholesale trade, as well as among retailers.

**Prospective Confusion.**

If the defendant has the right to use the word "Hofood" at all on cereal products, it could, if desired, use such mark both on retail packages and wholesale packages, or on any containers. The method of use may or may not be identical as to the form of the containers, but the product is of similar origin, and I believe that confusion not only may be present, but prospective if the defendant has the right to use its mark "Hofood."

The defendant affixes its mark in the United States on the containers, and these goods are shipped from the port of New York. The case of Vacuum Oil Co. v. Eagle Oil Co., 154 Fed. 867, is pertinent and applicable. It was there contended that the Court was without jurisdiction and that the alleged infringing acts were performed outside of the United States, but inasmuch as the instigation of the plan and the direction thereof took place in the United States, it was in substance held that the infringement began in this country. An injunction was issued.

There can be no question that the trade mark "Hofood" is affixed to containers in the United States by the defendant, which, I think, brings the alleged improper acts within Section 16 of the Trade-marks Act. The intention of the defendant to infringe or actual confusion may not be necessary of proof where the plaintiff's ownership and right are unquestioned.

And specific instances of confusion or deception are not required. In like manner, it is not necessary to hold that actual damages have been sustained by the plaintiff. Hutchinson, Pierce & Co. v. Lowey, 163 Fed. 43.

Counsel asked the Court to take special cognizance of the fact that the method of use of the trade marks by the litigants at the present time is less important than the natural changes in the condition of the trade of the future. The plaintiff, if it desires, may sell in bulk, and again the defendant may change its bulk packages to retail packages.

The Court has jurisdiction of the defendant (see Vacuum Oil case, supra). Holland Furnace Co. v. New Holland Machine Co., 24 Fed. (2) 751. In this latter case, it was held that there was an invasion of plaintiff's rights even if before final purchase, the buyer learns whose goods he is buying.

My conclusion is that plaintiff's trade mark "H-O" is valid, and that plaintiff is entitled to the exclusive use of the same, either with or without the word "Food" added and attached to the containers of its products.

Decree for plaintiff.

March 13, 1929.

# *Confusion in Marks for Candy*

EX PARTE FOX'S GLACIER MINTS, LTD. FIRST ASSISTANT COMMISSIONER OF PATENTS.

THE applicant was denied registration of a pictorial representation of a bear standing upon a block presumably representative of a cake of ice, used upon mints, as being confusingly similar to a trade mark consisting of a representation of a bear in an upright position holding a huge stick of candy, upon a finding that the goods are of the same descriptive properties. Toulmin & Toulmin for applicant.

The full text of the decision of First Assistant Commissioner Kinnan follows:

The applicant has appealed from the decision of the examiner of trade marks denying registration of a mark consisting of a pictorial representation of a bear standing upon a block presumably representative of a cake of ice, used upon mints. The ground on which registration was denied is that the mark is confusingly similar to the mark of Ed. L. Biesenbach & Co., registered November 23, 1920, No. 137123, which consists of a representation of a bear in an upright position holding a huge stick of candy.

The applicant contends that mints, upon which it uses the mark, are not candy; that the word mints has a

distinct meaning in the trade and such goods would not be called for by the name candy. The view is pressed that mints are so far different from a stick of candy, a representation of which latter consitutes a material part of the registered mark, that confusion would be improbable.

It is further noted by the applicant that the postures of the two bears differ and that in view of such differences and the difference in the specific character of the goods, registration should be granted the applicant.

It must be deemed the applicant's goods constitute but one particular kind of candy and would be very likely to be confused with the goods of the registrant if both classes of goods under the respective trade marks appeared in the same market. The registrant's mark is applied to candies and there is nothing upon which to base the view that its use has been restricted to stick candy.

Even if this were true the goods of both parties belong to the same class, candy, are sold to the same class of customers over the same counters, and would be likely to be called for as "bear" candy. It is believed the applicant should adopt a mark farther removed in design and appearance from that of the registrant.

The decision of the examiner is affirmed.

March 14, 1929.

## MARCH 26

# *Action Awaits Cancellation Ruling*

SOCIETE ANONYME DES ANCIENS ETABLISSEMENTS PANHARD & LEVASSOR v. PANHARD OIL CORPORATION. OPPOSITION NO. 4617, FIRST ASSISTANT COMMISSIONER OF PATENTS.

THE petition to reopen the opposition to permit petitioner, a successor of the applicant involved in the opposition proceedings, to take testimony, was denied on the ground that an appeal to the Court of Patent and Customs Appeals had been filed by the present petitioner from the Assistant Commissioner's decision holding that the issue raised by a petition for cancellation of the mark "Panhard" was res adjudicata in view of the fact that an opposition to registration of "Panhard" by applicant had been sustained.

The First Assistant Commissioner therefore held that final disposition of this petition should be held in abeyance until after the decision of the Court upon the appeal in the cancellation proceeding.

Mock & Blum for Societe Anonyme Des Anciens Etablissements Panhard & Levassor. Julian S. Wooster for Panhard Oil Corporation.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

Panhard Oil Corporation, through its counsel, has presented a petition to revive and reopen this opposition to permit petitioner, which is the successor of the applicant involved in said opposition proceeding, to take testimony. This opposition proceeding was decided against the petitioner's predecessor on December 21, 1925, by default.

The history of the proceedings between the parties to this opposition and those in interest with them is somewhat involved and will be here set forth somewhat in outline, which will be deemed sufficient for the disposal of the present petition.

**Mark "Panhard" Granted.**

It satisfactorily appears that the party George A. Haws obtained a registration February 8, 1913, No. 90329, for the mark "Panhard" used upon lubricating oils and greases, and that thereafter the Panhard Oil Corporation of New York succeeded to the business, trade mark rights and good will of the said Haws and on November 25, 1922, filed an application for reregistration of this same mark "Panhard." Although the previous registration of 1913 had not expired, yet this application of 1922 was passed for publication March 9, 1923.

Opposition proceedings were then instituted by Societe Anonyme des Anciens Etablissements Panhard & Levassor, of Paris, France. This opposition was allowed to go to judgment by default, upon the advice of counsel for Panhard Oil Corporation of New York, the applicant for reregistration, such advice being given by an attorney, Thomas A. Hill, whose services were obtained to represent the applicant company by William H. Conant, a proper official or manager of such applicant company. The

judgment sustaining the opposition was rendered December 21, 1925, and became final since no appeal was filed.

It is claimed by petitioner that although Conant received and accepted the advice of counsel, Hill, to permit the opposition proceedings to go by default yet he was never made aware of the final judgment in such proceedings. It is further alleged that the instant petitioner, Panhard Oil Corporation of New Jersey, which succeeded to the business and trade mark rights of the applicant corporation involved in the opposition proceedings, was a purchaser in good faith and without notice of the prior judgment in the opposition proceedings.

Conant appears to have been fully aware of the opposition proceedings since he obtained the counsel to defend them, and must be charged with a knowlege, because he could have obtained it from his counsel, of the final determination of the opposition proceedings. Since Conant is an official or manager of the present corporation the instant petitioner, such corporation must likewise be held to have taken its title to the business and rights subject to the rights in the opposition proceedings.

It is claimed by the present petitioner that the reason given by counsel, Hill, to his clients for allowing the opposition proceedings to go to judgment by default was that the then applicant company, Panhard Oil Corporation of New York, still retained its ownership of the mark and the registration issued its predecessor in business, Haws, February 8, 1913, and the opposition proceedings would not interfere with the rights exercised under such registration.

### Cancellation Petition Presented.

After the judgment in the opposition proceedings, rendered December 21, 1925, the opposer in those proceedings presented on March 30, 1927, a petition for the cancellation of the registration of February 8, 1913, of the mark granted to petitioner's predecessor, Haws. After the registrant, the present petitioner, had filed its answer a motion was presented by the petitioner for cancellation that, under the provisions of equity rule 29, judgment be entered against the registrant on the ground that the answer was an insufficient defense, since the cause of action in that proceeding was the same as that in opposition No. 4617 and the parties were the same and the issue raised by the petition for cancellation was res adjudicata. That motion was granted by the examiner of trade mark interferences and his decision was affirmed on appeal to the Assistant Commissioner. An appeal from the holding of the Assistant Commissioner is now pending before the Court of Patent and Customs Appeals, Act of March 2, 1929, in effect April 1.

It is alleged in connection with the petitioner to revive and reopen the opposition proceedings, and certified copies in support of such allegations have been submitted, that a suit was brought by the registrant, Haws, against H. T. Alexander & Company, exclusive licenses of the opposer in the opposition, to stop infringement by such Alexander & Company of the Haws trade mark Panhard, such suit being filed in the Supreme Court of the State of New York; that the defendant, Alexander & Company, filed a counter claim against Haws praying injunction and accounting; that after a trial on the merits neither the defendant nor its licensor proved any date of adoption and use of the trade mark Panhard for oils prior to the date of October, 1904, which was the date established by Haws, and the court rendered an interlocutory decree on the merits in favor of Haws, dismissed the counter claim of Alexander & Company and rendered a final decree in December, 1910, perpetually enjoining Alexander & Company and awarded Haws damages and costs.

### Certified Copies Shown.

Certified copies of the record of the trial of this cause have been exhibited and the opposer has not denied that they are genuine. Upon all these circumstances, the petitioner seeks a revival and reopening of the opposition to the end that its rights may be protected, its rights may be served and it may have an opportunity to prove its ownership and right of registration of the mark.

In view of the appeal pending before the Court of Appeals, it is believed the petition should not be granted at this time. Many of the reasons presented to the court for its consideration of the question of estoppel by reason of res adjudicata are likewise reasons which would be presented and considered in connection with the petition to reopen the opposition upon the judgment of which the estoppel is based. If the court should find there was no estoppel by reason of res adjudicata, the cancellation proceedings would presumbaly be reopened for the taking of testimony and

a consideration upon the merits. This would render it unnecessary to reopen the opposition proceedings. It is believed the final disposition of the instant petition to revive and reopen the opposition proceedings should be, and it is, held in abeyance until the decision of the court upon the appeal in the cancellation proceedings.

March 11, 1929.

# Denial of Appeal As Issue Settled

AMERICAN FRUIT GROWERS, INC. v. JOHN BRAADLAND, LTD. APPLICATION FOR CANCELLATION No. 1837, ASSISTANT COMMISSIONER OF PATENTS.

IN holding that the doctrine of res adjudicata applies not only to matters previously adjudicated but also to all matters that could have been adjudicated in the former proceeding, the Assistant Commissioner affirmed the action of the acting examiner of interferences in dismissing a petition for cancellation of a trade mark where this petition raised a question regarding prior use of his mark on canned goods, that could have been raised in the opposition proceeding had between the same parties and on the same subject matter.

R. T. M. McCready and Charles R. Allen for American Fruit Growers Incorporated. Mason, Fenwick & Lawrence for John Braadland, Ltd.

The full text of the decision of Assistant Commissioner Moore follows:

The appellant, the American Fruit Growers Incorporated, appeals from the decision of the acting examiner of interferences dismissing its petition for the cancellation of the registrant's trade mark. Registration No. 233557, and recommending that said registration be not canceled.

The ground on which the petition for cancellation was dismissed is that the question herein involved, viz., the registrant's right to the registration of its trade mark, was finally adjudicated in Opposition No. 6648 between the same parties and involving the same subject matter.

The acting examiner of interferences points out that the only difference between the appellant's attack upon the registrant's right to its registration set up in Opposition No. 6648, and the one set up in this cancellation proceeding, is in the specific goods relied upon; that in the opposition proceeding prior use of the mark in question (Blue Goose) was alleged only on citrus fruits, such as oranges and lemons, and decidous fruits, such as cantaloups; while in this cancellation proceeding prior use of said mark is also alleged on certain canned goods, viz., canned fruits and vegetables.

The acting examiner holds that there was no good reason why the additional goods on which the appellant now claims use of its mark should not have been pleaded in the said opposition proceeding, and that the appellant is now estopped from contesting in the cancellation proceeding matters which could and should have been adjudicated in the former proceeding.

The appellant contends that it is relying on Registration No. 212033 in this proceeding, and that said registration was April 27, 1926, and could not have been pleaded in the opposition filed Sept. 8, 1925.

The appellant's Registration No. 212-033 was not a prerequisite to the pleading of prior adoption and use by the appellant of the mark in issue on canned fruits and vegetables, in the opposition proceeding, and the failure to so plead in the opposition proceeding, estops it from raising the question in this proceeding.

The doctrine of res adjudicata applies not only to matters previously adjudicated, but also to all matters which could have been adjudicated in the former proceeding.

The appellant also contends that the judgment in Opposition No. 6648 was in the nature of a nonsuit, and was not a final adjudication of the merits of the question in issue. Such contention is not tenable.

The record in the opposition proceeding shows that the merits of the registrant's right to register its mark were considered, and that it was decided that the goods pleaded by the appellant in opposition to the registrant's right to register were not of the same descriptive properties as the registrant's goods. If the appellant had appropriated its mark to canned fruits and vegetables prior to the opposition, as now contended, those goods should have been pleaded.

The question at issue is the same whether contested in an opposition proceeding or in a cancellation proceeding, and it was concluded in the opposition proceeding. The decision of the acting examiner of interferences is affirmed.

March 13, 1929.

## MARCH 28

# *Similarity of Marks for Perfumes*

GEORGE BORGFELDT & CO. v. FREDERICK STEARNS & COMPANY. OPPOSITION NO. 8448, ASSISTANT COMMISSIONER OF PATENTS.

THE applicant was denied registration of the mark "Jardin d'Or" for toilet preparations, over opposer's mark "Jade 'Or," used on goods of the same descriptive properties, the Assistant Commissioner applying the familiar rule laid down by the Court of Appeals of the District of Columbia to the effect that there is neither legal nor moral excuse for even an approximate simulation of a well known mark appropriated to goods of the same descriptive properties.

Conway F. Coe and Briesen & Schrenk for Borgfeldt & Co. Henry C. Thomson for Stearns & Company.

The full text of the decision of Assistant Commissioner Moore follows:

The applicant, Frederick Stearns & Company, appeals from the decision of the acting examiner of interferences sustaining the opposition of George Borgfeldt & Co. to the registration by the applicant of its trade-mark "Jardin d'Or," for perfume, toilet water and face powder.

The opposition is based upon prior adoption and use by the opposer of its trade-mark "Jade'Or" for toilet preparations, registered June 7, 1921, No. 143-558.

At the hearing it was agreed between the parties that the only question presented for decision is whether the two marks "Jade'Ore" and "Jardin d'Or," so nearly resemble each other as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

In order to determine whether trade marks are confusingly similar to each other, they are usually compared as to appearance, sound and signification.

In appearance, the two marks are quite similar. Both begin with Ja, and end with an apostrophe and Or. And the first word of each mark contains the letter "d."

In sound, the evidence shows that the opposer's mark is pronounced differently by different customers. With those unfamiliar with the French language, it is believed that both marks would be given much the same pronunciation.

As to signification, with the uneducated the two marks would convey no meaning. They would be regarded as arbitrary and fanciful marks. Few of the purchasing public unfamiliar with the French language would stop to analyze the two marks to determine their derivation and meaning.

The fact stressed by the applicant that no actual confusion had been shown, carries but little weight, as the applicant adopted its mark but a few months prior to the beginning of this proceeding.

I am of the opinion that the two marks, each considered as a whole, are confusingly similar to each other when appropriated to goods of the same descriptive properties, and that the familiar rule laid down by the Court of Appeals of the District of Columbia to the effect that there is neither legal nor moral excuse for even an approximate simulation of a well known mark appropriated to goods of the same descriptive properties, should be applied in this case.

The decision of the acting examiner of interferences is affirmed.

March 13, 1929.

## APRIL 2

# *Confusion In Minds of Buyers Despite Different Sales Field*

ANNIE M. MALONE v. ALADDIN PRODUCTS COMPANY. APPLICATION FOR CANCELLATION NO. 1407. FIRST ASSISTANT COMMISSIONER OF PATENTS.

THE decision of the Examiner of Trade Mark Interferences recommending that registrant's mark "Joro," used as a trade mark for soap in cake form for shampoos be cancelled in view of the prior adoption and use of the notation "Poro," as applied to various toilet articles and other preparations for shampoos by the petitioner, was affirmed.

It was concluded that the marks were confusingly similar, that they were used upon goods having the same descriptive

properties, and that the petitioner was prior in point of time and had built up a large business.

Respondent's contention that no confusion would result because the petitioner dealt exclusively with colored people, selling to them through agents, and not through drug stores, whereas registrant's soaps were sold in drug stores generally and for the most part to white people, was not sustained, the First Assistant Commissioner holding that colored people in purchasing goods from stores would confuse registrant's goods with those of petitioner.

Rippey & Kingsland for petitioners. Mida, Valentine & Jones and Albert L. Jacobs for Aladdin Products Company.

The full text of the opinion of First Assistant Commissioner Kinan follows:

This case comes on for review, on appeal of the registrant, respondent, Aladdin Products Company, of the decision of the examiner of trade-mark interferences sustaining the petition of Annie M. Malone, doing business under the style and name of Poro College, and recommending that the registration of the respondent be cancelled.

The respondent's mark, the registration of which is sought to be cancelled, comprises essentially the word "Joro," used as a trade mark for soap in cake form for shampoos. Petitioner bases her claim to damage on prior adoption and use and consequent ownership of the mark "Poro" used upon various toilet preparations, including soap and other preparations for shampoos. Petitioner sets up ownership of Registration No. 59546. Both parties have taken testimony and have presented briefs.

It is submitted in evidence on behalf of petitioner that the latter first used the mark "Poro" on a soap in liquid form for use in shampoos as early as 1918 and that subsequently, about 1922, the use of the mark was extended to soap in cake form which is used for shampoo purposes. The use of the mark on the goods as above noted has been continuous since 1918. It is established that petitioner has built up a very large trade, the goods under the trade mark "Poro" being sold by some 80,000 agents, and that petitioner is, in consequence, in possession of a valuable good will as an asset to her business.

The respondent claims the year 1922 as the earliest date of adoption and use of its notation "Joro," so the petitioner adopted and used her mark from a period about four years prior to the date the respondent claims to have adopted and used its mark. Priority of adoption and use having been established by petitioner, the goods possessing the same descriptive properties and the marks being so similar that if they appeared upon like goods in the same market confusion would be inevitable, none of which conclusions is seriously controverted by the registrant, it would seem the petition should be granted.

### Course of Instruction.

It is shown that petitioner conducts a training school known as Poro College, and that all agents who sell the preparations of petitioner must first take a cource of instructions in such college, and that the petitioner's goods are sold only by such agents directly to consumers or beauty shops, and are not sold through drug stores, novelty stores, or any general stores. It is shown that the agents are colored people, and that they deal almost, if not wholly, exclusively with the colored people.

The registrant has submitted in evidence the negative results of attempts to purchase petitioner's goods in drug stores located in sections where the population is largely colored. In view of the testimony submitted on behalf of petitioner it may be deemed conceded that the latter's goods are not generally sold in drug stores or in stores of the character that deal with the registrant's goods.

It is further submitted on behalf of the registrant that its goods are sold exclusively, or almost so, to members of the white race and sold in drug stores and other stores carrying this general class of goods. The view is pressed that, under these circumstances, confusion of goods or of origin would be quite unlikely.

It may well be that the present method of marketing petitioner's goods is such that they would not be likely to be purchased by members of the white race, but it is not deemed at all probable that members of the colored race would not purchase the registrant's goods believing they were purchasing those of petitioner. It cannot be considered probable all, or even a large proportion, of the members of the colored race would know of the method employed by petitioner in marketing her goods.

It is a matter of common knowledge that in cities having a considerable percentage of colored people members of both races purchase goods in the same stores, more especially in the same drug stores. In the city of Washington this

is so well known that judicial notice may be taken of it. Members of the colored race seeing registrant's goods under a trade mark so nearly like that of petitioner would readily be led to think the goods of both parties had the same origin.

The class of customers purchasing goods of this character would not be likely to consider the matter very carefully, but would be influenced by the sound of the name and would make a purchase quickly and without much thought.

It is believed the registrant should have adopted a mark farther removed from that owned by petitioner. Where there is doubt it is resolved against the newcomer.

The examiner of trade-mark interferences has noted certain adjudicated cases as supporting his view that the petition should be granted. It is believed the case of Hay v. Malone, 288 O. G. 431, 50 App. D. C. 399, is persuasive that the marks in the instant case are confusingly similar.

The decision of the examiner of trade-mark interferences granting the petition is affirmed and the cancellation of the registrant's mark will be made if this holding is not reversed or modified by appeal.

March 26, 1929.

## APRIL 3

# *Trade Mark for Oils and Greases*

EX PARTE STANDARD OIL COMPANY OF NEW JERSEY. COMMISSIONER OF PATENTS.

THE term "Take It Yourself" was held not registrable as a trade mark for oils and greases on the ground that it merely describes the manner in which the article is merchandised and, to that extent, describes a characteristic of the article itself.

Commissioner Robertson stated that in view of the common practice in grocery stores and cafeterias of permitting the customer to help himself and of the fact that measuring pumps have been invented and patented to be used in connection with automatic vending mechanism, it was evident that the mark would indicate to purchasers that they did not have to be served by an individual but could "take" the goods in the way they were arranged and make payment therefor.

The decision of the examiner of trade marks was affirmed.

The full text of the decision of Commissioner Robertson follows:

This is an appeal from a decision of the examiner of trade marks refusing registration of the term "Take It Yourself" as a trade mark for oils and greases.

The examiner refused registration on the authority of the decision in Ex parte Brennan, Fitzgerald & Sinks, 151 O. G. 449, 1910 C. D. 30, in which it was held that the term "Servself" was not registrable as a trade mark for lunches, sandwiches, etc. He also referred to certain patents showing dispensing pumps, designed primarily to be used in dispensing gasoline, from which the purchaser may obtain the gasoline upon the insertion of a coin into the device.

In the decision cited it was pointed out that the specimens filed indicated that the goods were wrapped in oiled paper or placed in packages so that the customer of the restaurant in which they are for sale may serve himself from the package or help himself thereto, and a number of decisions with reference to descriptive marks were cited, including the decision in Ex parte Bronson Company, 87 O. G. 1782, in which it was held that "Ever Ready" was not registrable as a trade mark for coffee mills.

Of course it is true that the mark here sought to be registered does not describe the goods or a quality thereof in the sense that it states whether they are high or low grade products or what their physical composition is. It does, however, very clearly state the manner in which the goods are to be merchandised. In other words, in view of the common practice in grocery stores and cafeterias of permitting the customer to help himself and of the fact that measuring pumps have been invented and patented to be used in connection with automatic vending mechanism, so that a person, by depositing the proper coin in a slot, can get the desired amount of gasoline, it is evident that the mark should indicate to purchasers that they did not have to be served by an individual, but could "take" the goods in whatever way they

were arranged to be taken and make appropriate payment therefor. The reasoning of the Brennan case above cited is believed to be clearly applicable to this case.

It is contended on behalf of the applicant that a number of decisions have been rendered since the Brennan decision which would have the effect of modifying the holding therein, and attention is called to a number of slogans which have been registered.

No case has been cited, nor has any been found, in which the Brennan decision was overruled, nor does it appear from any of the slogans to which attention has been called that their registration would prima facie take away from the public the right to use the common words which would describe the physical characteristics of the goods or the manner in which the goods are sold.

In the case of Drive It Yourself v. North et al., 130 Atl. Rep. 57, 16 T. M. Rep. 159, the Court of Appeals of Maryland held that the words "Drive It Yourself" are descriptive of a business in which automobiles are hired without drivers to people who desire to do their own driving, and said "under the authorities heretofore cited it is not the subject of exclusive appropriation."

The question of the character of these words was very fully discussed and, after citing a number of decisions in analogous cases, the court said:

"The words are ordinary English words in everyday use. The combination in which they are used, when applied to the hiring of automobiles, accurately designates and describes the character and nature of the business to which they refer, and the exhibits filed in the case show that the phrase is used and understood throughout the country as indicating that particular business."

In the case of Ault & Wiborg v. Chichester, 191 Fed. Rep. 741, the court held that the term "No Wash Up" was descriptive as applied to printing rollers, since these words clearly imply that after use the rollers did not have to be washed.

In the case of Ungles-Hoggette Mfg. Co. v. Farmers' Hog & Cattle Powder Co., 232 Fed. Rep. 116, the term "Dry-Dip" was held descriptive as applied to a powder to be sprinkled on animals for killing vermin. In that case the court said:

"The word "dip" as a noun has a well-understood meaning. In connection with animal husbandry this word, taken by itself, therefore, signifies some liquid preparation, consisting of a mixture of parasiticides, like sulphur coal tar creosote, arsenic, or similar agents, into which animals infected with lice and other vermin may be plunged for treatment.

"The word 'Dry-Dip' employed in connection with animal husbandry would, presumptively, mean some dry or powdered preparation intended to perform the same service. So it appears that the dry dip served the same purpose and accomplished the same result as the liquid dip, with an unimportant difference—in their application. The infected animal is driven or plunged into the liquid dip, while the dry dip is sprinkled upon the infected animal."

In the case of Beckwith v. Commissioner of Patents, 274 O. G. 613; 252 U. S. 538, the Supreme Court said:

"It was settled long prior to the Trade Mark Registration Act that the law would not secure to any person the exclusive use of a trade mark consisting merely of words descriptive of the qualities, ingredients or characteristics of an article of trade.

"This for the reason that the function of a trade mark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of qualities, ingredients or characteristics, when used alone, do not do this. Other like goods, equal to them in all respects, may be manufactured or dealt in by others, who, with equal truth, may use, and must be left free to use, the same language of description in placing their goods before the public."

That reasoning applies clearly to the present case, since others having systems by which goods of the same descriptive properties are dispensed without the service of a salesman could truthfully describe such goods by the term "Take It Yourself."

In Ex parte Robert E. Miller, Inc., 260 O. G. 733, it was held that "U-Put-On" is not registrable as a trade mark for rubber heels for shoes. While there it was held that this term directly states the character of the heels, namely, that they are of such a construction that the purchaser himself applies them or may apply them, the reasoning of the case is thought to be applicable to the present case.

In that decision the then Assistant Commissioner said:

"The descriptiveness here arises from

applying the mark to the goods, as it must always be applied. To call a given article "U-Put-On" rubber heels is to state a capability of those particular rubber heels."

To paraphrase that decision, to call an article "Take It Yourself" is merely to describe the manner in which the article is merchandised and, to that extent, to describe a characteristic of the article itself.

It must be held, therefore, that the mark is not registrable and the decision of the examiner of trade marks is affirmed.

March 30, 1929.

# *Use of Geography in Trade Marks*

EX PARTE SEMET-SOLVAY COMPANY. ASSISTANT COMMISSIONER OF PATENTS.

A NOTATION consisting of the words "Semet-Solvay Coke," with the word "Coke" disclaimed, was held registrable as a trade mark, the words "Semet" and "Solvay" not being considered as an individual name and a geographical term, respectively, in view of the fact that only one instance of the use of each for the purpose stated was cited. The decision of the examiner of trade marks refusing registration was reversed.

Forbes Silsby for appellant.

The full text of Assistant Commissioner Moore's opinion follows:

The applicant appeals from the decision of the examiner of trade marks finally refusing to register the applicant's mark consisting of the notation "Semet-Solvay Coke," with the word "Coke" disclaimed.

**Grounds for Refusal.**

The ground on which registration was refused is that the word "Semet" is merely a surname not distinctly displayed, and the word "Solvay" is geographical, neither word being registrable under Section 5 of the Trade Mark Act of February 20, 1905, which provides:

"That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed or woven in some particular or distinctive manner, * * * or merely a geographical name or term, shall be registered under the terms of this act,"

and that a trade mark cannot become registrable by merely combining unregistrable words, citing in support of the latter proposition the decisions of the Court of Appeals of the District of Columbia in In re Meyer Brothers Coffee and Spice Company, 140 O. G. 756; 32 App. D. C. 277; 1909 C. D. 312, and of the Commissioner in ex parte American Lakes Paper Company, 350 O. G. 469; 1926 C. D. 79.

The applicant contends that the examiner erred in holding that the word "Semet" and the word "Solvay" are of such significance as a surname and a geographical term, respectively, as to bar their registration as a trade mark, and, irrespective of whether the word "Semet" and the word "Solvay" are each individually nonregistrable as trade marks because a surname and geographical term, respectively, in holding that the combined mark "Semet-Solvay" is nonregistrable as a trade mark to applicant.

The applicant also contends that the facts in the instant case are not controlled by the decisions cited by the examiner, but by the decisions of the Supreme Court in Beckwith v. Commissioner of Patents, 274 O. G. 613; 252 U. S. 538; 1920 C. D. 471; and Hamilton Brown Shoe Company v. The Wolf Brothers & Company, 225 O. G. 1441; 240 U. S. 251; 1916 C. D. 281.

The Court of Appeals of the District of Columbia distinctly stated in the Meyer Brothers Coffee and Spice Company case that:

"This Court has held that a registrable mark cannot be made by combining two nonregistrable words,"

and if it be conceded that the words "Semet" and "Solvay" when considered apart are unregistrable, then under the ruling of the Court of Appeals, said words when combined would not be registrable.

It is not seen that the ruling of the Court of Appeals is in conflict with the decisions of the Supreme Court. In the Beckwith case the registrability of the mark did not depend upon the descriptive matter; and in the Hamilton Brown Shoe case the mark was a descriptive phrase, descriptive of the girl and not of the goods.

This case it is believed, falls under the ruling of the Commissioner in ex parte United Roofing & Manufacturing Company (1913 C. D. 35). The word

"Semet" is not a generally recognized surname. The examiner cites but a single instance (St. Louis Directory for 1924) of the use of the word as a surname. The applicant states that the word does not occur in either the current telephone directories or in the general directory for the City of New York. Nor is it included in the 1928 directory for Washington, D. C.

**Not Reasonably Well Known.**

As to the word "Solvay," Lippincott's Gazetteer of the World gives it as the name of a village in Onondaga County, New York. It is not a reasonably well known geographical name, as contemplated by the statute. If the word "Lakeside," which appeared in the Postal Guide as the name of 16 or 17 post offices, and was found to be the name of two incorporated towns in the United States, was not a name of well known geographical places, such as would render probable that an ordinary person would regard the word as a geographical term (ex parte United Roofing & Mfg. Co., supra), then certainly the word "Solvay" would have no such effect upon the ordinary observer.

In view of the above it is believed that the applicant's mark would be generally regarded as arbitrary and fanciful and as such registrable.

The decision of the examiner of trade marks is reversed.

March 28, 1929.

## APRIL 5

# *Denial of Rehearing Cancellation*

MARSHALL FIELD & COMPANY v. THEODORE TRIVERS. MOTION TO REOPEN CANCELLATION PROCEEDING NO. 1630, COMMISSIONER OF PATENTS.

A MOTION filed by the petitioner requesting that the cancellation proceeding be reopened and tried de novo was denied upon a finding that no ground had been made out which would justify reopening the proceeding.

The motion was supported by records indicating insanity of the attorney originally instituting the proceeding; but it was found unnecessary to decide whether insanity would be sufficient ground for reopening the case. The petitioner introduced new evidence along with the motion, and no reason was given for not originally submitting it. The Commissioner ruled that a case will not be reopened unless the new testimony was not orginally in possession of the party now seeking to produce it, and could not have been obtained by the usual and expected search.

**Grounds for Basing Motion.**

Edward D. Jones and Albert L. Jacobs for Marshall Field & Company; Edgar M. Kitchen for Trivers.

The full text of the decision of Commissioner Robertson follows:

This is a motion that the above entitled cancellation proceeding be reopened and that the petitioner may be permitted to amend its petition for cancellation in the two cases originally numbered 1630 and 1631, but which were subsequently consolidated under the former number. The motion further asks that the decision of the Commissioner, dated November 30, 1928, be vacated and that the decision of the examiner of interferences be affirmed, or that the case be remanded to the examiner of interferences with instructions to "proceed with the trial thereof de novo and to fix new times for the taking of testimony in chief and in rebuttal on behalf of said Marshall Field & Company."

The motion is based on the ground that the attorney for Marshall Field & Company, who prepared the petitions for cancellation and examined the witnesses, was at the time of his actions mentally incompetent and incapable of properly analyzing the case of his client or properly conducting it.

The motion is supported by a certified copy of the records of the court in Illinois showing that the said attorney was found to be a "distracted person" and certain affidavits setting out in effect what new evidence can be introduced if the case is reopened.

The registrant has filed a motion that the motion to reopen be denied on the ground that the Commissioner of Patents is without jurisdiction to pass upon the questions raised therein.

No reason is found for so holding and the motion to dismiss is denied.

The decision of November 30, 1928, reversing that of the examiner of interferences and dismissing the petition for cancellation, was based on the ground

that the statement of the witnesses as to the date when the "Field-Knit" mark was first used by Marshall Field & Company was insufficient to establish that it was used during the year next preceding the registrant's application for registration, since no documentary evidence had been introduced nor were any circumstances given by which the alleged dates were fixed.

The present motion to reopen is accompanied by certified copies of the records of the Probate Court of Cook County, Illinois, from which appears that on December 5, 1928, a jury found Arthur E. Wallace, who was the attorney for the registrant, to be a distracted person and incapable of managing and controlling his estate, and that Minnie E. Wallace was appointed as the conservator of the said Arthur E. Wallace.

Obviously, however, that finding does not establish that Mr. Wallace was not in his right mind and capable of properly attending to business at the time that the petition for cancellation was prepared and executed on the 30th day of July, 1927, nor does it establish that Mr. Wallace was not in proper possession of his faculties on the day that the testimony was taken, namely, January 9, 1928.

The original petitions for cancellation allege use by Marshall Field & Company of the trade mark "Field-Knit," and that the mark registered by the registrant Trivers, as shown in Registration No. 205977, is identical with the name by which the goods of the petitioner for cancellation had long been known. The proposed amended petitions for cancellation allege use by Marshall Field & Company of the mark "Field Seven-Fact," which was registered on January 5, 1926, being Registration No. 207568.

Not only is that registration not mentioned in the petition for cancellation, but it was not mentioned in the testimony of Pierce. He stated in his testimony that he was the assistant secretary of Marshall Field & Company and, in response to a question by counsel, whether registrations had been procured by Marshall Field & Company of marks used on clothing or piece goods in connection with which either the word "Field" or "Field's" forms the essential part of the trade mark, stated that they had, and in answer to Question 3 he listed a number of such marks which had been registered, but did not mention the mark "Field Seven-Fact."

It is to be noted especially that the affidavits in support of the motion to reopen do not purport to supply simply documentary evidence as to the dates stated by the witnesses, and that they in no way corroborate those witnesses as to the time when the mark "Field-Knit" was first used.

The witness Bergquist, who is the affiant in one of the affidavits filed in support of the motion, gave the date since when one of the marks had been used as "the Spring of 1924" and when he was asked on cross-examination if he had any documentary evidence indicating the date, he answered: "Absolutely," and stated further that he could produce it and would do so, but it was not produced. The witness Pabst, on cross-examination, stated that the word "Field" alone had been used since "four years ago this spring." As the testimony was given in January of 1928, that would have fixed the use as beginning in the spring of 1924, and in answer to further questions he stated that he knew that was the date and that the month was April and, when he was asked how he fixed the date, he said: "By what our records show."

### Earliest Order Dated 1924.

None of the affidavits filed in support of the motion to reopen, however, set up a use as early as the spring of 1924, but they all allege a use "during the period between September 14, 1924, and September 14, 1925." The latter is the date on which the registrant's applications were filed. With respect to the affidavit of Read, relating to ordering clothing containing "Field-Knit" labels, it is noted that the earliest of these orders is dated September 23, 1924.

It is well settled that a case will not be reopened for the taking of further testimony unless it can be shown that the testimony was "newly discovered," that is, was not in the possession of the party now seeking to produce it, and could not have been obtained by the usual and expected search.

Clearly no such a case has been made out here. It would have been just as easy apparently to have produced this evidence originally as to produce it now.

It is not necessary to decide whether, if it were established that the attorney was, unknown to his client, in no mental condition to have properly prepared the petition for cancellation or to have properly determined what evidence should be produced, that that would constitute sufficient ground for setting aside the decision and reopening the case to the extent not only of granting permission to take further testimony in support of the original petitions, but of allowing the

party to amend the petitions for cancellation and introduce new evidence in support of both the original and amended petitions, since, as above pointed out, no such showing has been made herein. The original petition for cancellation was verified by Kersey Coates Read. Presumably he was familiar with the trade marks of Marshall Field & Company or could easily have made himself familiar therewith by searching the records of that company or consulting whatever employe or officer of the company had charge of the trade mark situation.

No reason whatever is given why, if the "Field Seven-Fact" registration was thought to be pertinent to the situation here involved, it was not referred to in the original petition for cancellation. Furthermore, it is presumed that some of the officials of Marshall Field & Company were consulted as to the witnesses to be called when testimony was first taken. It is also to be presumed that somebody was consulted as to the necessity of producing documentary evidence. There is no allegation in any of the affidavits that this was not the fact.

It must be held, therefore, that no ground has been made out which would justify reopening the proceedings.

The motion to reopen is denied.

## APRIL 6

# *Descriptivity of Article Mark*

EX PARTE THE PROSPERITY COMPANY, INC. ASSISTANT COMMISSIONER OF PATENTS.

REGISTRATION was denied applicant for the trade mark "Grid Head" for garment and laundry press machines, on the ground that it is descriptive, that it is definitive of the article rather than indicative of the originator or owner of the article.

Parsons & Bodell for applicant.

The full text of the opinion of Assistant Commissioner Moore follows:

This is an appeal from the decision of the examiner of trade marks finally refusing to register the applicant's trade mark "Grid Head" for garment and laundry pressing machines. The ground on which registration of the mark was refused is that the mark is descriptive of the goods.

It appears from the patent to Palmer, referred to by the examiner, and the patents to Grever, No. 979844, and Simpson, No. 1639458, that the part of garment pressing machines to which the applicant applies the words Grid Head, is usually termed in the art a head or a presshead, and that said head is sometimes formed with a formaminous bottom, or an equivalent structure, for distributing steam evenly over the surface of the garment while under pressure.

It also appears that the term "grid" is of such breadth as to include devices formed in whole or in part of wire netting, as, for example, a wire-bottomed mining sieve (see New Standard Dictionary).

In view of the above, it is believed that the words "Grid Head" are properly descriptive of the pressheads of the patented type; that they are definitive of the article rather than indicative of the originator or owner of the article, and that the refusal to register the applicant's mark was without error.

The decision of the examiner of trade marks is affirmed.

March 28, 1929.

## APRIL 9

# *Rights Where Mark is Unused*

THE UNITED STATES PRINTING AND LITHOGRAPHING COMPANY, PETITIONER, V. GRIGGS, COOPER AND COMPANY. NO. 372, SUPREME COURT OF THE UNITED STATES.

IT was held herein that the Trade Mark Act of 1905 does not allow a remedy upon it for infringing a trade mark registered under it where the alleged infringing acts occur within a State and do not affect interstate or foreign commerce.

The plaintiff in the lower court, owner of a trade mark "Home Brand" for various grocer goods sold in certain States, brought suit for infringement on the

ground that defendant is selling labels on similar goods, containing the word "Home," which labels are used in States other than those in which plaintiff has established a market.

The lower courts granted the relief prayed, but their judgment is reversed by the Supreme Court. On writ of certiorari to the Supreme Court of the State of Ohio.

The full text of the Court's opinion, delivered by Mr. Justice Holmes, follows:

This is a suit brought by the respondent, a corporation of Minnesota, against the petitioner, a corporation of Ohio, alleging that the plaintiff has a trade mark "Home Brand," registered in the Patent Office for various grocers' goods which it sells at wholesale in certain named States of the northwest; and that the defendant is printing and selling labels for similar grocers' goods, containing the word "Home," which labels are used by the purchasers in States other than those in which the plaintiff has established a market. No interference with interstate or foreign commerce is alleged.

The bill seeks an injunction against printing and selling such labels for any groceries that the plaintiff sells. The trial court found the facts to be as above stated and the Supreme Court held that the "purpose and effect of the (Trade Mark Act of February 20, 1905, c. 592, section 16; 33 Stat. 728 (C., Tit. 15, section 96)) was to project the trade mark rights of the registrant and owner thereof into all the States even in advance of the establishment of trade therein, and to afford full protection to such registrant and owner." It affirmed a judgment for the plaintiff giving the relief prayed and a writ of certiorari was granted by this Court.

In the Trade Mark Cases, 100 U. S. 82, it was held upon full consideration by a unanimous Court that the earlier acts attempting to give these unlimited rights were beyond the power of Congress.

Soon after that decision an Act of March 3, 1881, gave remedies for the wrongful use of a registered trade mark in foreign commerce or commerce with Indian Tribes. It was said that obviously the Act was passed in view of the above mentioned case, that only the trade mark used in such commerce was admitted to registry and that the registered mark could only be infringed when used in that commerce. Warren v. Searle & Hereth Co., 191 U. S. 195, 204, (see United Drug Co. v. Theodore Rectanus Co., 248 U. S. 90, 99), and the constitutionality of the Act even when so limited was left open. 191 U. S. 206.

The Act of 1905 goes a little farther and gives remedies against reproduction, etc., of the registered trade mark "in commerce among the several States" as well as in commerce with foreign nations, etc., Section 16, supra. A remedy for such infringement was given in Thaddeus Davids Co. v. Davids Manufacturing Co., 233 U. S. 461, see also American Steel Foundries v. Robertson, 262 U. S. 209. Baldwin Co. v. Robertson, 265 U. S. 168.

But neither authority nor the plain words of the act allow a remedy upon it for infringing a trade mark registered under it. within the limits of a State and not affecting the commerce named. More obviously still it does not enlarge common law rights within a State where the mark has not been used. General Baking Co. v. Gorman, 3 F. (2d) 891, 894.

Some attempt was made to support the decision upon other grounds, but we do not think them presented by the record, and they are not mentioned by the Ohio court. Judgment reversed.

April 8, 1929.

## APRIL 17

# *Resemblance of Marks for Soap*

ENOCH MORGAN'S SONS COMPANY v. JAMES F. C. MENLOVE. OPPOSITION No. 7898, ASSISTANT COMMISSIONER OF PATENTS.

"SOPONITE" as a trade mark for soap, hand cleaner and general house cleaner, was held not to be registrable over opposer's mark "Sapolio," used on goods of a like character for the reason that the marks so nearly resemble each other as to be likely to cause confusion. In the opinion reference is made to prior decisions in which "Soapolin" and "Saponit" were denied registration over the mark "Sapolio."

Archibald Cox and William G. Henderson for Enoch Morgan's Sons Company; Albert J. Fihe for Mr. Menlove.

The full text of Assistant Commissioner Moore's decision follows:

The applicant, James F. C. Menlove, appeals from the decision of the examiner of interferences sustaining the opposition of Enoch Morgan's Sons Company to the registration of the applicant's trade mark "Soponite" for soap, hand cleaner and general household cleaner.

The opposer bases its opposition to the registration of the applicant's mark upon prior adoption and use of the trade mark "Sapolio" for goods of a like character, and for which it has secured the following certificate of registration: No. 49646, dated February 13, 1906, and renewed.

The examiner of interferences sustained the opposition, and adjudged that the applicant was not entitled to register his trade mark, for the reason that the two trade marks so nearly resemble each other as to be likely to cause confusion in the mind of the public or to deceive purchasers. The examiner of interferences found the question not to be free from reasonable doubt in view of the rulings in Enoch Morgan's Sons Company v. Ward, 152 F. 690; v. Edler, Cox Manual No. 714; v. The Sanitary Products Company, 285 F. 1015, 52 App. D. C. 281; and resolved the doubt in favor of the prior user.

It appears to be agreed that the only question presented for decision is the likelihood of confusion between the two marks when contemporaneously appropriated to goods of the same descriptive properties.

This question appears to have been answered by the above adjudicated cases. In the case of Enoch Morgan's Sons Company v. The Sanitary Products Company, the Court of Appeals of the District of Columbia held that the contemporaneous use of the marks "Soapolin" and "Sapolio" on goods of the same descriptive properties would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. There is about as much difference between "Soponite" and "Sapolio" as between "Soapolin" and "Sapolio," and the reasoning of the Honorable Court would apply with equal force to the two cases. The same is true with respect to the other adjudications in which it was held that the marks "Sopono" and "Saponit," respectively, were confusingly similar to the mark "Sapolio." Each of these marks suggests the idea of soap, and their appearance and sound are not sufficiently distinctive to be carried in the mind of the average purchaser.

The decision of the examiner of interferences is affirmed.

April 10, 1929.

# *Opposition to Gelatine Notation*

POSTUM CEREAL COMPANY, INCORPORATED, v. HAAS-LIEBER GROCERY COMPANY. OPPOSITION NO. 7514, FIRST ASSISTANT COMMISSIONER OF PATENTS.

THE oposition to the registration of the notation "Pi-Lo-Jell" used upon gelatine powder, the word "Jell" being disclaimed, was sustained in view of the prior registration of the mark "Jell-O," used upon the same class of goods, it being held that purchasers would confuse applicant's mark with that of the opposer as they would forget or eliminate the prefix "Pi" and would likely call for "Lo-Jell" or "Jell-O." The decision of the examiner of interferences holding applicant entitled to registration of "Pi-Lo-Jell" was reversed.

James L. Norris for Postum Cereal Company, Incorporated; Howard G. Cook for Haas-Lieber Grocery Company.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

This case comes on for review, on appeal of the opposer, Postum Cereal Company, Inc., of the decision of the examiner of trade-mark interferences dismissing the opposition and adjudging the applicant, Haas-Lieber Grocery Company, entitled to the registration for which it has made application.

The applicant seeks registration of the notation "Pi-Lo-Jell," used upon gelatine powder, the word Jell being disclaimed, except in connection with the other elements of the notation. The opposer sets up ownership of the mark "Jell-O," used upon the same class of goods, and cites its registrations, No. 40383, issued May 19, 1903, and 70690, issued September 22, 1908.

No testimony has been taken by either party and, in consequence, the pleadings, for the purposes of this case, may be accepted as showing opposer was in the field in the use of its mark upon its goods long prior to any date claimed by the applicant. Since the goods are substan-

tially identical, the decision must hinge upon the question of similarity of the marks.

Both marks include the common word "Jell." This is descriptive of the goods and is not capable of exclusive appropriation by either party. There is no contention to the contrary. The opposer's mark, "Jell-O," is frequently pronounced as if it were "Jel-Lo," the sound of "L" being carried over to the last syllable. This pronunciation of the name of opposer's goods makes it apparent the applicant has reversed the two portions of the opposer's mark, making it read "Lo-Jell," and has then added the prefix "Pi." Purchasers, however, would readily forget or eliminate this prefix "Pi" and would be apt to call for the goods as "Lo-Jell" or "Jell-O."

There would appear to be probable confusion, in consequence, especially in view of the class of goods, their small cost and their being sold by the same dealers to the same class of customers, to be used for the same purposes. Purchasers would not have the two marks before them, but would depend to a considerable extent upon memory and, seeing the applicant's mark or hearing the name pronounced, would readily confuse it with that of the opposer. It is thought the applicant should have departed farther from the opposer's mark.

The applicant has cited a number of prior registrations, but the opposer has noted that "Cast-O-Jell" is for a different class of goods, "Fruit-O-Jell" has been canceled and only "Presto Jell" remains and it was registered in September, 1923, long subsequent to the opposer's date of adoption and use of its mark. The other marks to which applicant invites attention are not so similar to that of the opposer and were adopted long subsequent to its date of adoption and use. It is believed the marks should be considered as a whole, rather than separated into their syllables and, when this is done, it is believed confusion of names would be quite probable, if such appeared upon the same goods in the same market.

The decision of the examiner of interferences is reversed, the opposition is sustained and it is adjudged the applicant is not entitled to the registration for which it has applied.

April 10, 1929.

## APRIL 19

# *Appellant's Failure to Press Case*

EX PARTE THE OHIO CHEMICAL & MANUFACTURING CO. FIRST ASSISTANT COMMISSIONER OF PATENTS.

THE appeal to the Commissioner of Patents from a decision of the examiner denying registration of a trade mark was dismissed for the reason that no appeal brief was filed and no appearance made at the hearing on behalf of the appellant.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

Applicant, by its counsel, has appealed from the decision of the examiner denying registration as a trade mark of certain colorings applied to containers for nitrous oxide.

### Assignment of Error.

No brief has been filed and no appearance was made at the hearing. Beyond the mere assignment of errors, which constitutes but a formal statement that the examiner has erred, there has been nothing presented on the appeal as to why the denial of registration by the examiner is not proper. Under these conditions, it is clear the appeal should be dismissed.

While the rules of practice relating to the prosecution of applications for patents provide, rules 137 and 163, for the filing of briefs of the authorities and arguments on which an appellant relies to maintain his appeal to the Board of Appeals, and while the procedure is settled, ex parte Booth, 186 O. G. 291, that in case no brief is filed nor appearance made at the hearing, the appeal will be dismissed, yet it is noted that the rules relating to trade marks do not specifically require the filing of briefs on appeal.

It is substantially the uniform practice of courts of appeal to dismiss an appeal where no brief is filed and no appearance at the hearing is made on behalf of the appellant and it is believed this practice properly obtains in appeals to the Commissioner in trade mark cases. This practice is followed by the Court of Appeals of the District of Columbia, see Section 3, Rule 8, of said

court as amended October 18, 1911, published in 171 O. G. 1007, which states: "For failure to file the brief within the specified time, such appeal shall stand dismissed."

It is held, in consequence, that where appeals in trade mark cases are taken to the Commissioner from the decision of the examiner of trade marks or the examiner of trade mark interferences and no brief is filed nor appearance made at the hearing on behalf of appellant, such appeal will be dismissed.

The appeal in the instant case is dismissed.

## APRIL 24

# "Granite State" on Cotton Duck

EX PARTE JOHN BOYLE & COMPANY, INC. FIRST ASSISTANT COMMISSIONER OF PATENTS.

THE notation "Granite State" as a trade mark for cotton duck in the piece, was denied registration over the same mark applied to ginghams in the piece, the First Assistant Commissioner expressing the belief that there is no such distinction in the minds of the purchasing public between cotton piece ginghams and cotton piece duck as would avoid confusion of origin if both kinds of cotton piece goods appeared in the market carrying the same trade mark.

Fraser, Myers & Manley for applicant.

### Appeal From Examiner.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

The applicant has petitioned for a reversal of the decision of the examiner of trade marks denying registration under the Act of March 19, 1920, of the notation "Granite State" as a trade mark for cotton duck in the piece.

The ground upon which registration is refused is that the same mark has already been registered, No. 182862, issued April 15, 1924, by the Amoskeag Manufacturing Co. for use upon ginghams in the piece.

The examiner has cited certain decisions in connection with other applications for registration of trade marks in support of his holding. Perhaps the most pertinent of these is in case of Haas Brothers Fabrics Corporation v. Bliss, Fabyan & Company, 355 O. G. 187, 57 App. D. C. 44, wherein fabric or cotton artificial silk, used in large part for dresses for women and children was held to be goods of the same descriptive properties as sheer silk piece goods.

Since the registered mark and that for which the applicant seeks registration are substantially identical the decision here hinges upon whether the goods are of the same descriptive properties.

The applicant presses the view that its mark is confined to cotton duck in the piece used for tents, awnings, and similar coverings for out-of-doors, and that the goods are used to keep off sun, wind, and weather. On the other hand, as urged by the applicant, ginghams are used for women's clothing and for this reason confusion in trade would be unlikely.

The applicant states that it has been dealing in the class of goods to which its mark is applied for more than half a century, is familiar with the trade, and that there has been no confusion of origin of goods during this period, notwithstanding the registrant conducts business in the same locality as the applicant.

## APRIL 25

# Trade Mark "Doctor B. F. Davis"

EX PARTE PAYSON MARSH, DOING BUSINESS AS DR. B. F. DAVIS LABORATORY. FIRST ASSISTANT COMMISSIONER OF PATENTS.

REGISTRATION was allowed to applicant of a trade mark comprising the notation "Doctor B. F. Davis" arranged with the word "Doctor" above the name "B. F. Davis," the larger letters being in the center, the other letters tapering toward each end and the general outline completed by the use of two triangular dots at each end, on the ground that the

entire notation is set forth in an unusual and distinctive way.

Lester L. Sargent for applicant.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

The applicant has appealed from the decision of the examiner of trade marks denying registration of a mark comprising the notation "Doctor B. F. Davis," arranged with the word "Doctor" above the name "B. F. Davis," the larger letters being in the center, the other letters tapering toward each end and the general contour of the entire notation being completed by two small triangular dots at each end.

The examiner has refused registration on the ground that the notation being but the name of an individual cannot be registered as a trade mark because not written, printed, impressed, or woven in some particular or distinctive manner. In support of his view the examiner relies upon the case In re Landis Machine Company, 327 O. G. 4, 57 App. D. C. 404.

It is settled a name of an individual, firm, corporation, or association, printed in the form in which the name Landis appeared in the case relied upon by the examiner, is not so written or printed as to escape the prohibition of the statute.

A diamond, circle, triangle, square, or other rectangular outline is so common in connection with trade marks, signs, and other advertising matter that such mere outlines or shapes ordinarily cannot be held to bring such names, otherwise formed in ordinary characters, within the terms of the statute as to being written or printed in some particular or distinctive manner.

In the instant case, however, there is no outline or border but the entire notation is set forth in an unusual way and it is believed proper to hold that it is printed in a particular or distinctive manner and its registration is therefore not prohibited by the trade mark statute.

The decision of the examiner is reversed.

# *Notation on Beauty Preparations*

EX PARTE BEAUTY RESEARCH LABORATORIES, INC. FIRST ASSISTANT COMMISSIONER OF PATENTS.

APPLICANT was denied registration of the word "Masque," with certain of the letters written in a distinctive manner, as a trade mark for cosmetics upon a finding that the word constitutes a portion of trade marks owned by others, in consequence of which confusion would result, and that the term is descriptive since the purchasing public when pronouncing it would merely regard it as the common word "Mask."

Harry C. Alberts for applicant.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

The applicant has appealed from the decision of the examiner denying registration of the word "Masque" used upon skin salve preparations including facial creams and similar cosmetics. The ground upon which registration was denied is that the word "Masque" sometimes spelled "Mask" has been long applied to goods of this same character as exhibited by registrations to:

Isabel Cassidy, 39876, March 3, 1903; Walker Chemical Co., 78749, July 5, 1910; Florence Redmond, 116360, April 24, 1917; Marie Marthe Richard Vve. Grenoville, 177048, December 11, 1923; Guy T. Gibson, 186034, July 1, 1924; The Janay Mfg. Co., 194891, February 10, 1925; Florence N. Lewis, 205788, November 17, 1925.

And that, in consequence, the word sought to be registered as a trade mark is common property as applied to the applicant's goods and is not subject to exclusive appropriation by anyone.

**Distinctive Display.**

The applicant presses the view that the word being presented in script is distinctively displayed. While disclaiming the word "apart from the distinctive manner in which it is written," the contention of the applicant is that it is entitled to registration because the initial letter and the letter "q" are formed in a somewhat unusual manner and the latter letter is separated from the two letters that precede it as well as the two that follow it.

The applicant notes that portion of the statute which states "no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed * * * in some particular or distinctive manner," and urges that such portion of the statute supports the view that the mark is registrable. The fact must not be overlooked that this portion of the statute

relates to registration of the "name of an individual, firm, corporation, or association," and this section of the statute has no bearing upon the applicant's right to register this word.

The section of the statute which must bar the applicant registration, if such registration is to be denied, is that which states that a mark will not be registered if it so nearly resembles a "registered or known trade mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers" or that portion which states that words or devices will not be registered "which are descriptive of the goods with which they are used, or of the character or quality of such goods."

**Similarity in Sound.**

It is evident that notwithstanding the particular manner in which the word is represented, it would be spoken in the same manner as if it were printed in the most ordinary letters. The goods would be called for by the name "Masque" pronounced in the usual manner and since this word constitutes a material portion of the trade marks of others, as shown by the cited registrations, confusion in the mind of the public would be quite certain. While none of those previously registered marks which includes this word "Masque" can be deemed to give its owner exclusive right to the word "Masque" when used alone, yet it is believed such owners of trade marks are entitled to be protected against the confusion resulting from a late comer obtaining a registration of the word used alone. For this reason it is deemed the applicant should be denied registration.

The applicant states that "it is conceded by both the appellant and the examiner that the several prior registrations rely for distinction on other features, and that the word 'Masque' shorn of any particular, arbitrary and distinctive dress or weave, is incapable of exclusive appropriation." The applicant admits the term "Masque" is descriptive unless it is written in a distinctive manner, indicated in its application, for the brief notes that "the prior registrations cannot serve to decide appellant's right to registration of the particular and glaringly distinctive dress or weave of the term 'Masque' for this word is descriptive of the particular goods of the registrants' and appellant."

**Term Is Descriptive.**

Where a word is descriptive of the goods it is not registrable so long as its plain identity as a descriptive word remains. The purchasing public would still regard the applicant's notation, in pronouncing it, as merely the descriptive word "Masque." Since the word is descriptive the formation of the initial and the other letters in the particular way shown becomes immaterial. The applicant is still seeking registration of the descriptive word.

In the appellant's brief reference is made to the holding of the District Court for the District of Connecticut in the case of Charles Broadway Rouss, Inc., v. Winchester Co., 290 F. 463, that the mark "The Winchester" was a good common law mark and properly registered under the 1905 act. It should be noted that on appeal the U. S. Court of Appeals, 2nd Circuit, 300 F. 706, reversed the judgment of the lower court and also pointed out that the registration of the mark was obtained under the March 19, 1920, act rather than under the February 20, 1905, act. The reviewing court specifically ruled that the mark did not constitute a common law trade mark.

It must be held, both because the applicant's mark constitutes a portion of the marks of others previously adopted and used on the same goods, and, in consequence, confusion would result, and because the mark is descriptive, that the applicant is not entitled to registration.

The decision of the examiner is affirmed.

April 16, 1929.

## APRIL 27

# "Jack Frost" Dry Tea and Coffee

F. B. CHAMBERLAIN COMPANY v. CHASE & SANBORN. OPPOSITION No. 8801, ASSISTANT COMMISSIONER OF PATENTS.

THE notation "Jack Frost" as a trade mark for coffee and tea in dry form was found to be registrable over the same mark used by opposer for concentrated extracts and syrups for making non-alcoholic maltless beverages, the descriptive properties of the goods being different.

The Assistant Commissioner stated that, while classification of articles of trade for trade-mark registration purposes in the Patent Office is not conclusive that the goods separately classified have different descriptive properties, yet it is a factor to be considered in determining the question.

Opposer's mark was shown not to be entitled to a monopoly of use in a very wide field since the mark "Jack Frost" had been used by others as a trade mark for many articles of food.

Small & Small for F. B. Chamberlain Company; Louis H. Harriman for Chase & Sanborn.

The full text of the opinion of Assistant Commissioner Moore follows:

The opposer, F. B. Chamberlain Company, appeals from the decision of the examiner of interferences dismissing its opposition to the registration by the applicant, Chase & Sandborn of its trade mark consisting essentially of the notation "Jack Frost" for coffee and tea in dry form.

### Mark Used on Extracts

The opposition is based primarily on prior adoption and use by the opposer of the mark "Jack Frost" for certain enumerated food products, and for concentrated extracts and syrups for making non-alcoholic maltless beverages, for which latter use the opposer has been granted certificate of registration No. 246983, September 18, 1928. The opposer contends in effect that its concentrated extracts are of the same descriptive properties as the applicant's coffee and tea in a dry state.

The applicant contends that the articles of trade of the respective parties are not of the same descriptive properties, and bases this contention on the fact that the respective articles are separately classified in this office, and on the decisions in Johnson Educator Food Company v. Sylvanus Smith & Co., Inc. (175 O. G. 268; 37 App. D. C. 107; 1912 C. D. 440); Wagner's Sons Co. v. Orange Snap Co. (18 F. R. (2d) 554); and Schreiber Products Corp., v. McInnes Bros. (151 MS. Dec. 201; 16 T. M. Rep. 312).

While the classification of articles of trade for trade mark registration purposes, in this office, is not conclusive that two or more separately classified articles have not the same descriptive properties, yet it is a factor to be considered in determining this question and is controlling except in cases in which such separately classified articles clearly have the same descriptive properties.

### Possible Deception Is Test.

In the Johnson Educator Food case the following rule was restated:

"We think two trade marks may be said to be appropriated to merchandise of the same descriptive properties in the sense meant by the statute when the general and essential characteristics of the goods are the same. * * * The test is whether there is such a sameness in the distinguishing characteristics of the goods as to be likely to mislead the general public."

In Wagner's Sons Company case, it was held that ginger ale is not a beverage of the same descriptive properties as fruit beverages. And in the case of Schreiber Products Corporation it was held that coffee was not of the same descriptive properties as beer and near beer.

It is believed that much closer relationship exists between ginger ale and a fruit beverage, and between coffee and beer or near beer, than exists between concentrated extracts and syrups for making beverages and coffee and tea in a dry state. Certainly there is no such a sameness in the distinguishing characteristics of concentrated extracts and syrups and coffee and tea in a dry state as to be likely to mislead the general public.

### Court Decisions Cited

Reference may also be made to the decision of the Court of Appeals in the Peter Schoenhofen Brewing Co. v. John Sexton & Co. (200 O. G. 1117; 41 App. D. C. 510), in which grape juice was

held not to constitute goods of the same descriptive properties as beer; and to the decision in Christo Mfg. Co. v. Christian Moerlein Brewing Co. (9 T. M. Rep. 318; 129 MS. Dec. 192), in which near beer put up by a brewer was held not to be of the same descriptive properties as a sparkling limeade put up by a soda fountain supply company.

Nor is the opposer's mark so truly arbitrary, strange and fanciful as to entitle it to a monopoly of use in such a wide field as to exclude the applicant's use of the mark on coffee and tea in a dry state. The applicant points out that for many years the mark "'Jack Frost" has been used by others as a trade mark for many articles of food as evidenced by the trade mark registrations listed by applicant in its motion to dismiss the opposer's opposition, and referred to in its answer.

The applicant's contention to the effect that if the opposer were ever entitled to the exclusive use of its mark in such a wide field as to include all non-alcoholic beverages, and food products in a fluid state, and all ingredients from which the essentials of such beverages and food products are extracted, such as coffee and tea in a dry state, such right has been lost by laches in view of many registrations of Jack Frost by others for food products, is regarded as tenable.

I have considered all of the opposer's reasons advanced in support of its allegations of error in the decision of the examiner of interferences, but do not believe them to be of such a nature as to justify me in reversing or modifying said decision.

The decision of the examiner of interferences is affirmed.

## MAY 1

# *Similarity of Clothing Marks*

GUITERMAN BROS., INC., v. SHAPIRO & RUBIN. OPPOSITION NO. 7969, FIRST ASSISTANT COMMISSIONER OF PATENTS.

REFUSAL of registration to the applicant of the notation "Jiffy Jacks" and beneath such notation the words "Rival Brand," the latter words being disclaimed, as a trade mark for men's, women's and boys' jackets, was affirmed by the First Assistant Commissioner. The opposer owned the mark "Jiffy" used upon mechanics' suits, cloth shirts and trousers, and it was found that the marks were substantially the same and that the goods of the respective parties possessed substantially the same descriptive properties.

Bradbury & Caswell for Guiterman Bros., Inc.; Edwin Levisohn for Shapiro & Rubin.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

### Claim of Prior Use.

This case comes on for review, on appeal of the applicants, Shapiro & Rubin, of the decision of the examiner of trade mark interferences sustaining the opposition filed by Guiterman Bros., Inc., and adjudging the applicants not entitled to the registration for which they have applied.

The applicants seek registration of the notation "Jiffy Jack" and beneath such notation the words "Rival Brand," these latter words being disclaimed except in the relation shown, the mark being used on men's, women's, and boys' jackets.

The opposer claims adoption and ownership from a date long prior to that alleged by the applicants of the mark "Jiffy" used upon mechanics' suits, cloth shirts and trousers, and sets forth ownership of registration No. 178075, issued. January 8, 1924 for this mark used upon the goods as noted.

Neither party has taken testimony and in consequence the pleadings may be considered, for the purposes of this proceeding, as stating such facts as are properly pleaded. The opposer being first in the field and its mark having been bodily adopted by the applicants, they merely adding to it another word, the question of confusion may be said to hinge upon whether the goods of the respective parties possess the same descriptive properties. It is deemed plain enough that if the two notations appear upon the same class of goods in the same market, confusion would be quite probable, as purchasers would be apt to recognize and call for the garments by the name of "Jiffy."

The goods of both parties are clearly outer wearing apparel and belong to the same class. The wife or the son of the mechanic who was wearing a garment

bearing the opposer's trade mark might well purchase a garment bearing the trade mark of the applicants. The garments would thus be worn by members of the same household. Resulting confusion of origin would be almost certain.

While the applicants have called attention, in the brief of counsel, to a considerable number of registrations of this word "Jiffy," yet these are not pleaded in the answer, the goods upon which they appear are not identical, and such registrations furnish no reason for permitting the applicants to register a mark including the complete mark of the opposer.

The decision of the examiner of interferences sustaining the opposition and adjudging the applicant not entitled to the registration for which application has been made is affirmed.

April 25, 1929.

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## MAY 2

# *Unfairness in Use of Container*

HITT FLASHCRACKA COMPANY, PLAINTIFF, v. VICTORY SPARKLER & SPECIALTY CO. IN EQUITY NO. 711, DISTRICT COURT FOR THE DISTRICT OF DELAWARE.

AN injunction pendente lite against defendant's use of the notation "Flash Cracker" was not granted, but such injunction was allowed for unfair competition by defendant in the use of red, white and blue cartons and containers similar in size and appearance to those made by plaintiff, and in the use of a folder almost identical with that used by plaintiff.

### Lack of Sound Basis.

Mason, Fenwick & Lawrence, attorneys for plaintiff; Watson, Coit, Morse & Grindle, attorneys for defendant.

The full text of the opinion of the court, delivered by Judge Morris, follows:

I find in the record as now presented no sound basis upon which defendant's use of "Flash Cracker" may be enjoined pendente lite.

Whether defendant is estopped or otherwise barred from successfully contending that it is at liberty to use stripes upon a white background, used by it for some years upon its torpedoes, involves novel questions of law arising out of the former relations of the parties and their subsequent acts that should not be decided upon a motion for a preliminary injunction.

It is clear, however, that plaintiff had and possessed a distinctive dress for its cartons that it has not abandoned. This the defendant has imitated, almost copied. Moreover, it takes express use of this fact in its circular, plaintiff's Exhibit 6, distributed by it for the specific purpose of obtaining orders for its flash crackers. It there says:

"We are using red, white and blue cartons and containers similar in size and appearance to the type we developed for Hitt, . . . . ."

A clear intimation to dealers or jobbers that former purchasers of Hitt's goods would be found ready purchasers of defendant's product would be difficult to phrase.

### Unfair Competition.

These cartons have been displayed by defendant in a folder almost identical with that used by Hitt. Regardless of whether the defendant would have been at liberty to use the folder had it not displayed therein cartons unlawfully imitating the cartons of the plaintiff, I have no doubt that the use to which the folder has been put has made it, at least temporarily, a successful means of unfair competition.

Defendant's use of the circular, the folder, and the cartons in their present dress must be enjoined pendente lite.

April 12, 1929.

## MAY 3

# *Priority of Vested Rights in Mark*

EUGENE J. MURPHY COMPANY v. MCFARLAND. TRADE-MARK INTERFERENCE NO. 1112, ASSISTANT COMMISSIONER OF PATENTS.

DECISION on priority in this case having been suspended February 6, 1929, to give the parties opportunity to show cause why registration should not be denied each of them in view of prior vested rights to others to the mark in question, the final decision has just been reached.

The Assistant Commissioner found that the registrant assigned her interest in the mark on May 26, 1910, that the assignees came into legal possession of the trade-mark registration, that their rights continued under said registration during the life thereof—that is, until April 23, 1927—and that, as each of the parties adopted the mark prior to the latter date, neither could claim priority of adoption over the others.

Therefore, registration of the mark "Red Caps," as a remedy for colds, was denied each of the parties in interference.

The contention that the mark had been abandoned by the assignees was not sustained, it being held that abandonment of a mark may not be presumed but must, in the absence of proof, be held to the contrary.

Milton E. Lowey for Eugene J. Murphy Company; Spear, Middleton, Donaldson and Hall for Bender; Irving L. McCathran for McFarland.

The full text of the decision of Assistant Commissioner Moore follows:

On February 6, 1929, I suspended my decision on priority, and gave the parties 20 days within which to show cause why registration should not be refused to each of the parties, in view of existing vested rights in others to the mark in controversy, under trade-mark registration No. 62211, when the parties to this proceeding entered the field.

Each of the parties, Bender and McFarland, contended that the said prior trade mark had become abandoned, and requested that permission be given to take testimony to establish this alleged fact. On March 2, 1929, 40 days were allowed within which the parties might furnish evidence establishing facts showing abandonment of said mark by the prior owners thereof, and the time when the act of abandonment occurred.

As the 40 days have expired and as neither party has furnished any additional evidence of a controlling nature bearing on the question of abandonment of said prior registration, the case is taken up for final decision.

As to the question of priority of adoption and use of the mark "Red Caps" between the parties to this proceeding, on reconsideration it must be held that, as the testimony of Bender and Naylor stands unimpeached, it may be accepted as establishing adoption and use of said marks for colds, la grippe, etc., by Bender, prior to any date alleged by either of the other parties.

As to the question of abandonment of the mark "Red Caps" by Flora E. Schmauser, registrant of trade-mark registration No. 62211, registered April 23, 1907, the registrant has filed an affidavit in which it is stated "that use of this trade mark was voluntarily abandoned by her on or about the year 1909."

The assignment records of this office, however, show that the said Flora E. Schmauser on May 26, 1910, assigned to Dr. R. A. Gamble and W. E. Armstrong, for a valuable consideration, all of her right, title and interest in the said trade mark and in the business with which it was used, and she may not now be heard to say that she abandoned the mark before the date of assignment. The fact that she had parted with her interest in the trade-mark is a reasonable explanation as to why she has not used the mark since May 26, 1910.

The parties, Gamble and Armstrong, having come into legal possession of said trade-mark registration, and as the registration of said mark is prima facie evidence of ownership, and as abandonment of the mark may not be presumed, it must be held in the absence of proof to the contrary, that the rights of Gamble and Armstrong continued under said registration during the life thereof, viz., until April 23, 1927.

**Neither Prior to Other.**

As each of the parties to this proceeding adopted said mark and appropriated it to a remedy for colds, etc., prior to April 23, 1927, neither was prior to the other in point or time, since neither could in any event date priority of right to use said trade-mark beyond the time when the prior owners surrendered title by act of abandonment, assuming the

said trade-mark to have been abandoned by Gamble & Armstrong. This conclusion is fully supported by the decision of the Court of Appeals of the District of Columbia in Justin Seubert, Incorporated, v. A. Santaella & Company, referred to in my decision of February 6, 1929.

The decision of the acting examiner of interferences that neither Eugene J. Murphy Company nor Charles McFarland is entitled to register said mark is affirmed. The decision of the acting examiner of interferences that Walter C. Bender was prior to the other parties in adopting and using said trade-mark is affirmed.

It is ordered that registration of the mark "Red Caps" for a remedy for colds, etc., be refused to each of the parties to this controversy, as neither could claim priority of right to use said trade-mark over the others.

April 23, 1929.

# Similar Notation for Plaster Boards

PLASTOID PRODUCTS, INC., v. UNITED STATES GYPSUM COMPANY. OPPOSITION NO. 6905, FIRST ASSISTANT COMMISSIONER OF PATENTS.

REGISTRATION to applicant of the notation "Rocklath" as a trade mark for plaster boards and plaster wallboards, was denied upon a finding that the opposer was first in the field and used the notation "Locklath" upon goods having the same descriptive properties, it being stated that while the first portions of each of the marks were quite dissimilar in significance yet they were so alike in spelling and sound that the marks as a whole were deemed confusingly similar.

Albert J. Fihe for Plastoid Products, Inc.; Jones, Addington, Ames and Seibold for United States Gypsum Company.

Appeal of the Applicant.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

This case comes on for review, on appeal of the applicant, United States Gypsum Company, of the decision of the examiner of trade-mark interferences sustaining the opposition filed by Plastoid Products, Inc., and adjudging the applicant not entitled to the registration for which it has applied.

The applicant seeks registration of the notation "Rocklath" used upon plaster boards and plaster wallboards. The opposer sets up adoption and ownership of the notation "Locklath" used upon identically the same kind of goods, namely, plaster board and plaster wallboard. Both parties have taken testimony.

In the applicant's brief before the examiner of interferences, objection was made to certain testimony taken by the opposer in rebuttal on the ground that it was testimony-in-chief. The examiner, in view of this objection, did not consider such rebuttal testimony. The applicant now withdraws objection to the consideration of this testimony and it will be reviewed.

The testimony submitted on behalf of the applicant satisfactorily establishes the use of the notation "Rocklath" continuously since June, 1925. Substantially these facts are admitted in the stipulation, page 10 of the applicant's record.

The testimony submitted on behalf of the opposer is deemed to satisfactorily establish use by it of the notation "Locklath" continuously since at least several years prior to the date established by the applicant. While the applicant, in its brief, urges the view that there is no documentary evidence showing use by the opposer of the latter's mark prior to June, 1925, when the applicant entered the field, yet it is deemed the testimony of Routt, Forker and Crouchley fairly proves prior adoption and continuous use on behalf of the opposer.

There is no rule of law or of equity which precludes the acceptance of proof of the character submitted by the opposer. In answer to Q. 6, Routt fixes the use of the trade mark of his company at least as early as 1919 and testifies, Q. 7, as to sales in various States and in Honolulu and Japan.

Exhibit No. 1 is identified by the witness as a sample of the goods sold and the manner in which they bore the trade mark. The explanation, Q. 12 to Q. 14, XQ. 70, of the change in the manner of applying the trade mark is deemed both reasonable and satisfactory.

The publications, Exhibits Nos. 5, 6, 7 and 8, do not of course establish trade mark use, but they are evidence that the opposer was selling or offering for sale goods under its trade mark, since it is not reasonable to suppose a company or corporation would expend money in ad-

vertising goods under a trade mark or trade name when it had no such goods for sale.

**First in the Field.**

The witness Forker positively testifies, XQ. 25 to XQ. 28, that the goods shipped to Japan bore a trade mark similar to that on opposer's Exhibit No. 1, and that he saw this mark on the goods. The witness Crouchley testifies concerning the shipment to Japan of the goods of the opposer and fixes the date, Qs. 8 to 12, as in 1921 or 1922.

His testimony is quite clear that the mark appeared upon the goods sold by his company prior to June, 1925, the earliest date established by the applicant. It must be deemed satisfactorily shown that the opposer was first in the field with its mark.

While the first portions of each of these marks have quite dissimilar significance, yet they are so alike in spelling and sound that the marks considered as a whole are deemed confusingly similar. The difference is in the initial letter and this is not enough to distinguish one mark from the other.

The decision of the examiner of interferences sustaining the opposition and adjudging the applicant not entitled to the registration for which it has applied is affirmed.

April 23, 1929.

## MAY 4

# *Prospective Damage as Warranting Rejection of Mark for Polishes*

YANKEE POLISH COMPANY, INC. v. YANKEE DANDY PRODUCTS COMPANY. OPPOSITION NO. 8328, FIRST ASSISTANT COMMISSIONER OF PATENTS.

A MOTION to strike certain portions of the brief presented on behalf of the applicant was denied, it being stated that the testimony in question would be given only such weight as seemed justified.

The First Assistant Commissoner affirmed the decision of the Examiner of Trade Mark Interferences sustaining the opposition to registration of applicant's composite trade mark, made up in part of an enlarged rectangular background bearing the representation of the sun with heavy rays extending therefrom, with the word "Yankee" appearing above the outline and the words "For Duco Finish Varnish Enamel or Furniture Body Polish" appearing below the entire representation.

**Same Descriptive Properties.**

The decision holds that, although the opposer did not establish prior use of the word "Yankee" as a trade mark, yet the evidence disclosed that it had used the word for a long time on its goods, and this justifies the conclusion that it would be damaged in its business if applicant be permitted to register its trade mark

Although the opposer failed to establish use of the notation "Yankee" on polishes other than for shoes prior to the applicant's entrance into the field, it was stated, these polishes possess the same descriptive properties as those for which applicant used its mark.

Geo. Kimmel for Yankee Polish Company, Inc.; Dean, Fairbank, Obreight & Hirsch for Yankee Dandy Products Company.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

The party, Yankee Polish Company, Inc., has filed a motion to strike certain portions of the brief presented on behalf of the applicant. It is not deemed proper to grant this motion although the testimony, upon which this portion of the brief is based, will be given only such weight and will be considered only to such extent as seems justified in view of the established procedure and the issue involved. The motion is denied.

Appeal from examiner of interferences: This case comes on for review, on appeal of the applicant, Yankee Dandy Products Company, of the decision of the examiner of trade mark interferences sustaining the opposition filed by the Yankee Polish Company, Inc., and adjudging the applicant not entitled to the registration for which it has applied.

The applicant seeks registration of a composite mark made up of an enlarged rectangular background on which appears a representation of the sun with heavy extending rays joined by numerous short lines running in concentric circles, this

being surrounded by a line of generally rectangular shape with rounded corners, above which in relatively large type is the word "Yankee" while in the center of the representation of the sun appear the letters "Y D" joined together in a monogram and in smaller type the notation "Y-D Products." Below the entire representation of the sun appear the words "For Duco Finish Varnish Enamel or Furniture Body Finish." The mark is used upon containers for liquid polish for furniture, automobile bodies, and the like.

Opposer does not set up registration of any trade mark including the word "Yankee" but alleges adoption and use of the word as a trade mark, continuously since about 1915, on shoe polish and polishing wax for floors, furniture, automobiles, and all articles made of leather. Both parties have taken testimony and it satisfactorily appears, and this conclusion is not seriously controverted by the opposer, that the applicant first adopted and used its mark about the middle of 1926 and has used it continuously since that time.

**Review of the Evidence.**

The opposer has presented a large number of exhibits including labels, a carton, and many tin boxes, and seeks to establish use of the word "Yankee" as a trade mark from a period long antedating the earliest date of adoption and use by the applicant. A careful review of the entire evidence submitted on behalf of the opposer and the rebuttal evidence presented by the applicant makes it difficult to determine in just what sense the opposer used this word "Yankee" upon its goods. In none of the tin boxes, save those put out in Germany, Exhibits Q and S, does the word "Yankee" appear as a name applied to the goods. There is no satisfactory proof that boxes of the type indicated in these two exhibits, Q and S, made in Germany, were ever sold in this country prior to the date the applicant entered the field. Exhibit F, a tin box with a label thereon upon which appear the words "Yankee Wax Polish," has not been overlooked. The use of the label in that manner, as well as the use of cartons shown in Exhibit A and Exhibit G, is not proved. There is almost no direct testimony about these exhibits, and what there is clearly fails to establish their adoption and use prior to June, 1926, when the applicant began the use of its mark. The tin boxes of the types disclosed in Exhibits B, C, D, E, and applicant's Exhibits 14, 15, 16, 17, 21, 22, etc., all show registered trade marks as indicated on the boxes, which marks do not include the word "Yankee" or any feature in common with the applicant's mark. Exhibit B discloses the Lion trade mark on the top and the Uncle Sam trade mark on the bottom of the can. The contents are noted on the cover as "London Polishing Paste." In exhibits like C and D and many others the "Uncle Sam" trade mark appears on the top and the bottom of the boxes and the contents are described as "Uncle Sam Shoe Polish" in the case of Exhibit C and "Uncle Sam Wax Polish" in the case of Exhibit D. Upon the sides of the bottoms of these boxes appears the notation "Yankee No. 4." In view of the presence of the opposer's trade mark or trade marks upon these goods it is doubtful if the use of the word "Yankee" on these boxes could be deemed trade mark use. It seems to be a word borrowed from the name of the opposer's corporation or company intended, clearly enough, to identify origin of the goods with the opposer company. The evidence submitted on behalf of opposer shows that it changed its corporate name in 1916 or 1919, opposer's record, page 30, Q. 3, at least long prior to the entrance of the applicant into the field, so as to eliminate the word "Shoe" and this would indicate the intent of the opposer to broaden its business to include polishes other than shoe polish. It must be held that opposer has not only failed to show trade mark use of the word "Yankee" upon automobile polishes prior to the applicant's use of its mark but has failed to show trade mark use of this word "Yankee" at all.

While the applicant in its answer has not made specific pleadings yet it has in general denied the allegations of the opposer that the latter is the owner of the trade mark "Yankee." In view of this general denial it is thought proper to consider the evidence submitted on behalf of the applicant as to prior registrations of this word "Yankee." These prior registrations can not be considered in this proceeding for the purpose of determining right of ownership of the trade mark here in issue in third parties but such registrations may be considered in connection with the question whether the opposer was the first to adopt and use this name or mark upon its goods.

Registration No. 41331, issued October 20, 1903 to Whittemore Bros. & Co., for 30 years under the then existing law, is for the word or mark "Yankee" ap-

plied to shoe black and shoe dressing or shoe polish. The applicant has shown by a folder, applicant's exhibit 19, that such name "Yankee" was still in use by Whittemore Brothers Company upon shoe polishes in June, 1927. This folder was shown the witness Abrahms who seems to have admitted its genuineness XQ. 90. There is also submitted registration No. 70240, issued August 18, 1908, to the Chicago Wood Finishing Co., which registration expired August 18, 1928, and was not renewed, of the trade mark "Yankee Cleaner" accompanied by a picture of the face and a portion of the hat of the mythical Uncle Same for use upon cleaning compound, which compound is described as both for cleaning and polishing various goods including metal goods both enameled and plated. These registrations and the folder indicate the opposer was not the first to apply the name "Yankee" as a trade mark to goods of the character here under consideration. It is apparent, however, that the opposer has for a long period used this mark "Yankee" upon its goods to indicate their origin, although possibly not as a technical trade mark with respect to which it possessed exclusive rights.

It would seem, in consequence, that the applicant should not be granted registration of a mark in which this word "Yankee" forms so prominent a part since the goods of both parties would very likely be called for by the name "Yankee." It is thought the case falls under the ruling in The Atlas Underwear Company v. B. V. D. Company, 261 O. G. 801, 48 App. D. C. 425, in which the court held that in order to sustain an opposition it is not necessary that the opposer establish trade mark use of the mark. The court stated that it was sufficient if the opposer has acquired a right to use the mark though not an exclusive one prior to the applicant's adoption of the mark. It would appear the opposer's long and prominent use on its goods of this word "Yankee" justifies the conclusion that it would be damaged in its business if the applicant obtained the registration for which it has applied.

**Probable Confusion.**

In reaching the above conclusion the difference between the shoe polish, upon which it has been established the opposer used the word "Yankee" from a date long prior to the applicant's entrance into the field, and the furniture and automobile polish upon which the applicant uses its mark, has been considered. Notwithstanding the holding that the opposer has failed to establish use of the notation "Yankee" on polishes other than for shoes prior to the applicant's entrance into the field, it is believed these polishes all belong to the same class and possess substantially the same descriptive properties. Many polishes are also described as cleansers so that the terms "cleaner" and "polisher" may be said to indicate to the average purchaser very much the same article. Manufacturers and dealers in shoe polishes frequently handle other kinds of polishes and it is deemed confusion would result if the same trade mark or trade name appeared upon both kinds of polishes in the same market.

The decision of the examiner sustaining the opposition and adjudging the applicant not entitled to the registration applied for is affirmed.

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MAY 6

# *Trade Mark Use Not Involved In Sending Unsolicited Samples*

THE RUBBER SERVICE LABORATORIES CO. v. AMERICAN CYANAMID COMPANY. OPPOSITION NO. 8791, ASSISTANT COMMISSIONER OF PATENTS.

THE word "Retardox," used on materials comprising aldehyde-amine condensation products, was held registrable over opposer's notation "Resistox" for materials having the same descriptive properties, the decision of the examiner of interferences being reversed.

The Assistant Commissioner concluded that while the marks so nearly resemble each other as to be confusingly similar, yet the opposer did not establish prior use of his mark. It was stipulated between the parties that the applicant had used its mark since December 15, 1927, placing the burden upon the opposer of proving beyond a reasonable doubt that it had used its mark prior to that date. This, it was

found, the opposer failed to do in that it did not show that goods bearing its trade mark and had actually been marketed prior to that date. The decision stated that the mere sending out of unsolicited samples of a commodity with the mark affixed does not constitute trade mark use.

**Grounds of Opposition.**

Robert L. Sibley for The Rubber Service Laboratories Co.; H. G. Bierman for American Cyanamid Company.

The full text of the opinion of Assistant Commissioner Moore follows:

The applicant, American Cyanamid Company, appeals from the decision of the examiner of interferences sustaining the opposition of The Rubber Service Laboratories Co. to the registration by the applicant of its trade mark consisting of the word "Retardox" for materials comprising aldehyde-amine condensation products.

The opposition is based upon alleged prior adoption and use by the opposer of the trade mark consisting of the word "Resistox" for materials having the same descriptive properties, the opposer contending that the two marks so nearly resemble each other as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

It appears to be agreed that the primary questions presented for decision are:

(1) Whether the two marks so nearly resemble each other as to be likely to cause confusion or mistake when concurrently appropriated by the respective parties to the goods in question; and

(2) Priority as between the parties of trade mark use of their respective trade marks.

(1) A comparison of the two marks shows that their resemblance is such as would be likely to confuse and mislead the public as to the origin or ownership of the goods to which they are appropriated.

Each of the marks consists of a three-syllable word having the same number of letters, of which the first two and the last two are the same, and the two marks suggest the same thought. While the slight difference in spelling and in sound of the two words are observable on comparison, yet it is believed that they are not such as would be carried in the memory of the average purchaser. But if the differences were observed and remembered, they would most likely be regarded as variants of the same mark.

(2) As to priority of trade mark use of the two marks, the following stipulation has been filed of record:

"It is hereby stipulated by and between counsel for the parties to the above-entitled cause that the American Cyanamid Company is the owner of the trade mark 'Retardox' for antioxidants and has used the same in commerce among the several States of the United States as early as December 15, 1927."

The opposer seeks to avoid the force of this stipulation by contending that while "the application papers allege that applicant's mark 'Retardox' is employed on merchandise comprising aldehyde-amine condensation products, yet the stipulation fails to mention use of the marks on such products and does not necessarily relate to such products."

**Binding Force Upon Opposer.**

The stipulation, however, refers "to the above-entitled cause," which cause is this opposition proceeding brought by the opposer against the registration by the applicant of its trade mark "Retardox" for antioxidants comprising aldehyde-amine condensation products. The antioxidants referred to in the stipulation, therefore, must be held as comprising aldehyde-amine condensation products.

This stipulation made it unnecessary for the applicant to take testimony, and it has a binding force upon the opposer. In view thereof, in order that the opposer may prevail in this proceeding, it must establish beyond any reasonable doubt trade mark use of its mark "Resistox" prior to December 15, 1927.

The opposer alleges in its notice of opposition that prior to December 15, 1927, it had employed the word "Resistox" as a trade mark designation of materials comprising aldehyde-amine condensation products, and it has attempted to establish this alleged fact by testimony and exhibits.

In support of this proposition the opposer relies primarily upon three house orders, each calling for the shipment of a ½-pound sample of "Resistox," said orders being identified, respectively, as House Orders 7698, 7699, and 7705. Opposer's Exhibit No. 3 indicates that these orders were dated December 6, 1927, and the samples shipped December 12, 1927, to F. P. Jecusco, Chatham Rubber Company, Middletown, Conn.; L. J. D. Healy, Fisk Rubber Company, Cudahy, Wis., and F. K. Houck, Racine Horseshoe Tire Co., Racine, Wis., respectively.

The record does not show that these samples were ever ordered, or were ever received, or were ever paid for by the

consignees. The evidence certainly does not show that any one of these samples was received prior to December 15, 1927, the date accorded to the applicant by stipulation for adoption and use of its mark.

In view of the above facts, as I view the case, the vital and controlling question presented for decision is whether the mere shipment of the samples marked "Resistox" by the opposer on December 12, 1927, in the absence of solicited orders by the consignees, constituted a trade mark use of said mark.

A trade mark is necessarily a mark used in trade. In the case In re Gregg & Son, Inc. (373 O. G. 759), the Court of Appeals of the District of Columbia quoted with approval the following from Sec. 214 of Nims on Unfair Competition and Trade Marks (2d ed.):

"The trader must do three things in order to acquire a good title to a technical trade mark: First, he must adopt a trade mark open to appropriation; second, he must apply it or attach it physically to a vendable commodity; and, third, he must actually put the commodity so marked on the market. Schneider v. Williams, 44 N. J. Ed. 391."

That the opposer met the first and second of the above requirements prior to December 15, 1927, has been established with reasonable certainty. Whether he had met the third requirement, as above indicated, depends upon whether the sending out of the three unsolicited samples with the word "Resistox" marked thereon constituted the act of actually putting "the commodity so marked on the market."

**Sending of Unsolicited Samples.**

That the mere sending out of unsolicited samples of a commodity with the mark affixed does not constitute trade mark use of the mark appears to be the law as it has been interpreted by the authorities. For example, in Phillips v. Hudnut & Mack (273 O. G. 629; 49 App. D. C. 247; 263 Fed. Rep. 643; 1920 C. D. 164), it was held by the Court of Appeals of the District of Columbia that the making of some sample boxes of toilet powder, placing upon them the mark involved and forwarding them from New York through the house for which the interferant was then working to three dealers in goods of that character, one in Texas, one in Philadelphia, and one in New Orleans, the consignees paying 5 cents for each box, the usual sale price for such an article being about 50 cents, was not a bona fide business transaction; that the trade mark recognized by the common law is generally the outgrowth of a considerable period of use rather than a sudden invention; that the exclusive right to it grows out of its use and not its mere adoption.

From the evidence it appears that the first trade mark use made by the opposer of its trade mark was February 14, 1928, which was long after the date accorded to the applicant and a month and one-half after the applicant filed its application for registration.

The decision of the examiner of interferences sustaining the opposition and adjudging that the applicant is not entitled to the registration for which it has made application is reversed.

April 29, 1929.

# *Green vs. Blue for Utensils*

A. & J. MANUFACTURING COMPANY V. R. WALLACE & SONS MANUFACTURING COMPANY. OPPOSITION NO. 8333, FIRST ASSISTANT COMMISSIONER OF PATENTS.

THE applicant was held to be entitled to registration for its trade mark consisting of a green color applied to the tips of the free ends of kitchen and household tools or utensils over opposer's mark consisting of a blue color used on the tips of the free ends of the same class of goods, it being stated that the opposer can not extend its proprietary rights to include any other primary color used at the same place upon the same class of goods but must be content with the particular color it has adopted.

The various court decisions considered, some holding that mere color is not registrable as a trade mark, another stating that the claim of monopoly or right in making the edge of belting of any color is too broad, and other opinions to the same effect, were deemed conclusive that the opposer was not entitled to exclude others from using colors other than blue on utensil handles.

Philip S. Hopkins for A. & J. Manufacturing Company; Seymour, Earle & Nichols for R. Wallace & Sons Mfg. Co.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

This case comes on for review, on appeal of the applicant, R. Wallace & Sons Manufacturing Company, of the decision of the examiner of trade mark interferences sustaining the opposition filed by A. & J. Manufacturing Company and adjudging the applicant not entitled to the registration for which it has applied

The applicant seeks registration of a trade mark consisting of a green color on the tips of the free ends of kitchen and household tools or utensils. The opposer alleges ownership of a mark of the same class of goods, and pleads ownership of registration No. 204467, issued August, 1925, for such mark upon the above noted goods.

Both parties have taken testimony and it satisfactorily appears that the opposer was prior in the field in the use of its mark upon its goods and that it has expended large sums in advertising, has sold enormous numbers of its articles bearing its trade mark and is, in consequence, in possession of a presumably very valuable good will as an asset to its business. Under these circumstances if there is doubt it must be resolved against the newcomer in accordance with the established rule.

The goods being substantially identical the case hinges upon whether the marks are so familiar as to render confusion in trade probable. There is evidence submitted on behalf of the opposer of some small actual confusion. There is evidence that the applicant was well aware of opposer's mark when the former adopted its green tip upon its goods.

The examiner sustained the opposition largely upon the holding of the Court of Appeals in the case In re Eagle Pencil Company, 185 O. G. 1383, 39 App. D. C. 361, and the previously adjudicated case cited in that decision, Leschenn & Sons Rope Co. v. Broderick & Bascom Co., 164 O. G. 977, 36 App. D. C. 451. These cases considered alone would seem to be persuasive of the correctness of the examiner's holding but it is thought other adjudicated cases, some of which were before the Court of Appeals, D. C., should be reviewed.

In the case of Turner & Seymour Mfg. Co. v. A. & J. Mfg. Co. et al., 20 F. (2d) 298 (II U. S. Daily, 1584), the Circuit Court of Appeals, Second Circuit, in reversing the lower court and holding there was no infringement of the mark "Blue Whirl" by the opposer's "Blue Tip" used upon the same class of utensils stated:

"Mere color cannot be appropriated, as plaintiff attempts to do, and has succeeded in doing below."

The Court further noted that the word "blue" used by both plaintiff and defendants was common property and commonly used by manufacturers of kitchen utensils, and then quoted with approval a prior holding by another Court that:

"It is a well-settled general rule of law that a trader may not monopolize a particular color, and that color alone, unaccompanied by any distinguishing sign, seal, or symbol, is not sufficient to constitute a trade mark."

**Same Descriptive Properties.**

In the case of California Packing Corporation v. Halferty, 320 O. G. 700, 54 App. D. C. 88, the Court held the mark "White Band," accompanied by a band of white extending from one end to the other of the label, not deceptively similar to the words "Gold Bar" with a representation of such a bar on a distinguishing background, or to the words "Silver Bar," likewise used in conjunction with a silver band upon a distinguishing background, but in that case the goods were not identical, although the court held that they belonged to the same class and had the same descriptive properties.

In the case of Plough Chemical Company v. Isadore Bullion, 336 O. G. 256, 55 App. D. C. 294, the Court held the trade mark "Black and White" not deceptively similar to the mark "Red and White" when used upon the same goods. The Court found that the respective terms "suggest contrast rather than identity."

In the A. Leschen & Sons Rope Co. v. Fuller et al., 218 F. 786, Circuit Court of Appeals, Eighth Circuit, it was held that the Leschen Company sought to monopolize the use not of one, but of all colors to make its rope, and the Court noted that if the mark disclosed "is a valid trade mark, it is so because, and only because, it is limited to a red stripe or strand, and that limitation permits the use by others of wire ropes with strands of other colors, and the defendants do not infringe that trade mark because they use a yellow strand."

In the case of Dodge Mfg. Co. v. Sewall & Day Cordage Co., 142 F. 288, Circuit Court, D. Massachusetts, it was held that there was no conflict between a blue thread twisted into rope and a red thread likewise employed as a mark for the same goods.

In another case, Gandy Belting Co. of Baltimore City v. Victor-Balata & Tex-

tile Belting Co., 215 F. 795, District Court, E. D. Pennsylvania, the court noted that "the plaintiff claimed proprietary right to a green color applied to one edge of the belting while the defendant colored both edges a brilliant black, and stated:

"A claim of monopoly of right, either at common law or under the trade mark statutes, in the privilege or practice of making the edges of the belting of any color is certainly too broad."

To the same effect are the holdings in Diamond Match Co. v. Sagninaw Match Co., 142 F. 727, Circuit Court of Appeals, Sixth Circuit: In re American Circular Loom Company, 126 O. G. 2191, 28 App. D. C. 446; In re Waterman, 152 O. G. 232, 34 App. D. C. 185; Samson Cordage Works v. Puritan Cordage Mills, 211 F. 603, Circuit Court of Appeals, Sixth Circuit; Taylor v. Bostick, 299 F. 232, Circuit Court of Appeals, Third Circuit; In re Johns-Manville, Incorporated, 231 O. G. 488, 55 App. D. C., 142; In re Gotham Silk Hosiery Co., Inc., 366 O. G. 4.

The foregoing cases are deemed conclusive that the opposer is not entitled to bar others from coloring kitchen utensils handles with colors other than blue. It would seem the doctrine is fairly established that having adopted a particular color as a trade mark and used it on a particular portion of a kitchen utensil the opposer cannot extend its proprietary rights to include any other primary color used at the same place upon the same class of goods, but must be content with the particular color it has adopted.

The opposer, however, urges two reasons why its opposition should be sustained. The first is that the colors blue and green are more nearly alike and more liable to be confused than the pairs of colors involved in the adjudicated cases, and the second is that the particular location of the color on the free ends of the handles should be held to distinguish the case at bar from those previously recited.

**Dismissal of Opposition.**

As to the first reason, it may well be that blue and green seen under artificial light would be more readily confused than would blue and red, or red and yellow, or green and black, but all these save black belong in the group of what are known as the primary colors and are familiar to all persons not afflicted in some degree with color blindness.

Regarding the second point the location of the colors seems not to be more distinctive than it was in many of the decided cases, more particularly in the Gotham Silk Hosiery case where the ridge in the stocking was at a particular point; in the Johns-Manville case where a colored band was placed just within the ends of the pipe sections; in the Samson Cordage Works case where the colored thread was made to form a series of lozenge-shaped dots, spirally about the cord.

The decision of the examiner of trade mark interferences is reversed, the opposition is dismissed, and it is adjudged the applicant is entitled to the registration for which it has applied.

April 29, 1929.

## MAY 8

# *Similar Marks for Motor Oils*

SINCLAIR REFINING COMPANY v. ROBERT HICKMAN BLACKBURN. APPLICATION FOR CANCELLATION NO. 1766, FIRST ASSISTANT COMMISSIONER OF PATENTS.

THE decision of the examiner of Interferences sustaining the petition for cancellation of registrant's mark comprising a diamond-shaped outline within which appears the letter "B" and below all of which appears the notation "'Diamond B' Motor Oils," was affirmed upon a finding that the petitioner was long prior in the use of the trade mark "Diamond C" for motor oils, and that the marks were similar in appearance and sound, the usual rule as to resolving the doubt against the newcomer being applied.

Edward S. Rogers, Allen M. Reed, William T. Woodson, and Francis L. Browne and Dudley Browne for Sinclair Refining Company; M. S. Meem for Robert Hickman Blackburn.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

This case comes on for review, on appeal of the registrant, Robert Hickman Blackburn, of the decision of the examiner of trade-mark interferences sustaining the petition for cancellation filed by the Sinclair Refining Company

and recommending that the registration of the appellant be cancelled.

The registrant obtained his resignation March 30, 1928, No. 240100, on an application filed November 19, 1927, for a mark comprising a diamond outline within which appears the letter "B" below all of which appears the notation "'Diamond B' Motor Oils," used on lubricating oils and greases.

The petitioner claims use of the trade mark "Diamond C" continuously since January, 1917, upon goods of same class and sets up its registration No. 146872, issued September 20, 1921, for such mark as applied to lubricating oils.

The petitioner has taken testimony but the registrant has not. It satisfactorily appears from the testimony submitted on behalf of the petitioner that petitioner has been using its mark "Diamond C" on lubricating oils continuously since at least as early as 1919 and probably since 1917, and has sold its goods under its mark in very large quantities, reaching as high as half a million gallons annually. It is also in evidence that the registrant was at one time a distributor of the petitioner's goods (Lockridge's testimony, q. 10). It is deemed a fair presumption that the registrant was, when he adopted his mark, entirely familiar with the petitioner's mark and goods. Under these conditions if there is doubt it must be resolved against the newcomer in accordance with the usual rule.

The registrant has pressed the view that a diamond or a diamond shape is an exceedingly common part of trade marks which have been registered and used upon many classes of goods, including those here involved, from a date long prior to the entrance of the petitioner into the field with its mark. Upon this basis it is urged by the registrant that the distinction between the two letters of the alphabet, as such letters are used in the respective marks, is sufficient to establish that it is unlikely there will be confusion in trade.

The registrant also invites attention to what may be deemed well enough established, that a representation of a diamond is under many conditions the equivalent of the word diamond and conveys the same meaning to a customer.

**Confusion in Letters.**

While the main contentions of the registrant may be accepted as correct yet the trade marks must be considered as a whole and when this is done it is thought their similarities outweigh their differences. There are some letters of the alphabet, such as B, C, D, E, P, T, etc., which are recognized as sounding alike. Confusion in using such letters in connection with messages over the telephone is a matter of common knowledge.

It is thought there would be confusion even in customers orally calling for the particular goods if both parties to this proceeding were using their respective marks in the same market upon the same class of goods. It is held the registrant has approached too near the petitioner's trade mark.

The decision of the examiner of trademark interferences sustaining the petition is affirmed, and the registration of the applicant will, if this holding is not modified or reversed on appeal, be cancelled.

April 29, 1929.

## MAY 9

# *Notations for Free Publications*

EX PARTE THE OSKAMP NOLTING CO. FIRST ASSISTANT COMMISSIONER OF PATENTS.

A MARK, comprising the notation "Great American" with the representation beneath it of an Indian carrying bow and arrows, used upon a jewelry catalog, delivered without charge to prospective customers of the goods advertised, was held registerable, the decision of the examiner being reversed.

The First Assistant Commissioner distinguished this case, wherein a catalog of considerable size containing many illustrations, some highly colored and ornamental, of goods which applicant sells, is adapted to be of great intrinsic value to dealers in reselling the goods, from those cases where goods are described in sporadic, gratuitously distributed catalogues, which are not sent out periodically nor to customers on established mailing lists.

Decisions were noted holding that billheads, letter-heads, cards and circulars could not be considered as goods, and therefore not subject to trade mark use. Wood & Wood for applicant.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

The applicant has appealed from the decision of the examiner denying registration of a mark comprising the words "Great American" and beneath them a representation of an Indian carrying a bow and arrows, used upon jewelry catalogs issued periodically and sent or delivered without charge to previous and also prospective purchasers of the goods advertised in the catalog

The book is of considerable size, being about a foot long, some nine inches wide, and approximately an inch and a half thick It contains nearly 700 pages, profusely illustrated, including many illustrations in colors of the goods sold by the applicant.

The goods represented in the catalog are generally those manufactured by others and distributed or sold through the applicant company. It is apparent the book is of considerable value and represents, for its production, a considerable outlay per volume.

It is stated to be issued annually with such corrections and changes as are found necessary to keep it up to date. As above noted it is not directly sold. That it would be distributed to a carefully selected group of customers, past or prospective, is quite evident.

It must be deemed clear that the cost of the publication would be reckoned in the overhead expenditures of marketing the goods and the profit obtained from such goods would have to be sufficient to take care of the cost of the publication. Under these conditions the question arises as to whether books, thus periodically issued and distributed, are goods used in commerce within the meaning of the trade mark law.

The adjudicated cases relied upon by the examiner are not deemed wholly determinative of the question here presented. In the case of the Commercial Liquidation Company, 129 Ms. D. 89, 9 T. M. Rep. 325, the then Commissioner held upon somewhat similar circumstances that the applicant had not shown trade mark use.

Reference was made by the examiner in that case, whose decision the Assistant Commissioner affirmed, to the holding in the case of Battle Creek Sanitarium Compay, Limited, v. Fuller, 134 O. G. 1299, 30 App. D. C. 411. That case, however, is not deemed directly in point.

The mark was not sought for a publication or catalog but for goods described under the alleged trade mark in the catalog or publication, and the court found this not to consist of a trade mark use since the mark had not been used upon the goods.

In the case of Ex parte Associated Mortgage Investors, Inc., 295 O. G. 227, the mark was used on advertising matter which offered mortgages for sale, and the applicant sought registration of the trade mark for the mortgages on which, even if they were merchandise within the meaning of the trade mark law, the mark had not been used.

This holding, as well as that in Hartshorn v. Philbrick, 101 O. G. 2077, accords with that in the Battle Creek Sanitarium Company case, in that the mark sought to be registered was not used upon the goods at all but was only used in advertisements of such goods. There would seem to be no analogy between these cases and the case at bar.

In the case of Ex parte Roy and Nourse, 54 O. G. 1267, the Acting Commissioner held that a mark which was fixed to bill-heads, letter-heads, cards, and circulars which the applicants used themselves in their business was not such a use as entitled the applicants to registration. Bill-heads, letter-heads, cards, and circulars bearing the applicants names or the name of their firm could not well be considered goods, wares, or merchandise, because no one would wish to purchase such articles and their use would be limited to those whose names appeared upon them.

This holding is somewhat in line with that in the case of Western Union Telegraph Company, 146 Ms. D. 321, 15 T. M. Rep. 139, in which the notation "Western Union Telegraph" was denied registration as a trade mark when used on stationery on which messages are written, notwithstanding such stationery was distributed among merchants and others who were expected to frequently use it in connection with telegraph messages.

To the same effect is the holding in the case of Ex parte The Third National Bank of St. Louis, Missouri, 260 O. G. 562, where trade mark registration for the business name of the applicant was denied registration as applied to letterheads, writing paper, etc.

Referring to those decisions that more nearly support the contentions of the appellant here, it is noted that in the case of Ex parte The Curtis Publishing Company, 197 O. G. 1000, the Commissioner held that the words, "The Swastika," were a proper trade mark for a publication issued periodically and distributed free for advertising purposes.

In that case the Commissioner noted

that it was doubtful "whether a magazine periodically issued, containing only advertisments and given away free, should be distinguished under the trade mark statute from the ordinary magazine." In that case he held that, "even though the magazine is distributed freely, the publishers undoubtedly expect in some way to get a return."

The holding in the Maryland Assurance Corporation v. Van Sant, 326 O. G. 469, is likewise to the effect that a magazine published periodically and distributed without cost, and which is merely a house organ or advertising medium comes within the meaning of the words "goods" and "merchandise," as such terms are used in the trade mark statutes.

The applicant's catalog, being a volume of considerable size and containing a very great number of illustrations, some of them highly colored and ornamental, of the goods which the applicant sells, constitutes a book, a catalog or a volume of considerable intrinsic value to those engaged in the purchase and resales of the applicant's goods. The volume is stated to be published periodically and the trade mark applied to it is so far fanciful as to fall within the accepted definition of a trade mark.

**Indirect Reimbursement.**

The only bar raised against the registration, therefore, is that the catalog or book is not directly sold. As above indicated, it is believed proper to hold that purchasers of applicant's goods do pay for the publication indirectly and that the trade mark law is satisfied.

In reaching this conclusion the holding in the case In re Gregg & Son, Inc., 373 O. G. 759, and the decision in Schneider v. Williams, 44 N. J. Eq. 391, quoted with approval therein has not been overlooked.

As was emphasized in the Maryland Assurance Corporation case, the instant case is to be sharply distinguished from those cases where goods are described in sporadic, gratuitously distributed catalogs which are not issued periodically for established mailing lists, and from allegations of trade mark use on such sporadically issued and gratuitously distributed catalogs and advertisements.

The decision of the examiner is reversed. May 2, 1929.

## MAY 13

# *Use of "Tex" as Trade Notation*

THE CELOTEX COMPANY V. BEN HUR WILSON. OPPOSITION NO. 8716, FIRST ASSISTANT COMMISSIONER OF PATENTS.

THE applicant is allowed registration of the notation "Waltex" placed within a diamond-shaped figure, as a trade mark for composition insulating wall boards, upon a finding that the notation is dissimilar in appearance, sound, spelling and significance from opposer's trade mark "Celotex," used upon goods of the same descriptive properties.

In the opinion it is stated that the first portion of a trade mark is apt to impress the memory more than the latter part, that the first portions of these two marks are quite different, and that the latter portion, "Tex," had been quite generally used in trade mark registration long prior to the time the opposer entered the field.

**Claim of Prior Adoption.**

William E. Seaver and Henry G. Hunt for The Celotex Company; Bair, Freeman and Sinclair for Ben Hur Wilson.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

This case comes on for review, on appeal of the opposer, The Celotex Company, of the decision of the examiner of trade mark interferences dismissing the opposition and adjudging the applicant, Ben Hur Wilson, assignor to Des Moines Saw Mill Company, Inc., entitled to the registration for which application has been made.

The applicant seeks registration of the notation "Waltex" placed within a diamond-shaped figure or outline, used upon composition insulating wall boards, Class 12, Construction Materials.

The opposer claims prior adoption and use of the trade mark "Celotex" upon the same class of goods, namely wall boards, and sets up ownership of trade mark registration of its mark "Celotex," issued July 29, 1924, the corrected registration number of which is 187332.

The opposer has taken testimony but the applicant has taken none, has filed no brief, and was not represented at the hearing. The evidence submitted on behalf of opposer fairly establishes that it adopted and used its mark upon its goods as early as 1921 and has continuously used it since that time. It satisfactorily appears that very large

sums have been expended in advertising its goods under its trade mark, such sums increasing from $114,000 in 1923 to over $1,000,000 in 1927 and that the business has likewise increased until there were sold in 1927 nearly 300,000,000 square feet of the opposer's wall board under its trade mark.

The applicant is not entitled to any date of adoption and use of his trade mark prior to the date "November 21, 1927," on which he filed his application for registration. Under these circumstances it is very clear that the applicant should be denied registration if there is any doubt of confusion. In the case of Lambert Pharmacal Company v. Mentho-Listine Chemical Company, 247 O. G. 965, 47 App. D. C. 197, the court quoted with approval the statement made by the District Court, S. D. N. Y., in the case of Lambert Pharmacal Co. v. Bolton Chemical Corp., 219 F. R. 325, that:

"Of course, the burden of proof always rests upon the moving party, but having shown the adoption of a similar trade name, arbitrary in character, I cannot see why speculation as to the chance that it will cause confusion should be at the expense of the man first in the field. He has a right to insist that others in making up their arbitrary names should so certainly keep away from his customers as to raise no question."

The only similarity in the two marks resides in the last syllable, Tex. The other portions of the marks are wholly dissimilar in appearance, sound, spelling and significance. While there is some evidence of the heresay type that the applicant's wall boards were made from walnut sawdust, and possibly the first syllable of the applicant's mark was borrowed from the word walnut, yet it is probable, in view of the commonly accepted name given the goods by those familiar with goods of this character, wall board, the public would be apt to think the first syllable of the applicant's mark was borrowed from the name of the goods.

**Improbability of Confusion.**

However this may be, the mark seems merely suggestive, if it would have any meaning at all to the purchasing public. The opposer's mark comprises three syllables rather than two as in the applicant's mark, and the first two syllables would impress the average observer or customer more than would the final syllable. It is believed quite improbable that anyone exercising any judgment at all would ever confuse the two notations. The first portion of a trade mark is apt to impress the memory more than the latter portion, even where the two parts are equally prominent and significant.

In the instant case the most prominent and significant portion of the opposer's mark, as well as the larger portion of such mark in point of number of letters or syllables, is wholly dissimilar to any part of the applicant's mark. If confusion could arise it would not be as to the marks but would arise by reason of some person familiar with the opposer's mark and its goods, supposing, on seeing the applicant's mark on his goods, that the opposer was putting out a new line or grade of wall board. The chance of confusion of origin in this way is deemed too remote to have weight here.

The opposer has noted that, so far as the record shows, it is the first to use the mark including the letters Tex in connection with these goods. It appears, however, that there have been a good many trade marks registered very long before the opposer entered the field of marks including these letters and used upon quite similar goods although not the identical goods. The following registrations are noted:

National Fire Proofing Co., No. 86,-436, registered May 7, 1912, for Tex, used upon structural blocks, bricks and tiles.

The Texas Company, No. 100446, registered October 20, 1914, for Texaco, used upon composition felt roofing.

Barrett Manufacturing Co., No. 105-334, registered July 20, 1915, for Vitex, used upon prepared roofing.

Trussed Concrete Steel Company, No. 105472, registered July 27, 1915, for Stone Tex, used upon waterproofings, damp-proofings, and technical paints.

Sunderland Brothers Company, No. 108577, registered February 15, 1916, for Tex-Tile, used upon asphalt shingle.

The Stevens Paper Mills, Inc., No. 17754, registered January 1, 1924, for Fibre-Tex, used upon light-weight fibre board.

F. Graham Williams Brick Co., Inc., No. 179486, registered February 12, 1924, for Art-Tex, used upon bricks.

Pioneer Paper Company, No. 194211, registered January 20, 1925, for Flaxa-Tex, used upon asphalt saturated and coated reinforcing felt for built-up roofing; waterproofing and damp-proofing used in connection with building construction.

The Paraffine Companies, Inc., No. 201-700, registered August 4, 1925, for Flo

tex, used upon prepared roofing saturated and coated with an elastic waterproof compound and for a base sheet to be applied under composition roofing.

Concrete Surface Corp., No. 209200, registered February 16, 1926, for Bond-Tex, used upon material for treating horizontal concreate surfaces to expose aggregate therein for bonding purposes.

Latex Products, Inc., No. 201757, registered August 4, 1925, for Rulatex, used upon flooring composed of rubber latex reenforced principally with asbestos fiber applied in a plastic state to form a seamless rubber surface.

In view of the widely extended use of these three letters Tex, in connection with trade marks for building materials of various and somewhat analogous kinds, it is believed the opposer is not entitled to protection of its trade mark so broad as to bar others from using any mark however dissimilar upon wall board, which mark includes these letters Tex.

In view of these registered trade marks being made of record in this case without prior notice to the opposer, the latter is, upon filing a request therefor within the period of appeal to the court, entitled to a reconsideration of the matters here decided so far as they are affected by this citation of these registrations.

The decision of the examiner of trade mark interferences dismissing the opposition and adjudging the applicant entitled to his registration is affirmed.

May 3, 1929.

## MAY 17

# *Issue Between 'Craftex' and 'Plastex'*

CRAFTEX COMPANY V. PLASTEX COMPANY OF AMERICA, INC. OPPOSITION NO. 8589, ASSISTANT COMMISSIONER OF PATENTS.

THE opposition to the registration of the notation "Plastex" as a trade mark for a composition of animal and mineral substances used for interior finishes was dismissed upon a finding that opposer's trade mark "Craftex" did not resemble applicant's notation either in appearance, sound or suggestion.

In the opinion it is noted that no evidence as to confusion was introduced, although both trade marks had been in common use for upwards of two years.

Elis Spear, Jr., for Craftex Company; Carrol Blakely Low for Plastex Company of America, Inc.

### Appeal Filed By Opposer.

The full text of the opinion of Assistant Commissioner Moore follows:

The opposer, Craftex Company, appeals from the decision of the Acting Examiner of Interferences dismissing its opposition to the registration by the applicant, Plastex Company of America, Inc., of its trade mark consisting of the word "Plastex" for a composition of animal and mineral substances, used for ceiling, wall and other interior coverings and finishes.

The ground for opposition is that the opposer through its predecessor has for many years and long prior to August 10, 1927 [Sept. 27, 1926], the date claimed by the applicant for adoption and use of its trade mark, used the word "Craftex" as a trade mark for goods of a like character, for which it has secured trade mark registrations No. 149815, November 21, 1921, and No. 233047, September 20, 1927; that the mark "Plastex" so nearly resembles the mark "Craftex" in appearance, sound, spelling and meaning as to cause confusion or mistake in the mind of the public and to deceive purchasers; and that the use by the applicant of its mark on goods of the same descriptive properties will result in irreparable loss to opposer.

### Specific Grounds of Appeal.

The specific grounds upon which this appeal is taken are:

1. The Examiner of Interferences erred in holding that the words "Plastex" and "Craftex" do not possess the same appearance.

2. The Examiner of Interferences erred in holding that the words "Plastex" and "Craftex" do not sound alike when pronounced.

3. The Examiner of Interferences erred in holding that the points of difference between the two marks outweigh the points of similarity.

4. That the Examiner of Interferences erred in holding that confusion would not be likely to result from the concurrent use in the trade by different parties of the trade marks "Plastex" and "Craf-

tex" upon goods of the same descriptive properties.

It appears to be agreed that the primary question presented for decision is whether the two marks are confusingly similar to each other.

The applicant in its brief points out that it is common practice to use the suggestive prefix "Plas," also the suggestive suffix "tex," in forming trade marks used for construction materials (Class 12); that no one is entitled to the exclusive use of the suffix "tex" in forming trade marks for this class of goods; and contends that it is only when these syllables are combined with each other that a suggestive and unique trade mark is formed.

In comparing the two marks "Craftex" and "Plastex" with each other it is found that they both use the common suffix "tex" and the letter "a," but resemble each other in no other respect. Certainly there is no resemblance between "Plas" and "Craf," either in appearance, sound or suggestion. The applicant points out that "Plastex" "suggests at once a plastic substance capable of being textured. "Craftex," on the other hand, might suggest a substance capable of being applied by, or possessing the appearance of having been applied by, one having the ingenuity, skill or dexterity of a craftsman. But whatever else the opposer's mark may suggest it is evident that it does not convey the same thought as the applicant's mark.

Furthermore, in view of the many prior trade marks, for goods of this class, which include the suffix "tex" the opposer's mark may be said to be so truly arbitrary, strange and fanciful as to entitle the opposer to a monopoly of use such as to exclude the use of the applicant's mark on the same class of goods.

## MAY 18

# *Mark Deceptive Description of Goods*

PONEMAH MILLS AND AMERICAN BLEACHED GOODS COMPANY, INC., COMPLAINANTS, v. UNIVERSAL CREPE & TISSUE MILLS, INC. IN EQUITY 38363, DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK.

THE court holds in this case that the owner of the previously adopted trade mark "Soiesette" as applied to cotton fabrics has no cause of action against the use of "Soisette" as applied to toilet paper, although the plaintiffs are damaged by the use of their trade mark in connection with toilet paper.

The complaint as to unfair competition was not sustained owing to the fact that there was no similarity in labels, packages, advertisements, etc., although both parties included phonetic spelling of the word.

Regarding the question of confusion, the court concluded that there was no possibility of the goods being mistaken, one for the other, since the two products are in different classes, there is no association of the two products in selling of them, and the advertisements for the two products would not be placed in the same periodicals.

Kenyon & Kenyon, solicitors for plaintiffs; McDonnell & Lebett, attorneys for defendant.

The full text of the opinion of the court, delivered by Judge Coleman, follows:

The crux of this controversy is whether the use of the trade mark "Soisette" as applied to toilet paper injures the owner of the previously adopted trade mark "Soiesette" as applied to cotton fabrics. The two words are so similar that defendant concedes a substantial indentity, and for the purposes of this decision they will be considered as though exactly the same.

Plaintiff Ponemah Mills is a Connecticut corporation and the manufacturer of the cotton goods in question. Plaintiff American Bleached Goods Company, Inc., is a New Jersey corporation and the exclusive selling and distributing agent for those goods. The defendant Universal Crepe & Tissue Mills, Inc., is a New York corporation and is the manufacturer and seller of toilet paper.

### Adopted in 1902.

The word "Soiesette" was adopted as the trade mark for that particular kind of cotton fabric in 1902, and was registered in the Patent Office in 1904. It has been used continuously and has been quite considerably advertised. The sales of the goods to which that trade mark is attached average over $2,000,000 annually, and the word has become so closely as-

sociated with the particular type of fabric that the latter is frequently ordered by name both on the part of the general public and of the people in the trade.

Defendant first commenced to use the word "Soisette" in connection with a new line of toilet paper in 1926. At that time defendant was well aware of plaintiff's long prior use of their trade mark, but nevertheless deliberately and under advice of counsel adopted it. Thereafter in February, 1926, defendant filed an application of its trade mark in connection with toilet paper, and after an opposition proceeding on the part of the plaintiff Ponemah Mills, the Commissioner of Patents finally allowed the registration, though an appeal is still pending in the Court of Appeals for the District of Columbia.

Defendant has widely advertised its toilet paper under that name, and the latter is now rather well associated in the public mind with defendant's product. The plaintiff protested against the use as early as August, 1926, and there is no question of laches barring such rights as it might otherwise have.

This action is brought on two theories, infringement of technical trade-mark rights, and unfair competition. There is no ground for complaint against any act of defendant except the use of the word "Soisette" in connection with its product. There is no similarity in labels, packages, advertisement, etc., though both plaintiffs and defendant in their circulars include the phonetic spelling of the word. (In plaintiffs' it is given as "Swah-zet," and in the defendant's as "Swazet.") Both products are high grade in their respective classes and have good reputations.

### In Different Classes.

The two products are in such entirely different classes that there is not the slightest possibility of one ever being mistaken for the other, nor is there any competition between them. That fact of course does not in itself defeat plaintiff's claim. If there is any real danger of defendant's toilet paper being considered another product put out by the plaintiffs because of the same trade mark being used on both, plaintiffs would be entitled to the injunction they seek. (Yale Electric Corp. v. Robertson, 26 Fed. (2d) 972.)

The first question presented, therefore, is whether the practical indentity of the trade marks could reasonably be expected to give rise to a mistaken notion that both articles were put out by the same concern. The labels, packages and advertising of both plaintiffs and defendant give the names of those corporations as the producers and distributors of their products; but the names are so inconspicuously given that they would not materially tend to dispel any misapprehension that might arise from the use of the same trade mark. There is no association between the two products in the selling of them.

Plaintiffs' is sold only in dry goods stores, whereas defendant's is sold in house furnishing and drug stores. In department stores, where both might be sold, they would be ordinarily in widely separated departments. The only place that I can think of where there would be proximity in the sales of the two articles would be in rural general stores; but in those there is such a variety of merchandise that I do not believe there would be any material increase in the association between plaintiffs' and defendant's products because of the proximity.

In advertising, however, the two would very likely have proximity. Both articles are used by the general public and would be advertised in media appealing particularly to women. It is therefore not at all unlikely that in the course of time the advertisements for the two products would be in the same periodicals.

There is not the slightest association in use between the two products nor in manufacture. In so far as the consumer is concerned, neither article in itself suggests the other; furthermore the trades are completely out of contact with each other except as above mentioned.

I find that there was no intention or desire on the part of the defendant to have its toilet paper in any way associated in the minds of the public with plaintiffs' cotton goods. The latter is a strong, durable fabric used largely in the making of pajamas, and though it has a somewhat smooth finish it has no particular attractiveness which might prompt the defendant to desire its product to be associated with it.

### Suggestion of Silk.

In other words the merits of plaintiffs' product are rather in durability than in fineness or richness, and I believe that the defendant if seeking to have its product associated with some fabric would have chosen a more luxurious one than cotton print goods. I am convinced that the word soisette was chosen by defendant because it sug-

gested silk rather than the plaintiffs' product.

Furthermore I am convinced that defendant did not intend nor desire that its product be thought a product of the plaintiffs'. The names of the latter are not well known to the public, and their trade mark "Soisette" does not appear in them. There could be no such incentive on the part of the defendant as in the case of Rolls Royce of America, Inc., v. Wall, 4 Fed. (2) 333, or Yale Electric Corp. v. Robertson, supra.

Under all the circumstances I do not believe that there is any danger of the toilet paper being thought a product of the plaintiffs. It is conceivable that some person might draw that inference from the practical identity of the two words that constitute the trade marks, but I think that the mistake would be so unusual as not to constitute a violation of plaintiffs' rights.

In this connection it must be considered that the word soisette is not a completely unique and artificial symbol; the predominant element in it is the French word meaning silk, and the only artificial element is the addition of the French suffix "ette." To most persons it would suggest the idea of silk, as well as plaintiffs' brand of cotton goods. If the word were completely artificial, so that it suggested no idea but plaintiffs' goods, the use of it on other goods would have a greater tendency toward giving the impression that both emanated from the same concern.

Even though there is no chance for confusion or mistake it is plain that plaintiffs are damaged by the use of their trade mark in connection with toilet paper. There is an indelicacy about the latter notion that cannot help bring embarrassment and probably financial loss to the plaintiffs. The more plaintiffs' trade mark becomes associated with an article which most people are repelled from contemplating, the less popular it will become.

The same sort of damage might be done to a trade mark containing the name of some individual or place that has suddenly, through war or crime or other reason, become extremely unpopular. I believe that defendant in adopting plaintiffs' trade mark has caused them damage; but I have been unable to find any authority either in the reported cases or in the textbooks indicating that such damage is an injury which the law will remedy.

If the paper which defendant manufactures were writing paper, or some other kind without an unpleasant association, plaintiffs would certainly have no cause of action, and I have been unable to find any indication in the authorities of a ground for distinguishing the two cases. It should be borne in mind in this connection that if it seems unfortunate that plaintiffs should suffer this damage without a remedy, they are to some extent responsible in that they adopted as their trade mark a word which plainly suggests certain qualities applicable to an entirely different kind of product from their own.

They have branded their goods with a slight modification of a French word and have run the risk of having the same word applied in good faith to an entirely different article whose qualities are suggested by the same root. The law protects plaintiffs from the possibility of confusion but in the absence of that I feel constrained, and with some reluctance, to hold that there is no cause of action.

I accordingly direct a decree for the defendant. April 30, 1929.

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# *Use of Mark on Paper and Fabric*

EX PARTE BONIDE CHEMICAL CO., INC.
ASSISTANT COMMISSIONER OF PATENTS.

THE notation "Crow-tox" was held not registrable as a trade mark for a non-poisonous preparation for protecting seed against birds and for invigorating seed, it being found that the expression is falsely descriptive of the goods to which it is applied since the word "Tox" is defined as a poison, whereas the goods sold by appellant are nonpoisonous. The decision of the examiner was affirmed.

Martin & Rendell for applicant.

The full text of the opinion of Assistant Commissioner Moore follows:

**Appeal from Examiner.**

The applicant appeals from the decision of the examiner of trade marks refusing to register is trade mark "Crow-tox" for "a nonpoisonous preparation for protecting seed against birds and animals and for invigorating seed."

The ground on which registration of said mark was refused is that it is descriptive or misdescriptive of the goods.

The examiner cites as authority for his holding the decision in the Larvex Corporation v. Peter G. Walter (151 MS. Dec. 763), in which it was held that "Larvatox" is descriptive of an insecticide; and the decision in re National Phonograph Co. (128 O. G. 1295; 29 App. D. C. 142), holding that a word cannot be appropriated as a trade mark which is either truly descriptive or falsely descriptive.

The law (Trade-Mark Act of Feb. 20, 1905, Sec. 5), specifically provides that no trade mark which consists "merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods," shall be registered; and the courts have uniformly held that marks which are deceptive are not entitled to protection as a property right (Clinton E. Worden & Company v. The California Fig Syrup Company, 23 Sup. Ct. 161; 187 U. S. 516; 102 O. G. 623; 1903 C. D. 637).

The trade-mark act does not forbid registration of descriptive words or devices as trade marks, but only those which are descriptive of the goods, or the character or quality of the goods, with which they are used. Therefore, in order to determine whether words or devices used as trade marks are descriptive of the goods or are deceptive, it is necessary to ascertain the probable effect such words or devices, when given their usual meaning, have upon the public mind.

The meaning of some descriptive words or devices used as trade marks is so foreign to the qualities or characteristics of the class of goods with which they are used as to render it unlikely that they would ever be regarded as used descriptively or deceptively. In such cases the marks are arbitrary and fanciful and form proper technical trade marks. It is where the meaning of the words or devices is descriptive of the qualities or characteristics of the class of goods with which they are used as trade marks that their registration is prohibited by the trade-mark act.

The applicant's mark is primarily for a preparation for protecting seed against birds and animals. It is common practice to include a poison in preparations of this class. The applicant's trade mark "Crow-tox" would therefore suggest to the mind of the public that the goods with which the mark is used is a poison, the word "tox" being defined the same as "toxic" and "toxico" from the Greek "toxicon," poison, a combining form.

### Mark Is Deceptive.

It is contended by the applicant, however, that its mark is not descriptive of the goods, as the goods contain no poison for crows. This being true, then the mark is deceptive, as one wishing to purchase a poison for crows would be deceived into purchasing the applicant's nonpoisonous preparation.

The decision of the examiner of trade marks is regarded as without error, and it is accordingly affirmed.

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MAY 25

# *Requirement for Copies of License*

BROCKTON SHOE MANUFACTURING COMPANY, INC., v. BERENICE BROWN, TRUSTEES FOR ARCH PRESERVER SHOE PATENTS SUBSTITUTED. APPLICATION FOR CANCELLATION NO. 1824, ASSISTANT COMMISSIONER OF PATENTS.

PETITIONER'S motion for judgment on the record, based on respondent's failure to file copies of certain specified licenses, in a trade mark cancellation proceeding, was denied, and the case was remanded to the examiner with instructions to fix a time within which respondent should furnish the copies in question, it appearing that the petitioner wished those documents, not as evidence to establish his own title to the trade marks, but to show that the marks had been so farmed out by licenses that the registrations were not valid.

### Examiner's Action Disapproved.

The decision of the examiner of interferences, modifying an order which had been entered by consent between the parties, was held to be without authority.

Charles W. McDermott for Brockton Shoe Manufacturing Company, Inc.; Edwin F. Murdock for Brown. The full text of the opinion of Assistant Commissioner Moore follows:

This is an appeal from the decision of the acting examiner of interferences in charge of trade marks modifying an

order which he had entered on January 19, 1929, requiring respondent to furnish petitioner copies of certain specified licenses and denying petitioner's motion for judgment on the record in view of the failure to furnish such copies.

### Applicability of Rulings

This "appeal" is entitled also in cancellation proceedings Nos. 1825 and 1826, and, while the question does not appear to have been specifically raised in those cases, the parties and the examiner appear to have considered the rulings herein as applicable thereto.

Ordinarily no appeal lies from a decision of the examiner of interferences denying a motion for judgment, and the questions involved will be reviewed on such a so-called appeal only in the exercise of the supervisory authority of the Commissioner.

The order of January 19, 1929, was entered by consent, it appearing that at the hearing the respondent had agreed to furnish the petitioner with the copies of the licenses and the examiner of interferences holding that respondent would not be required to furnish petitioner with copies of certain contracts.

### Value of Evidence

In the later decision the examiner of interferences stated that the documents in question had only been cursorily examined in view of the respondent's consent to furnish copies thereof, and in that later decision he held that upon further consideration it was not perceived how the documents referred to were material to petitioner's case, and therefore the order was modified and it was held that respondent need not produce the documents specified in paragraphs 10, 11, 14, and 18 of the answer.

Inasmuch as the practice in opposition and cancellation proceedings follows the equity practice, it is thought that the examiner of interferences was without authority to so modify the order entered by consent. It does not, however, follow from that that the examiner of interferences necessarily had to enter judgment on the record in favor of petitioner.

### License Not Produced

From the papers which had then been filed or have subsequently been filed, it would seem that petitioner has been furnished with copies of the contracts referred to so far as they exist, except the one referred to in paragraph 18 of the answer, which is said to be a license executed about May 1, 1924, in which the party Charles Brown conveyed to the Selby Shoe Co. a license to use the trade mark shown in registration 239510 on women's and misses' boots and shoes and men's, boys' and little men's boots and shoes, respectively. It does not appear that any copy of that license has been furnished, nor any statement under oath or otherwise as to the terms of that license, if, as a matter of fact, it was not a separate paper, but was embodied in some other contract. Since the trust agreement is dated June 20, 1921, clearly a license of May 1, 1924, could not be disclosed therein.

### Status of Mark Involved

It appears from the record that the petitioner was seeking to get these licenses not for the purpose of establishing his title to his trade mark by derivation or otherwise, but wished these documents as a basis for the contention that these marks, the cancellation of which is sought, had been so farmed out by licenses that the registrants had not so used the mark that the registrations were valid.

The order of the examiner of interferences denying the motion for judgment will not be set aside, but the case is remanded to the examiner of interferences, with directions to fix a time within which respondent shall furnish petitioner with a copy of the license referred to in paragraph 18 of the answer.

### Decree Subject to Appeal

If the papers, copies of which have been furnished, and the license of 1924 show licenses such as argued by the petitioner, of course any argument as to the effect of those licenses can be presented by the petitioner and if only excerpts from those licenses have been filed, any doubt as to the character of these licenses should, in view of the failure to furnish the full copies, be resolved against the respondent. If the respondent neglects or fails to furnish within the time set by the examiner of interferences the copy of the license referred to in paragraph 18 of the answer, petitioner can then urge that such action be taken as he is entitled to under the provisions of Equity Rule 58 for failure to file the copy of that license.

The decision of the examiner of interferences is modified to the extent indicated.

May 13, 1929.

# Evidence of Fraudulent Practice

SAQUOIT PAPER CO., INC., v. HILDA WEISTOCK. OPPOSITION NO. 8434, ASSISTANT COMMISSIONER OF PATENTS.

THE Assistant Commissioner held that the opposer lost the right to its exclusive use of a trade mark due to fraudulent practices through the use of a notation on its label stating that its mark had been registered and that infringements would be prosecuted, whereas no such registration had been obtained. The decision states that the opposer must be guiltless of any misrepresentation as to the mark relied upon in the opposition.

The decision of the Acting Examiner of Interferences sustaining the opposition to registration of the notation "Purple Cross," with a pictorial representation of a purple cross, as a trade mark for toilet paper, was reversed.

Mason, Fenwick & Lawrence for Sauquoit Paper Co., Inc.; Jacobi & Jacobi for Weistock.

The full text of the opinion of Assistant Commissioner Moore follows:

The applicant, Hilda Weistock, doing business as City Specialty Company, appeals from the decision of the acting examiner of interferences sustaining the opposition of Sauquoit Paper Co., Inc., to the registration by the applicant of her trade mark consisting of the notation "Purple Cross" and a pictorial illustration of a purple cross, for toilet paper.

This appeal presents two questions for decision:

(1) Whether the opposer had a good title to the trade mark "Purple Cross" for toilet paper when the applicant entered the field; and

(2) Whether the opposer has been guilty of fraud and misrepresentation and thereby lost the right to the exclusive use of the mark in controversy.

(1) As to the title, the opposer took testimony showing that there was a sale and assignment from Seneca Paper Company, Inc., through the trustee in bankruptcy to the opposer of the trade mark "Purple Cross" and the good will of the business. The applicant apparently was not present or represented by counsel at the time the testimony was taken and has furnished no proof showing that the opposer did not acquire a good title to the mark from the bankrupt. In the absence of proof to the contrary, it must be presumed that the legal formalities of the sale were complied with by the trustee and that a good title to said mark passed to the opposer.

(2) Bearing on the question as to whether opposer has been guilty of fraud and misrepresentation, the following notation appears on the opposer's specimen label:

"All infringements of this label will be prosecuted. Trade mark registered United States Patent Office." Whereas, according to the records of this office no such trademark had been registered.

That a false statement on a label that the disclosed trade mark has been registered constitutes such fraud and misrepresentation as to deprive the party making the same of the benefits of the Trade Mark Act, was settled by the Court of Appeals of the District of Columbia in the case of Four Roses Products Co. (Four Roses Malt Extract Co. Substituted) v. Small Grain Distilling & Drug Co. (378 O. G. 506), in which the Court stated:

**False Statement Is Fraudulent.**

"The record discloses that appellant's labels carrying the mark have borne the words 'Trade Mark Reg. U. S. Pat. Off.' The mark had not been registered, and of course appellant knew it had not been registered. That such a legend has some significance in the public mind is apparent. Manifestly, appellant intended to convey to the public the impression that the United States Patent Office had determined the question of the ownership of the mark. In other words, that appellant was its owner and that any other user on goods of the same descriptive properties would be an infringer.

"In Levy v. Uri, 31 App. 441, 135 O. G. 1363, this court ruled that the Patent Office should not recognize a property right in a mark and grant it registration as a trade mark, when the courts, upon the same facts, would decline to protect the mark if registered, basing its decision, in part, upon the decision of the Supreme Court of the United States in Worden & Co. v. California Fig Syrup Co., 187 U. S. 517-528."

**Right Depends on Facts.**

The acting examiner of interferences recognized that the doctrine of "unclean hands" is involved in this case, but held "that the state of facts existing at the time the decree is entered, and not the state of facts existing at the time the bill is filed, determines the rights of the parties," it appearing from the record

that after the bill was filed but before the decree was entered the opposer discontinued using the objectionable labels. This ruling was based on the decision in McCabe et al. v. Guaranty Trust Co. of New York (243 F. R. 845), in which it was stated:

"It is true that the right to judgment in an action at law depends upon the facts as they exist when the action is commenced; but in equity a different rule governs, and is, as already stated, that the decree in equity is to be shaped as the rights of the parties exist at the time of the decree."

**Opposer Misrepresented.**

The above decision is not applicable to the state of facts in the instant case. The issue between the parties in this case is whether the applicant's trade mark shall be registered, and not the question of unclean hands. The doctrine of "unclean hands" is one of which the court may take judicial notice, the maxim of the court being that he who comes into court of equity, asking its interposition in his behalf, must come with clean hands; and if it appear that the complainant has been guilty of fraud or of unconscionable, inequitable, or immoral conduct, "he will be repelled at the threshold of the court" (Simmons Medicine Co. v. Mansfield Drug Co., 93 Tenn. 94, 1893; 23 S. W. 165). And the fact that the opposer discontinued the misrepresentation after filing the notice of opposition is entitled to but little consideration in determining the bona fides of the opposer's position when it applied for equitable assistance (Bear Lithia Springs Co. v. Great Bear Spring Co., 71 N. J. Eq. 595).

That this opposition should have been dismissed in view of the above facts is fully supported by the ruling of the Court of Appeals of the District of Columbia in The Federal Products Co. v. Lewis (57 App. D. C. 338), in which it was stated:

"It is urged by counsel for the applicant that inasmuch as an opposition proceeding is in the nature of a proceeding in equity, the opposer, to establish her right to protection, must come into Court with clean hands. In other words, one seeking to prevent the registration of a trade mark must be guiltless of any false representations either in the mark relied upon as a basis for opposition or in the advertising of the goods on which the mark is used, and if it appears that absolute honesty in either of these particulars is lacking, the opposition should be dismissed."

The decision of the acting examiner of interferences is reversed.

May 15, 1929.

## JUNE 1

# *Notation "Unitube" on Anesthetics*

EX PARTE ARTHUR E. SMITH. FIRST ASSISTANT COMMISSIONER OF PATENTS.

THE examiner's requirement that the notation "Unitube" be disclaimed as being the equivalent of the words "unit tube" and therefore descriptive was reversed on the ground that the notation was not descriptive of the goods to which appellant's composite mark, including the notation "Unitube," is applied, the goods consisting of anesthetic tablets and solutions.

Burnie J. Craig and M. K. Saunders for applicant.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

The applicant has appealed from the decision of the examiner of trade marks denying registration of a composite mark made up of the notations "Conducto" and "Unitube", the notation "Conducto" being shown with the base of the letter "C" extended in a curve under the remainder of the word to the terminal letter "O", while the notation "Unitube" appears below the word "Conducto" but within the curved line connecting its initial and final letters. The letter "T" of the notation "Unitube" is made larger than the other letters and its upper horizontal portion projects over some of the letters while the vertical portion of this letter extends below the other letters and across and below the curved line. The goods upon which the mark is used are local anesthetizing nerve blocking tablets, local anesthetizing nerve blocking solutions, anesthetic tablets, and anesthetic solutions.

The examiner has held the notation "Unitube" to be equivalent to the words "unit tube" and to be descriptive of the goods, and required a disclaimer.

It is not denied by the applicant that the goods are sometimes placed in or sold in containers which may be described as unit tubes. The statement is made that the goods may be and in fact frequently are put up in containers which are not unit tubes.

**Misconstruction Held Likely.**

It is considered the examiner was correct in his view that the purchasing public would be likely to construe the notation as meaning "unit tube." It is not believed, however, that such words or notation which merely indicate a container of unit capacity are descriptive or applicant's goods. Indeed there is nothing at all in the notation which is descriptive of the tablets and solutions even if descriptive of an ampoule or glass container. Those familiar with the goods when sold in containers would not be likely, unless familiar with this name which the applicant has adopted, to refer to the goods as unit tubes. More likely those using such tubes, if they had never heard of this particular notation, would call them single tubes or single-charge tubes. While the notation which the examiner requires to be disclaimed may be in some sense suggestive of the unit charge of the contents for hypodermic syringes yet it is believed it is not at all descriptive of the tablets or solutions.

The decision of the examiner is reversed.

May 20, 1929.

## JUNE 3

# *Use of Designation "Air-O" on Belts*

CLUETT, PEABODY & CO., INC., v. DENVER M. WRIGHT. APPLICATION FOR CANCELLATION NO. 1581, ASSISTANT COMMISSIONER OF PATENTS.

THE petition for cancellation of registrant's trade mark "Air-O" for belts for men's and women's wear was denied upon a finding that the goods upon which the petitioner used his mark—shirts, collars, cuffs, handkerchiefs, etc.—did not have the same descriptive properties, and that there would likely be no confusion by virtue of the use of both marks. The opinion states there was no evidence of confusion, although both marks have been in use since 1915.

Roberts, Cushman & Woodberry for Cluett, Peabody & Co., Inc.; Albin & Weismantel for Wright.

**Case Heard on Appeal.**

The full text of the opinion of Assistant Commissioner Moore follows:

The petitioner, Cluett, Peabody & Co., Inc., appeals from the decision of the acting examiner of interferences dismissing its petition for the cancellation of registration No. 162625 of the registrant's trade mark "Air-O" for belts for men's and women's wear.

The essential ground advanced for cancellation is prior adoption and use by the petitioner of trade marks consisting of the word "Arrow," or the word "Arrow" associated with a pictorial representation of an arrow, for various articles of wearing apparel. In substantiation of this ground for cancellation, the petitioner has listed and claims ownership of 12 registrations of trade marks registered from 1900 to 1925.

**Goods Not in Competition.**

The petition was dismissed by the acting examiner of interferences for the stated reasons that the goods (belts for men's and women's wear) manufactured and sold by the registrant are clearly not goods of the same descriptive properties as any of the articles upon which the petitioner is the prior user of the "Arrow" mark, more specifically shirts, collars, cuffs, handkerchiefs, nightshirts, pajamas, undershirts, underdrawers and union suits; also, because of the difference between the respective marks of the parties.

It appears to be agreed between the parties that the essential and controlling question presented for decision is, as stated by the registrant:

"Are the distinguishing characteristics of the petitioner's and registrant's goods of such similarity that they might be classed as of the same descriptive properties?"

From the facts conditionally stipulated, but which have not been controverted or disproved, the registrant began using the mark "Air-O" on the belts in 1915; whereas, the petitioner did not use its marks on belts of any kind prior to November, 1926, and then only on bathing belts.

It also appears from the record that the petitioner and its predecessors have

used the "Arrow" mark on shirts, collars and cuffs since 1885; that its use was extended to handkerchiefs about April, 1909, and to nightshirts, pajamas, undershirts, underdrawers and union suits, about July, 1913.

That the registrant's belt does not have the same descriptive properties as any of the articles to which the petitioner appropriated its mark up to the time the registrant entered the field is evident. One wishing to purchase collars, cuffs, shirts, etc., would never be deceived into purchasing the registrant's belt; nor would one wishing to purchase registrant's belts be deceived into purchasing any one of the petitioner's articles to which it appropriated its mark prior to 1926. In fact, the petitioner has regarded the various articles of wearing apparel to which it has appropriated its "Arrow" mark as possessing different descriptive properties, as evidenced by its several registrations of said mark, listed in this proceeding, for different articles of wearing apparel. Registrations Nos. 34645, 44073, 45693, 90793, and 127011 are for collars and cuffs; No. 107962 is for shirts, collars and cuffs; No. 114337 is for nightshirts, pajamas, undershirts, underdrawers, and union suits; Nos. 147966, 165458 and 166951 are for handkerchiefs; and No. 195369 is for neckties.

**Confusion Not Likely.**

As to the likelihood of confusion or mistake in the mind of the public by the concurrent use of the two marks on the respective goods of the parties, it may be noted that the record does not disclose a single instance of any such confusion or mistake, notwithstanding both marks have been in use since 1915.

The petitioner admits that it did not appropriate the "Arrow" mark to belts until 1926, but contends that a trader using a mark on one species of goods within a commercial class has a right of expansion to other species within that class, and that he should not be hampered or embarrassed by the registration of his mark to another; citing in support of this rule Gutta Percha & Rubber Co. v. Ajax Mfg. Co., 48 App. D. C. 230; 259 O. G. 184.

The petitioner may at one time have had the right to extend the use of its "Arrow" mark to belts to the exclusion of the right of the registrant to use his mark "Air-O" on belts, but if the petitioner ever had any such right it has lost it by laches. From the record it appears that from 1915 to 1926 the petitioner practically acquiesced in the exclusive use of the mark "Air-O" on belts by the registrant, and that during that time the registrant built up a market, together with a good will, for its belts under the mark "Air-O." If the petitioner should now be given the exclusive right to use the mark "Arrow," and to exclude the use of the mark "Air-O" for belts, it would in a large part appropriate to itself the good will which, without objection, the registrant built up for his products. Such a result would be plainly inequitable (Victor Stove Company v. Hall-Neal Furnace Company, 374 O. G. 252; 18 T. M. R. 178.) In France Milling Company v. Washburn-Crosby Co., 7 F. (2d) 304, it was held:

"Manufacturer of flour under Gold-Medal trade mark, who for many years acquired in use of same mark by manufacturer of pancake and buckwheat flour, and sold latter raw flour for use in manufacture, held to have lost by laches all right to enjoin such use of mark."

The decision of the acting examiner of interferences is affirmed.

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# "Goose Load" on Cartridge Loads

WESTERN CARTRIDGE COMPANY v. REMINGTON ARMS COMPANY, INC. OPPOSITIONS NOS. 7737 TO 7748, CONSOLIDATED UNDER NO. 7737, FIRST ASSISTANT COMMISSIONER OF PATENTS.

THE opposition to registration of trade marks consisting of the notation "Goose Load," "Snipe Load," or "Duck Load," accompanied with the pictorial representation of the habitat of the bird or animal for which the particular type of ammunition was intended, for various cartridge loads, was sustained upon a finding that the marks were not registrable because of being descriptive of the class of goods to which they were applied and because of prior registrations and the opposer's prior use of pictorial representations of game used in connection with game loads and other forms of ammunition, which indicated that the exclusive use of pictorial representations for the purpose intended could not be granted to applicant.

Applicant's contention that the fanciful features of its representations would

so far subordinate the use of the name of the game bird in the mark as to prevent confusion between his marks and the prior uses and art was not sustained, it being held that the important part of the mark from the user's standpoint would be that for goose hunting the goose load should be used, etc., and that the landscape features would escape notice.

John H. Bruninga for Western Cartridge Company; A. A. Dicks for Remington Arms Company, Inc.

The full text of the opinion of First Assistant Commissioner Kinnan follows:

### Opposition to Marks.

This case comes on for review, on appeal of the opposer, Western Cartridge Company, of the decision of the examiner of trade mark interference dismising the opposition and adjudging the applicant, Remingington Arms Company, Inc., entitled to the registrations for which it has applied.

The applicant seeks registration of some 12 trade marks used upon various gun loads or cartridge loads of different grades or standards, the marks constituting pictures respectively of the game for which the loads have been manufactured and are deemed especially adapted. By stipulation approved by the Commissioner all these oppositions have been consolidated into one.

The registrations sought are respectively for a picture of a goose, a snipe, a brant, a quail, a grouse, a squirrel, a rabbit, a dove, a buck, and two different pictures of a duck. Each picture of a game fowl or animal appears upon a suitable background somewhat indicative of the habitat of the game. Each picture has printed above it the word "Load" preceded by the name of the particular fowl or animal appearing therein. The picture of the goose has above it the name "Goose Load"; that of the snipe, the name "Snipe Load"; that of the duck, the name, "Duck Load", and of the quail, "Quail Load," and so on through the various pictures of the game. These names are disclaimed in the respective applications except in connection with the pictures as shown.

In the ex parte prosecution of these applications the examiner of trade marks denied registration as to all of them on the ground that they were descriptive of the goods. On appeal in the case of application No. 168794 I held that while the words "Duck Load" should be disclaimed, the peculiar or particular illustration of the duck hovering over a swamp or pond together with the background was not descriptive but was suggestive. In view of that decision the examiner withdrew the objection to all the other applications and passed them for publication. The present oppositions resulted.

### Used as Class Marks.

There was not before me on appeal a knowledge of all these applications with notations therein indicating the grade or class of the goods. A review of these applications with the notations appearing above the pictures together with a consideration of the advertisement, opposer's exhibit No. 14, indicates the pictures sought to be registered have been used as grade or class marks rather than as trade marks. It is thought to be clear that users or purchasers of the goods would understand that the picture of the duck with the words "Duck Load" thereon represented a load particularly suitable for shooting ducks and that the picture of the quail, together with the words "Quail Load" indicated the load was of the class or grade suitable for shooting quail, and so on to all the other pictures with the names of the birds or animals appearing thereon.

The applicant has noted the former difficulties in indicating to purchasers of sporting ammunition the particular character of ammunition desired by such customers, due to the unavoidable variation in the propelling power of different powders, etc. A great variety of ammunition of this character was necessary to meet the demands of the trade. To overcome this defect the application alleges it designed the present system of indicating according to a standard the grade of ammunition to which the marks were applied. Applicant states that it loaded shells with reference to what they would do rather than what they contain. Ammunition of these particular kinds is obviously not limited to use in connection with the bird or animal pictured in the mark. The applicant states on page 17 of its brief:

### Pictorial Representations.

"The different loads of respondent's 'game load' line of shot shells are identified by the name of some particular game animals or birds, this identification

replacing the burdensome and pernicious powder specifications."

It seems evident enough the applicant's use of these various pictures is to indicate grade or class of goods and is, in consequence descriptive.

Aside from this phase of the question of descriptiveness it appears to have been common to, long before the applicant entered the field, register trade marks for ammunition which marks consisted of pictorial representations of game birds or animals. Trade mark No. 45420, registered August 15, 1905, for powder represents a flock of ducks in flight, while No. 52991, registered May 22, 1906, represents a single duck in flight used upon gunpowder. No. 57396, registered November 13, 1906, includes a pictorial representation of two game birds, used upon gunpowder. No. 64361, registered August 6, 1907, includes a pictorial representation of several ducks in flight and a hunter in the act of shooting. These registrations have expired and the record does not show that they have been renewed. They serve to illustrate, however, the practice of registering trade marks of this general type. Registration No. 64355, issued August 6, 1907, includes a picture of two pheasants, used upon gunpowder and No. 64356, registered August 6, 1907, includes the picture of a deer or buck, upon gunpowder. Both of these registrations have been renewed. Registration No. 79965, issued October 25, 1910, for the word "Bear" used upon smokeless powder; No. 80044, registered November 1, same word, used upon rifle powder. 1910, for the word "Stag" upon smokeless powder; registration No. 106328, issued October 19, 1915, for the word "Bear," obtained by the owner of the above-noted earlier registration for this same word, used upon rifle powder. There is also registration No. 155406, issued May 30, 1922, for a picture including a pheasant used upon gunpowder.

The opposer sets forth considerable literature, including advertisements, labels for its goods, etc., in which pictorial representations of game have been used in connection with game loads and other forms of ammunition. Opposer's exhibits Nos. 19, 19a and 37 satisfactorily establish these facts. This last noted exhibit shows a label which comprises a picture of a quail for use upon its goods. There have been submitted in evidence various publications showing pictures of game in connection with advertising opposer's ammunition.

From the foregoing registrations and opposer's advertising, it is fully established that the public has long been familiar with pictorial representations of game in connection with the ammunition to be used in hunting such game. The field is not open to anyone to exclusively appropriate pictorial representations of game in connection with goods of this character.

**Differences Claimed.**

The applicant, however, has pressed the view that its representations are so far different from those formerly used upon these goods that it is entitled to their registration as trade marks.

Upon considering this entire prior use, it is believed the fanciful features disclosed in the applicant's various marks are so far subordinate to the representation of the game bird or the game animal as to cause confusion in the minds of purchasers. Users of the applicant's ammunition would become familiar with the fact that for deer hunting the buck load should be selected; for goose hunting, the goose load; for squirrel hunting, the squirrel load, and so on, and would call for these goods by the name of the bird or animal appearing in the particular picture. The landscape or other features indicating the usual habitat of the bird or animal would either escape notice or not be remembered. This would cause confusion of goods or of origin with respect to opposer's goods It is thought registration would enable the applicant to interfere with the opposer's trade and customers. The latter has established use of the representations of game birds and animals in connection with its ammunition from a date prior to the applicant's entry into the field. The opposer who has used these pictures in a descriptive way would be damaged by the applicant's registrations.

The decision of the examiner of interference dismissing the opposition is reversed, the opposition is sustained, and it is adjudged the applicant is not entitled to the registrations for which it has applied.

May 16, 1929.

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# Syllabi of Patent Decisions

*(See Also Master Index on Page 3)*

## MARCH 4

Single as Opposed to Plurality of Securing Means: Electric Fixture Outlet: Patentability.—Claims 1 and 2, covering an electric fixture outlet in which the socket member was attached to the bottom of the box by means of a single fastening bolt located in an axial bore of the socket member, held: Not patentable over prior art device in which a plurality of attaching screws were employed, the screws extending longitudinally of the socket member and having threaded engagement with the part to which the socket member was attached. Claim 3, including special canopy structure, was allowed. Patent 1701935.—Ex parte Ryan. (Board of Appeals of the Patent Office).—March 4, 1929.

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## MARCH 5

Tables: Patentability.—A prior patent showing a table top of moulded stone-like material having embedded therein wooden base members and supporting frame members of moulded stone-like material connected to the top by clips embedded in the frame members, held: Anticipatory of several of claims 1, 2, 4 and 5 to 11 directly and as differing from the others only as to immaterial features which were present in other art. Claims 3, 12, and 13, being limited to specific features, were allowed.—Patent 1701529.—Ex parte Copeman. (Board of Appeals of the Patent Office).—March 5, 1929.

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## MARCH 7

Method of Wiring Contact Pins: Patentability.—Claims 1, 2 and 3, Patent 1702234, for a method of connecting a lead wire within an open-ended contact pin, the only requirements being that the two elements be associated with flux between them at the proper place and then dipped into hot solder, held: Unpatentable, the process of soldering by dipping two associated pieces of metal being old and the use of flux so well known that no invention is involved in placing fluv where union is desired in a dipping process.—Claim 4 was found allowable.—Ex parte Goodridge. (Board of Appeals of the Patent Office).—March 7, 1929.

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Combination not Present in References: Protector for Mattresses: Patentability.—Where the eight claims of Patent 1700535, cover a protector for mattresses comprising a sheet of flexible protective material provided at each side with separate hems along separate side marginal portions thereof, separate rod members in said hems, flexible straps, and means for connecting one of the straps to each one of the rod members and a bed, held: Patentable, the combination not being shown in any one of the references, though each of the elements was shown to be old in some one of the patents cited.—Ex parte Kaufmann. (Board of Appeals of the Patent Office).—March 7, 1929.

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Equivalency: Infringement.—Where the patent claims covered combinations and defendant's structure omitted one of the elements of the combination, and this element patentee had been required to abandon in view of the prior art, held: No infringement, since plaintiff could not claim equivalency based upon element he had been required to abandon. Nicholas v. E. W. Brown Company. District Court for the District of Maine).—March 7, 1929.

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Apparatus for Use in Fish Canning Industry: Omission of Element: Infringement.—Where Patent No. 1492178, for apparatus for use in fish canning industry,

containing combination claims, and defendant's device was similar except that the latter omitted an element, held: No infringement, since the "omission of one element or ingredient of a combination covered by any claim of a patent averts any charge of infringement based on that claim, whether or not the omitted ingredient was essential to the combination of the patent, and whether or not it was necessary to the operativeness of the machine."—Nicholas v. E. W. Brown Company. (District Court for the District of Maine).—March 7, 1929.

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Aggregation: Arrangement for Locking Automobiles: Patentability.—Claim 18, covering a pair of ignition switches, independent in structure and operation from each other, associated with a gasoline valve and a gear shift latch operated in addition to and by the same switch arm that operates the ignition switch, and which are consequently locked and unlocked simultaneously with it, held: Claim is aggregative, there being no dependence in structure and operation of the various elements.—Patent 1701584.—Ex parte Moorhouse. (Board of Appeals of the Patent Office).—March 7, 1929.

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Aggregation: Locking Systems for Automobiles: Patentability.—The combination with the wiring of the ignition system, of a switch in said wiring, means for locking said switch and requiring removal of the key for unlocking it, and a second switch in said wiring adapted to control the ignition when the first switch is "on," held: Unpatentable as for an aggregation, since each switch is independent in structure and operation from the other.—Patent 1701584. Claim 15.—Ex parte Moorhouse. (Board of Appeals of the Patent Office).—March 7, 1929.

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## MARCH 8

Refining Petroleum Oils: "Cracking:" Validity.—Where the claims related to the art of refining petroleum oils known as "cracking," and had as a distinguishing feature means for withdrawing objectionable foreign matter out of the system by continuously discharging a portion of the degraded oil as it circulates with the foreign matter in suspension and continuously feeding back an equal amount of fresh oil, whereby the bulk of the oil in the system shall be kept constan; inquantity; and the period of a run of a cycle system with its attendant advantages can be materially lengthened, this feature presenting a combination not present in the prior art, held: Claims valid. Claims 2 and 4, Patent 1281884.—Skelly Oil Company v. Universal Oil Products Company. (Circuit Court of Appeals for the Third Circuit).—March 8, 1929.

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Refining Petroleum Oils: Infringement.—Where patentee's device for refining petroleum oils differed from the patent structure in the character of boiler or heater employed, which was in itself old in the art, and in the use of a larger bulk of charging stock, but resembled the patent device in the addition of a continuous feed and bleed in a measure that maintains the charge in constant volume as it revolves in a closed ring, of which the boiler is only a part, held: Patent infringed. Patent 1281884, claims 2 and 4.—Skelly Oil Company v. Universal Oil Products Company. (Circuit Court of Appeals for the Third Circuit).—March 8, 1929.

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Apparatus and Method for Obtaining Pulverized Coal: Patentability.—Claim 3, requiring that air shall be admitted below the second crushing mechanism and withdrawn between the two crushing mechanisms to recover the fine products of both crushing mechanisms, held: Patentable over a like apparatus in which the air is admitted below the lower crushing mechanism and is also withdrawn below that crushing mechanism. Patent 1702055.—Ex parte Murray. (Board of Appeals of the Patent Office).—March 8, 1929.

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Non-Analogous Arts: Apparatus for Obtaining Pulverized Coal: Patentability.—An apparatus and method for obtaining pulverized coal, including a casing containing upper and lower crushing mechanisms spaced from each other and so constructed as to crush coarse and finer lumps in separate stages, held: Anticipated

by a patent disclosing a process and apparatus for treating coffee to crush it and remove dust, as the claim differed therefrom only in making a reference to pulverized coal. Claim 1, Patent 1702055.—Ex parte Murray. (Board of Appeals of the Patent Office).—March 8, 1929.

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## MARCH 9

Combination of References: Cash Registers: Patentability.—Appellant's claims for a cash register having for their distinctive characteristic a single, universal zero-resetting control member for each denominational order, which single control member is common to the like denominational wheels of each line of totalizers, notwithstanding the multiplicity of totalizer lines, whereas the basic references showed devices having a plurality of control members, and there was no teaching reference showing how the basic patents could be modified to produce the structure of the appealed claims, held: Claims patentable. Claims 1, 4, 16, 22, 23, Patent 1702861.—Ex parte Brand. (Board of Appeals of the Patent Office).—March 9, 1929.

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Pull Stroke Ditchers or Excavating Machines: Validity.—Where plaintiff's excavator distinguished from the ordinary steam shovel in that the scoops dig inwardly toward the operating machine, as a pick or hoe, rather than away from the machine, as a shovel, the advantage of this feature being that the ditch or trench is cut the width of the bucket only and the machine always remains on solid ground as the excavation progresses, rather than astride the wall or ditch, held: Patents valid, plaintiff's device accomplishing old results in a new and useful manner, and better results by reason of a novel combination of old elements. Claim 4, Patent 1317431; claims 5, 6, 7 and 9, Patent 1476121; all claims of Patents 1511114 and 1543250.—Keystone Driller Company v. The Byers Machine Company et al. (District Court for the Northern District of Ohio).—March 9, 1929.

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## MARCH 11

Golfing Tee: Infringement.—Where, during the prosecution in the Patent Office, the single claim in the case had been limited to golfing tee formed of a single piece of material comprising a cone-shaped shank having a pointed end, a disk-shaped member connected with and carried by the shank, said member being dished or concaved in its upper surface to conform to the surface of the ball and surrounding by a marginal ball-retaining and supporting rim; and in defendants' device the ball was not in contact at all points with the support, nor was the marginal rim employed, held: No infringement. Patent 1493687.—Nieblo Manufacturing Co., Inc., v. Preston et al. (District Court for the District of Vermont).—March 11, 1929.

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## MARCH 12

Self-Loading Vehicle: Separable and Flexible Drive Connections: Infringement.—Where Reissue Patent No. 16356 covered a self-loading vehicle, including a chassis, a tiltable cargo body, a mechanical loader on the body, and a power-shaft to supply power to the loader from the motor of the car; and the claims specified as an essential element a separability between the parts of the mechanism connecting the power shaft with the loader, whereas defendants employed a flexible connection, held: No infringement, the separable and flexible drive connections not being equivalents.—Atia Sales Corporation v. W. S. Howard et al. (District Court for the Southern District of New York).—March 12, 1929.

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## MARCH 13

Water Softening Apparatus: Patentability.—Claim 1, covering water-treating apparatus, a treating receptacle comprising a storage portion, a sedimentation portion below the same and decreasing in cross-sectional area downward, and a mixing portion below the sedimentation portion and forming an extension thereof, said mixing portion being of much smaller cross-sectional area than the storage portion,

and all of said portions being in unobstructed communication with one another, in combination with means for introducing raw water and treating material for reaction in the mixing portion and means for withdrawing water from the storage portion, held: Patentable, as specifying a simplified construction over prior art structures. Patent 1702256.—Ex parte Green. (Board of Appeals of the Patent Office).—March 13, 1929.

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Centrifugal Extractors: Combination of References: Patentability.—Claims 1 to 5 and 7, covering a centrifugal extractor of the type used in laundries, rejected on a combination of three references which failed to show that portion of the claims which states that the means for supplying fluid pressure for actuation of the pressure operating means is operated or controlled by the rotating means for the carrier, held: Claims patentable. Patent 1702713.—Ex parte Watkins. (Board of Appeals of the Patent Office).—March 13, 1929.

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Centrifugal Extractors: Reference not Adapted to Same Use: Patentability.—Where in a centrifugal extractor for use in laundries the claims covered an arm for raising the load-carrying cage that was adapted to be swung laterally, held: Claims allowable over a patent in which the arm was not only adapted to be swung laterally but was held from so swinging by the use of a rod. Claims 8 and 9, Patent 1702713.—Ex parte Watkins. (Board of Appeals of the Patent Office.)—March 13, 1929.

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Transformers: Patentability.—A claim for a transformer, dependent for its novelty over a reference upon the use of a "fast" spark gap, held: Anticipated, the word "fast" being merely a relative term. Claim 7, Patent 1703408.—Ex parte Smith. (Board of Appeals of the Patent Office).—March 13, 1929.

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Transformers: Patentability.—Claims 7, 9, 11, 12 and 17, Patent 1703408, based on the broad idea of placing a protective spark gap within a hermetically sealed transformer casing containing a gaseous dielectric under pressure, held: Unpatentable. Claims 8 and 10, specific to appellant's apparatus, allowed.—Ex parte Smith. (Board of Appeals of the Patent Office).—March 13, 1929.

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## MARCH 14

Apparatus for Dispensing Drinking Cups: Patentability.—Where the appealed claims covered apparatus for dispensing nested cups having a flange at the open end of the cup, and having, as a distinctive feature, cam means for prying the flanges of the two lowermost caps apart and forcibly separating the lowermost cup from the next adjacent cup; and the two references cited did not contemplate the forcible separating action mentioned, although one of them showed means for forcibly separating the lowermost cup from the stack by pulling action on the body of the cup, held: Claims allowable. Claims 1, 2, 4, 5, 12, 13, 15, 16 and 17, Patent 1703637.—Ex parte Reifsnyder. (Board of Appeals of the Patent Office).—March 14, 1929.

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Paper Drinking Cups: Impregnated: Patentability.—Claims covering a paper drinking cup impregnated with waterproof coating of sufficiently high melting point to enable the cup to be used to serve liquid of high temperature, and having no visible coating on the outer surface of the side walls, held: Patentable over prior art disclosures which did not show these features in combination. Claims 5, 6 and 8 to 13, Patent 1703638.—Ex parte Reifsnyder. Claims 2, 3, 4 and 7 denied in view of prior art as they did not specify that. (Board of Appeals of the Patent Office).—March 14, 1929.

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Biscuit Facing and Stacking Machines: Patentability.—Where Appellant's invention comprised feeding mechanism to handle articles, such as cookies, in such manner that in emerging they would all be faced in the same direction, the cookies being so shaped that the center of mass is located to one side of its plane surface, whereas the prior art disclosed a structure comprising a chute mechanism designed to cause can lids to swing in one direction or another, depending upon which direc-

tion the heavier side was presented, so that they would all be faced in the same direction during their course down the chute, held: Claims covering special features of appellant's mechanism allowable. Claims 6, 12 and 13 allowed. Claims 7 to 11 denied. Patent 1702901.—Ex parte Hungerford. (Board of Appeals of the Patent Office).—March 14, 1929.

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Drilling Mechanism: Combination of References: Patentability.—Where the basic reference disclosed a drilling mechanism of the type set forth by appellant but differed therefrom in that it did not employ a valve-controlled passage for supplying cleansing air to the cleansing tube, and an additional reference taught not only the use of this additional cleansing air supply means but also showed a special supporting means for the rear end of the cleansing conduit, such as specified in one of the claims, held: Claims anticipated by the combination of references. Claims 16, 17 and 19, Patent 1703841.—Ex parte Gartin. (Board of Appeals of the Patent Office).—March 14, 1929.

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## MARCH 15

Implied License: Infringement.—Claim of implied license to defendant as employer of plaintiff at the time he had the invention perfected, held: Not allowable where preponderance of the evidence showed that the agreement was that plaintiff was to have a royalty for each indicator equal to twice the cost of the materials entering into the completed device, that there were to be frequent statements and accountings, and that any moneys advanced to plaintiff were to be deducted from the royalties. Patent 1477450.—Sanbo v. Bear Manufacturing Company. (District Court for the Southern District of Illinois).—March 15, 1929.

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Defense of Statute of Frauds: Infringement.—The defense of the statute of frauds, that the alleged contract of plaintiff was not to be performed within one year and was therefore void, held: Not sustained, as both parties entered into the performance of the contract, and so far as performed it was valid. Patent 1477450.—Sanbo v. Bear Manufacturing Company. (District Court for the Southern District of Illinois).—March 15, 1929.

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Car Roofs: Combination of References: Patentability.—Where appellants claimed a car roof which consisted of a combined ridge pole and ridge cover, which was riveted to the car lines and to which the running board was fastened, the combined member having curved ends which served as interlocks with the roof plates so as to permit longitudinal movement thereof but to prevent vertical movement; and the basic reference showed all but the interlock feature, and in another reference an interlock between adjacent roof plates was disclosed, held: Claims allowable, there being no suggestion of the modification of the basic reference in the supplemental reference. . Claims 3 to 6, Patent 1703149.—Ex parte Joughins et al. (First Assistant Commissioner of Patents).—March 15, 1929.

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Applicant's Own Copending Patent as a Reference: Common Assignee: Patentability.—Where applicant was common assignee of two cases and he obtained an improvement patent on one of them, held: This patent does not deprive him of adequate protection for the invention in the other application. Case distinguished from Ex parte Dunbar, 1922, C. D. 105, in which the same invention was claimed in both applications. Claims 1 to 3, Patent 1702892.—Ex parte Clawson. (Board of Appeals of the Patent Office).—March 15, 1929.

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Motion to Dismiss Based on Failure to Enter Disclaimer: Infringement.—Where a court decision had sustained the validity of Claim 6, with a statement that "in so far as the other claims may be construed to be of broader scope they are held to be void," and in response to plaintiff's bill defendant brought motion to dismiss on the ground that plaintiff had not entered disclaimer in his patent in view of the quoted statement, held: Motion to dismiss denied, there having been no final adjudication as to validity of those "other" claims. Bankers Utilities Company, Inc., v. Interstate Trust Company. (District Court for the Southern District of New York).—March 15, 1929.

Motion to Dismiss Based on Failure to Disclaim: Infringement.—Plaintiff's failure to file a disclaimer in his patent after decision finally adjudicating invalidity of certain claims of the patent will defeat his suit for infringement.—Bankers Utilities Company, Inc., v. Interstate Trust Company. (District Court for the Southern District of New York).—March 15, 1929.

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## MARCH 16

Apparatus for Promoting Catalytic Reactions: Infringement.—Patent 1604739, for an improvement in apparatus for promoting catalytic reactions, held: Infringed by defendant's converter which embodied the essential features of the patented structure. The Barrett Company v. The Selden Company. (District Court for the Western District of Pennsylvania).—March 16, 1929.

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Apparatus for Promoting Catalytic Reactions: Validity.—Where the patented apparatus for promoting catalytic reactions involved the use of materials and principles well known to those versed in chemical reactions, but patentee combined them in such a way that a new and valuable result was obtained, as evidenced by the fact that the apparatus was produced only after extended effort, and defendant adopted the apparatus and discarded his old converters soon after, held: Patent valid. Patent 1604739, 31 claims.—The Barrett Company v. The Selden Company. (District Court for the Western District of Pennsylvania).—March 16, 1929.

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Carbon Sets or Piles: Device within Statutory Class of Invention: Patentability.—Claims covering an article of manufacture, comprising a manifolding assembly of carbon sheets, the carbon coatings of which are of graduated relative hardness, whereby the transferring capacity of the sheets increases relatively through the assembly, held: Claims patentable as being for an article, a roll of carbons arranged in a specified manner.—Claims 18 and 19, Patent 1702823.—Ex parte Lentz. (Assistant Commissioner of Patents).—March 16, 1929.

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Mining Machines: Analogous Arts: Combination of References: Patentability.—Where the claims covered the combination of a mining machine, a swingable cutter bar thereon, and locking means for the bar; and the claims stood rejected on a basic reference showing the general arrangement, taken with a disclosure of a carpenter's square illustrating the particular type of locking means employed by appellant, held: Claims anticipated, locking devices being useful in a great variety of arts.—Patent 1702828.—Ex parte Holmes. (Board of Appeals of the Patent Office).—March 16, 1929.

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Pavement Resurfacer: Patentability.—Where the claims covered a device for heating the surface of asphalt roadways, including a cover of relatively long and narrow dimensions so that when placed crosswise of the street its length covers the desired width of the paving and when placed lengthwise on the vehicle it can be carried easily through traffic, and means for positioning and handling the device, held: Claims covering those features allowed, as the prior art did not disclose the broad fundamental idea involved. Claims 2 and 3, Patent 1702546.—Ex parte Owens et al. (Board of Appeals of the Patent Office).—March 16, 1929.

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## MARCH 18

Foldable Vehicle Top: Validity.—The single specific claim of Patent 1493814 for a foldable vehicle top consisting of main, front and intermediate bows so interconnected as to enable the top to be easily extended or folded by a single operator on either seat or either side of the vehicle, without excessively elevating or depressing any part of the covering during these operations, held: Invalid for anticipation in view of the prior art, and for lack of invention.—Wolfe v. Bedford-Chevrolet Sales Corporation. (District Court for the Eastern District of New York).—March 18, 1929.

Indicating Devices for Automobile Radiators: Patentability.—Claims 13, 16 and 18, covering indicating devices for the cooling system of an automobile and including a system for circulating a cooling liquid to control the temperature of the motor, said system being sealed against flowing of liquid or vapor from the top thereof and having an air space above the level of the cooling liquid, an open vent communicating with said space and normally maintaining the system at atmospheric pressure, a visual danger indicator in view of the operator, and pressure means constructed and arranged to set the indicator to a warning position when superatmospheric pressure occurs in the system, held: Patentable over disclosure of the cited art. Patent 1704488.—Ex parte Schlaich. (Board of Appeals of the Patent Office).—March 18, 1929.

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Head Lamps for Automobiles: Patentability.—Claims 1 to 7, 9 and 10, Patent 1704467, directed to a head lamp including the combination with a reflector of substantially parabolic form, of an illuminating filament having an extended length located substantially in the focal plane of said reflector and extending around the focal point thereof, held: Unpatentable, as being broader than the invention in that the claim did not include the limitation "terminating forwardly at substantially the focal plane," a limitation which experiment had shown was necessary to make the device operative.—Ex parte Engle. (Board of Appeals of the Patent Office).—March 18, 1929.

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Motorized Hand Saw: Combination of References: Patentability.—Where the claims covered a motorized hand saw wherein the motor cylinder for actuating the saw was provided with flanged heads and these heads were connected by tie bars projecting beyond one of the cylinder heads, the saw actuating crosshead being guided on the tie rods, and a guide for the saw blade carried by the outer ends of the tie rods; and the claims stood rejected on the ground that in view of the prior art it would be uninventive to extend the tie rods of the device shown in the basic reference to guide and support the crosshead, held: Claims allowable, the thought of extending the tie rods coming from the application on appeal rather than from prior art. Claims 1 to 3, Patent 1704641.—Ex parte Weed. (Board of Appeals of the Patent Office).—March 18, 1929.

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Method of Treating Roofing Material: Article Instead of Method Claims: Patentability.—Where the claims covered a step in the preparation of roofing which comprised bending sharply upwardly of the general plane of the roofing as laid the marginal portions thereof which are exposed to the weather when the roof is laid, held: Claims unpatentable as being for common method of forming flange on sheet material, and that novelty, if any, resides in the article.—Claims 1 to 3, Patent 1704058.—Ex parte Overbury. (Board of Appeals of the Patent Office).—March 18, 1929.

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## MARCH 19

Method of Preserving Pistachio Nuts: Validity.—Patentee's method of preserving pistachio nuts, consisting of roasting the nuts in the shell, applying gum arabic as an adhesive, then applying a salt compound, whereby the shells were enhanced in appearance, the nuts were properly preserved and the salt which reached the kernel made it more delectable, held: Claims covering the compound and the method are valid over method involving coating egg shells with preservative and over methods wherein nut kernels are treated with preservative.—Claims 1 to 6, Reissue Patent 15902. Zenobia Company, Inc., v. Shuda. (District Court for the Eastern District of New York).—March 19, 1929.

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Method of Applying Preservative to Pistachio Nut Shells: Infringement.—Where the claims covered a method involving the use of gum arabic as an adhesive for the purpose of retaining a salt compound on the pistachio nut shell, and defendant's method was substantially the same except for the use of starch as an adhesive, held: Claims infringed. Claims 1, 4, 5 and 6, Reissue Patent 15902.—Zenobia Company, Inc., v. Shuda. (District Court for the Eastern District of New York).—March 19, 1929.

Automobile Body Construction: Sound-Deadening Roof: Patentee Entitled to Uses of His Device: Patentability.—Where the claims covered an automobile roof provided with a receptacle specially designed for sound-deadening purposes; and the claims were readable on a prior art device in which a receptacle was provided in the roof which would unavoidably accomplish the function of sound deadening although patentee made no reference to such use of his construction, held: Claims anticipated. Claims 3 and 11, Patent 1703118. Appeal dismissed as to claims 1 to 5 and 8.—Ex parte McCulley et al. (Board of Appeals of the Patent Office).—March 19, 1929.

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Electric Air Heater: Exhausted Combination of Elements: Patentability.—Where the appellant claimed the combination of an electric heater and a thermostat in a unitary structure containing all which is adapted to be received in a rectangular recess in which the thermostat is responsive to room temperature instead of the temperature within the heater, and the claims were rejected on references showing the combination of thermostat and electric heater, held: Claims allowable as being for a combination of old elements in a new manner to produce a new result. Patent 1704479, Claims 1 to 4 and 6 to 10.—Ex parte Kercher et al. (Board of Appeals of the Patent Office).—March 19, 1929.

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## MARCH 20

Hair and Scalp-Drying Equipment: Validity.—Claims 2, 5, 7 and 11, Patent 1541988, including a device for drying hair, and consisting of a casing having a discharge opening, means for projecting a stream of air from the discharge opening, electric light arranged to send forth radiant heat and light rays through the discharge opening, and means other than said electric light for heating the air stream in its passage through the casing, held: Valid, as being for a new combination of elements, each old in the art.—Meyer v. Modern Electric Equipment Company, Inc. (District Court for the Western District of New York).—March 20, 1929.

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Hair and Scalp-Drying Equipment: Infringement.—Claims 2, 5, 7 and 11, Patent 1541988, covering a device for drying hair held: Infringed by defendant's structure which operated upon the same principle as plaintiff's with slight structural alterations, but did not suggest a patentably different mode of operation. Meyer v. Modern Electric Equipment Company, Inc. (District Court for the Western District of New York).—March 20, 1929.

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## MARCH 21

Paint Spraying Apparatus: Infringement.—Where the patent covered a device for atomizing and spraying liquids, of which the distinguishing feature resided in the use of an automatic pressure regulator in the air line leading to the discharge nozzle, wherein complete independence of the regulation of air pressure to the paint supply and to the nozzle was obtainable, the novelty being in the location of the reducer, held: Not infringed by defendant's device wherein an unloader valve was located on the compressor which was not adapted to perform the same function as patentee's regulator. Patent 1196691.—Alliance Securities Company v. Roman Paint Company. (Circuit Court of Appeals for the Ninth Circuit).—March 21, 1929.

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Paint Spraying Apparatus: Infringement.—Where defendant's device for spraying liquids, known as "Sparko" was very closely analogous to the patents which were considered as prior art against plaintiff's structure, held: No infringement. Patent 1196691.—Alliance Securities Company v. Ford Motor Company. (Circuit Court of Appeals for the Ninth Circuit).—March 21, 1929.

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## MARCH 22

Bleaching and Dyeing Furs: Process and Product: Infringement.—Where on stipulation of the defendant it was apparent that defendant infringed all claims of

patents in suit, because it appeared that it treated the skins in accordance with the patented process, knowing that they were to be subsequently dyed, held: Defendant was a contributory infringer as to claims 17 to 20, 23, 24 of product patent No. 1564378 and claims 15 to 24 of process patent No. 1573200, for bleaching and dyeing furs.—Stein fur Dyeing Co., Inc., v. Windsor Fur Dyeing Co., Inc. (District Court for the Eastern District of New York).—March 22, 1929.

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Bleaching and Dyeing Furs: Process and Product: Valadity.—Defendant's contention that product patent 1564378 and Process Patent 1573200 for bleaching and dyeing furs were invalid because both cover the same invention, held: Not sustainable.—Stein Fur Dyeing Co., Inc., v. Windsor Fur Dyeing Co., Inc. (District Court for the Eastern District of New York).—March 22, 1929.

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Bleaching and Dyeing Furs: Process and Product: Validity.—Where the patents covered product and process relating to bleaching and dyeing furs, the process consisting in bleaching furs by the use of hydrogen peroxide in the presence of ferrous sulphate as a protective agent; and the prior art showed various methods of treating wool, and one patent disclosed a method of decolorizing furs but with different chemicals, held: Patents valid. Patents 1564378 and 1573200, 24 claims each.—Stein Fur Dyeing Co., Inc. v. Windsor Fur Dyeing Co., Inc. (District Court for the Eastern District of New York).—March 22, 1929.

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## MARCH 25

Protective Device for Interior of Iron and Steel Pipes: Protection Against Corrosion: Patentability.—Claims 2 and 3, covering a device for protecting the interior of iron and steel pipes against corrosion by the use of a removable section of zinc between the adjacent pipe sections, held: Anticipated by a foreign reference disclosing th invention claimed, except for immaterial or uninventiv details.—Claim 4, covering details relating to the pipe connection, allowed. Ex parte Mills. (Board of Appeals of the Patent Office.) March 25, 1929.

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Decorative Candle: Patentability.—Appellant's candle comprising a body of wax or like material having an elongated dowel rod embedded axially therein, held: Not anticipated by reference disclosing means employed in attaching a window weight cord to a sash, the arts being dissimilar.—Claims 1 and 2, Patent 1704729.—Ex parte Deckert. (Board of Appeals of the Patent Office). March 25, 1929.

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Method of Making Decorative Candles: Patentability.—Appellant's method of making a candle which consists in successively dipping into molten wax and withdrawing therefrom a dowel rod having its lower end weighted so that it will sink readily into the molten wax, and then cutting the candle and the dowel rod transversely above the weighted end of the dowel rod, and applying a coating of wax to the cut end of the rod, held: Allowable over prior art which did not disclose the use of a weighted dowel rod to facilitate the dipping operation. Ex parte Deckert. (Board of Appeals of the Patent Office.) March 25, 1929.

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## MARCH 26

Implied License: Title, Conveyances, and Contracts.—Where the patentee did not use the defendant employer's time or property to develop the device nor did he assent to the use of the hinge by the defendant company, held: Defendant has no implied license. Patent 1588948.—Massie v. Fruit Growers Express Company. (District Court for the District of Delaware).—March 26, 1929.

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True Inventor Determined in Interference Proceeding: Persons Entitled to Patents.—Where the defendant alleged that the patentee was not the true inventor; and in an interference proceeding in the patent office between David McEwan and Edward A. Downey as joint inventors and Edward A. Downey as sole inventor the Office had ruled that in view of the evidence Downey invented the hinge and made

a complete disclosure of it to McEwan, held: Patent valid. Patent 1588948.—Massie v. Fruit Growers Express Company. (District Court for the District of Delaware).—March 26, 1929.

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Public Use: Experimental: Validity.—Where the evidence showed that two of the hinges for slatted floor sections, to which the invention was directed, had been made in defendant's shop and made to demonstrate their practicability before officials of the company, such use occurring more than two years before the filing of the application for patent, held: Patent valid, such use being merely experimental and for test purposes. Patent 1588948.—Massie v. Fruit Growers Express Company. District Court for the District of Delaware).—March 26, 1929.

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Public Use: Oral Testimony: Validity.—Where defendant relied upon oral testimony to prove public use of the patented device about five years prior to the time of the hearing, held: Patent valid, the evidence not being so "cogent as to leave no reasonable doubt in the mind of the court that the transaction occurred substantially as stated."—Patent 1588948.—Massie v. Fruit Growers Express Company. (District Court for the District of Delaware).—March 26, 1929.

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Difference in Proportion of Constituents: Manufacture of Natural Gasoline from Natural Gas: Validity.—Where the claims of Patent 1429175 were product claims and depended for validity on an increased amount of butane and a decreased amount of propane, and the discovery that butane could be left in the liquid mixture in greater quantities, if propane was more thoroughly eliminated from it, held: Claims invalid, the law being well settled that a mere difference in proportion of the constituents of a product is not patentable.—Carbide & Carbon Chemicals Corporation v. The Texas Company. (Circuit Court of Appeals for the Fifth Circuit.) March 26, 1929.

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## MARCH 27

Claims Broader than Invention: Taming of Natural Gas Gasoline: Validity.—All claims of Patents 1465598 and 1523314, for the taming of natural gas, reducing the volatility of raw natural gasoline to bring it within permissible limits for use, by the use of the rectifying column in lieu of the weathering process previously used, held: Invalid as being for nothing more than the application of an old process to a new subject, without exercise of invention or production of new result.—Carbide & Carbon Chemicals Corporation v. The Texas Company. (Circuit Court of Appeals for the Fifth Circuit.) March 27, 1929.

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## MARCH 28

Self-Serving Stores: Aggregations: Patentability.—Claims 6 to 10 covering specific store arrangement and specific cabinet structure with an elevated passage, held: Aggregative, there being no necessary or or mutual cooperation between those elements. Claim 9, however, including the walk way between the cases and the cases open at the front and rear found to include sufficient structure to define over the prior art. Patent 1704061.—Ex parte Saunders. (Board of Appeals of the Patent Office.) March 28, 1929.

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Self-Serving Store: Duplication of Turnstiles: Patentability.—Claim 2 calling for a double turnstile constituting a double unidirectional entrance to the sales section of theh store, held: Unpatentable, as being for mere duplication of parts over the prior art structures. Patent 1704061.—Ex parte Saunders. (Board of Appeals of the Patent Office.) March 28, 1929.

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Self-Serving Stores: Arrangement of Display Devices: Patentability.—The feature of using low display devices at the front and elevated display devices at the rear of the store, held: Uninventive. Patent 1704061.—Ex parte Saunders. (Board of Appeals of the Patent Office.) March 28, 1929.

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Self-Serving Stores: Patentability.—The feature of placing basket racks adjacent each entrance of a double turnstile gateway, held: Unpatentable, as being an obvious expedient. Patent 1704061.—Ex parte Saunders. (Board of Appeals of the Patent Office.) March 28, 1929.

Operativeness of Reference Structure: Patentability.—A reference structure readable upon the claim constitutes an anticipation although it may not be as effective in operation as the means disclosed by applicant. Patent 1704943, claim 1.—Ex parte Irving. (Board of Appeals of the Patent Office.) March 28, 1929.

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Combination of References: Thermostatically Controlled Power Actuated Means: Invention.—Where claims 2 to 8 related to temperature controlling apparatus for internal combustion engines, and the combination set forth is not found in the prior art in that no reference shows a single motor means controlled by a thermostat for controlling both the radiator air shutter and the valve for regulating flow of fluid to the radiator; and it would involve invention to add to the basic reference independent valve and shutter operators found in other patents, held: Claims allowable. Patent 1704943.—Ex parte Irving. (Board of Appeals of the Patent Office.) March 28, 1929.

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## MARCH 29

Claims: Narrow Construction in View of Prior Art: Garment Pressing Machines: Infringement.—Where the patent structures cover a garment pressing device wherein hand control means is employed to bring the pressing head into position with respect to the buck and when so positioned an electric circuit is closed to effect automatic operation o power means to effect the pressing operation; and devices of this nature were old in the art, and defendant's machine paralleled one of these prior art structures except as to the use of manual rather than power operating means, held: Infringement denied, the patents being rstricted to a very narrow range of equivalents. Claims 6, 10 and 41, Patent 1379601, and claims 4, 5, 6 and 15, Patent 1489227.—American Laundry Machinery Company et al. v. Prosperity Company, Inc. (Circuit Court of Appeals for the Second Circuit.) March 29, 1929.

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Identity of Result, Means, and Mode of Operation: Infringement.—Identity of result alone is not sufficient to support a charge of infringement, but there must be identity of means and of mode of operation as well. Claims 6, 10 and 41, Patent 1379601, and claims 4, 5, 6 and 15, Patent 1489227.—American Laundry Machinery Company et al. v. Prosperity Company, Inc. (Circuit Court of Appeals for the Second Circuit.) March 29, 1929.

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Carbureters: Patentability.—Where the claims covered a carbureter having as a novel feature a Venturi with fuel passages made particularly small so as to produc the necessary amount of suction to lift the fuel from the bottom of the tank to the carbureter, and also produce a suction many times the amount of this necessary suction to minimize the inaccuracies in the fuel feed due to the variations of liquid level in the supply tank, held: Claims allowable, as the novel feature was not suggested in the prior art. Claims 3 and 5, Patent 1705282.—Ex parte Brake. (Board of Appeals of thhe Patent Office.) March 29, 1929.

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## MARCH 30

Copied from Patent: Headlamp Replacement Unit: Claims.—Claim 12, copied from a patent, must be narrowly construed in view of the prior art and when so construed, held: Not readable on appellant's disclosure. Patent 1704028.—Ex parte Arbuckle et al. (Board of Appeals of the Patent Office.) March 30, 1929.

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Headlamp Replacement Unit: Single Means for Securing Parts Together: Patentability.—A claim for a replacement reflector unit wherein the feature of novelty, if any, resided in the use of a single mans for scuring the reflector, bulb and shield together, held: Unpatentable, as being an obvious conception. Claim 2, Patent 1704028.—Ex parte Arbuckle et al. (Board of Appeals of the Patent Office.) March 30, 1929.

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Carpet Sweeper with Brush Cleaning Device: Patentability.—Where claim 3, Patent 1706039 defines over the prior art in that the referencs do not show outwardly curved teeth struck from the opposite edges of theh strip and pointed alternately in opposite directions, one row of teeth collecting while the other row is

discharging the debris as the brush rotates in opposite directions, nor do they show teeth so arranged as to pass between the tufts of the brush, as claimed, held: Claim allowable, prior art showing the general organization but not the specific features mentioned.—Ex parte Owen. (Assistant Commissioner of Patents.) March 30, 1929.

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## APRIL 1

Grinding Machine: Combination of References: Patentability.—Claims 6 to 9, relating to a grinding machine and particularly to means for increasing the travel of the reciprocating carriage to carry the grinder past the dressing tool when desired, and including means for automatically reestablishing the normal reciprocating working traverse, held: Patentable over basic references takn in connection with prior art which was not adapted to modify the references to embody the claimed structure. Patent 1705114.—Ex parte Heald et al. (Board of Appeals of the Patent Office.) April 1, 1929.

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Packing Material: Patentability.—Where claims 16 to 23 covered packing material consisting of layers of fabric vulcanized to interposed layers of rubber, and appellants contend that this construction permitted relative movement between the fabric layers, held: Claims anticipated by prior patent showing alternate layers of fabric and rubber but containing no reference to this relative movement. Patent 1706031.—Ex parte Lamb et al. (Board of Appeals of the Patent Office.) April 1, 1929.

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Trolling Spoon: Patentability.—A trolling spoon having reversely cupped front and rear ends and a central body portion of diamond form, and depending for patentable novelty on the diamond shaped central portion, held: Patentable, since in a well-developed art patentability may consist of a slight difference in structure or curvature. Claims 1 to 3, Patent 1706906.—Ex parte Tucker. (Board of Appeals of the Patent Office.) April 1, 1929.

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## APRIL 2

Identity of Invention: Combination and Element Claims Not for Same Invention: Reissue.—Where the original patent covered a combination in which a check or seal was only one of several elements, and the reissue claims 10, 11, 17 and 18 were directed specifically to the check or seal, held: Claims disallowed as not being for same invention as that originally claimed. Reissue 17241.—Ex parte Martineau. (Board of Appeals of the Patent Office.) April 2, 1929.

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## APRIL 3

Yeast Compositions: Invention.—Where claims 3, 4, 5, 6, 8, 9, 10, 11, 12, 15 and 16, included "a comminuted and substantially dry composition consisting essentially of viable yeast particles substantially encapsulated in milk solids," whereas in the prior art gelatin and like substances is used to encapsulate the yeast particles, held: Claims allowable, a new result being obtained in that milk solids are especially adapted for this use, allowing desiccation of the mixture without injury to the yeast cells. Patent 1706564.—Ex parte Dawson. (Board of Appeals of the Patent Office).—April 3, 1929.

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Composition of Matter: Dry Yeast Composition: Invention.—Where the claims cover a composition consisting of a comminuted and substantially dry composition, essentially of yeast particles encapsulated by malt extract solids, and a prior patent lists malt as a suitable substance to mix with yeast to form a dry yeast composition, held: Claims anticipated. Claims 1, 2, 4, 5 and 9, Patent 1706566.—Ex parte Dawson. (Board of Appeals of the Patent Office).—April 3, 1929.

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Composition of Matter: Encapsulating Material: Invention.—Where malt extract solids as an encapsulating material for comminuted and substantially dry yeast composition were old in the art, and applicant added fruit juice to the malt

extract solids as an encapsulating material, held: Claims allowable. Claims 3, 6, 7 and 8, Patent 1706566.—Ex parte Dawson. (Board of Appeals of the Patent Office).—April 3, 1929.

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Yeast Mixtures and Methods of Preparing the Same: Invention.—Yeast compositions involving the use of fruit juices as the encapsulating material for the yeast particles instead of, or in addition to, milk solids, held: Patentable. Patent 1706565, 14 claims.—Ex parte Dawson. (Board of Appeals of the Patent Office).—April 3, 1929.

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## APRIL 4

Elimination of Element: Brush Machine: Invention.—Claims 8 and 9, covering a brush machine, and including as a limitation a tuft picking and transferring unit arranged to deposit directly a tuft in a passageway of a nozzle, whereas in the reference structure the unit delivered the tuft to the passageway indirectly, through an intermediate mechanism, held: Patentable. Patent 1706450.—Ex parte Jobst. (Board of Appeals of the Patent Office).—April 4, 1929.

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Devices Removable as a Unit: Brush Machines: Invention.—Claims 2 and 3, for a brush machine, containing the limitation that the tuft-setting devices were removable as a unit, held: Patentable. Patent 1706450.—Ex parte Jobst. (Board of Appeals of the Patent Office).—April 4, 1929.

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## APRIL 6

Combination of References: Brush-making Machine: Patentability.—Claims 1 to 4 for a brush-making machine, including the feature of interchangeable holders for the brush backs, each adapted to receive several blanks, thereby providing a construction capable of gang operation, denied in view of a plurality of references, held: Not anticipated, where it was not obvious how the structure of the basic patent could be modified by the teachings of another patent to produce the structure of the appealed claims. Patent 1706451.—Ex parte Jobst. (Board of Appeals of the Patent Office).—April 6, 1929.

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New Matter: Brush-making Machine: Patentability.—Claim 3, covering a brush-making machine and including means for automatically stopping a certain movement at a given time in the operation of the apparatus, where the original specification states that the machine is stopped at a certain time but does not state whether this action is effected automatically or manually, held: Rejection proper, new matter being involved. Patent 1706451.—Ex parte Jobst. (Board of Appeals of the Patent Office).—April 6, 1929.

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Aggregation: Use of Aggregative Device in a System: Laundry Truck: Patentability.—Where the claims were directed to the laundry truck only but appellant stressed the point that the truck was found to consist of a convenient association of several independent features and not a true combination in a patentable sense, held: Claims unpatentable, the particular way or system in which the composite apparatus was used around the laundry not determining patentability. Patent 1706690.—Ex parte Boyuls. (Board of Appeals of the Patent Office).—April 6, 1929.

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Rejection of Claims on Copending Patent: Safety Sheave Blocks: Patentability.—Where appellant's copending patent shows and claims a safety sheave block, including a construction in which one of the guard plates is fixed and the other is adjustable laterally to provide space for the insertion of a cable, while in the present application ballguard plates are fixed or permanently secured and are spaced apart sufficiently to permit passage of the cable, held: Appellant's copending patent constitutes an anticipation; since there must be a patentable difference between the claims of appellant's two cases even though the record application was filed as the result of a requirement of division. Claims 13 to 17. Patent 1707560.—Ex parte McKissick. (Board of Appeals of the Patent Office).—April 6, 1929.

Substitution of Material: Wire Gauze for Paper-making Machines: Invention.—Where the prior art disclosed a wire fabric formed of brass reinforced by an excess of warp wires, and appellant claimed a wire gauze made by using the more easily bendable weft wires of old material in conjunction with the steel warp wires thereby forming a smooth screen and yet one having marked improvements over prior art screens in wearing properties, held: Claim patentable, the substitution of steel for brass producing a new result. Patent 1707757.—Ex parte Elsenhans. (Board of Appeals of the Patent Office).—April 6, 1929.

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## APRIL 8

Claims for Combination of Old Elements: Validity.—A combination claim may involve invention even if every element is old, provided a new result is accomplished, or an old result reached by a new and better way. Patent 1522344 held valid.—Kendall, etc., v. Trico Products Corp. (Circuit Court of Appeals for the Sixth Circuit).—April 8, 1926.

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Aggregations: Windshield Cleaners: Validity.—Where the claims relate to a unitary machine for windshield cleaning consisting of a rock shaft journaled in a casing, a wiper carried by the rock shaft, and a swinging operating member within said casing rigid with said shaft and adapted to receive direct applications of fluid pressure for rocking said shaft to operate said wiper, held: Claims valid, not being for aggregations, and being for a new combination of elements coacting to produce a new and useful result. Patent 1522344.—Kendall, etc., v. Trico Products Corp. (Circuit Court of Appeals for the Sixth Circuit).—April 8, 1929.

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Motion to Set Aside Preliminary Injunction: Infringement.—Where motion to set aside preliminary injunction granted to enjoin infringement of patent pending the determination of another suit was denied, and the affidavit accompanying the motion did not present proof beyond a reasonable doubt that the patent was anticipated, held: Motion properly denied, the refusal to grant preliminary injunction not being clearly an improvident exercise of discretion. Patent 1522344.—Kendall, etc., v. Trico Products Corp. (Circuit Court of Appeals for the Sixth Circuit, 1929).—April 8, 1929.

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Windshield Cleaners: Infringement.—Where defendant's device was similar in structure, method of assembly and appearance to the patented construction, held: Patent infringed. Patent 1522344.—Kendall, etc., v. Trico Products Corp. (Circuit Court of Appeals for the Sixth Circuit).—April 8, 1929.

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## APRIL 9

Remedy in Equity: Section 4915, R. S.: Jurisdiction of Bill by Patentees: Applications and Proceedings Thereon.—A patentee does not come within the provisions of Section 4915 of the Revised Statutes, granting equitable relief to an applicant for a patent, for the reason that the statute clearly provides that it is only "whenever a patent on application is refused" that resort to remedy by bill in equity in a District Court is authorized and that only the applicant may have recourse to such remedy.—MacGregor v. Chesterfield. (District Court for the Eastern District of Michigan.) April 9, 1929.

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## APRIL 10

Method of Fractional Distillation of oil consisting in circulation the oil through a closed system including a storage tank and a heating device, and based on the feature of so regulating the heater and the velocity of oil travel as to raise the temperature of the oil gradually without heating it to a cracking temperature, held: Anticipated by prior patents. Claims 1, 2. Patent 1707369, Patentability.—Ex parte Primrose. (Board of Appeals of the Patent Office).—April 10, 1929.

## APRIL 15

References: Sufficiency of: Patentability.—A reference possessing the inherent capability of operating in the manner in which the device set forth in the applicant's claim operates constitutes a good reference even though it does not describe that capability of operation. Claim 22, Patent 1707649. Claims 23 and 24 allowed over references, claims 22, 25, 26 and 28 denied.—Ex parte Weiner. (Board of Appeals of the Patent Office). April 15, 1929.

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Change in Size and Different Use: Abrasive Stones: Patentability.—Claims 1 and 2, covering thin weak strips of abrading material reinforced by a channel shaped metallic strip along one edge and adapted for use as a hand tool to operate between contact points of automobile ignition systems, held: Patentable over prior art disclosing channel shaped holders for blocks of abrading material, and for felt, mounted in supports for use in machines.—Patent 1707472.—Ex parte Dresser. (Board of Appeals of the Patent Office). April 15, 1929.

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Allowed Claim as Prior Art: Patentability.—Where claim 4 specified that the neck portion of the vacuum cleaner leads "from the suction chamber to the inlet opening of the fan chamber," whereas allowed claim 1 stated that the neck leads "from the suction chamber to the fan chamber," held: Claim unpatentable. Patent 1708282.—Ex parte Serva. (Board of Appeals of the Patent Office). April 15, 1929.

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Rejection of One Claim Upon Another: Patentability.—Where one claim differed from an allowed claim only in specifying that the vacuum cleaner was provided with a neck havin ga tapered throat at the entrance thereof, held: Claim unpatentable. Patent 1708282.—Ex parte Serva. (Board of Appeals of the Patent Office). April 15, 1929.

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## APRIL 17

Shoe Machines: Fold Presser: Infringement.—Patent No. 1527395, relating to a fold presser for the folding machine, comprising a curvilinearly faced hammer that is adopted by reason of having an extension toe initially to pinch the edge of the fold and then to roll over upon the fold, ironing it out smoothly, held: Infringed by defendant's fold presser, which was found by experiment to be a mechanical equivalent, Claim 72.—Beacon Folding Machine Company v. Rotary Machine Company et al. (Circuit Court of Appeals for the First Circuit). April 17, 1929.

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Shoe Machines: Wiper Strip: Infringement.—Patent No. 1527396, relating to a shoe machine having a wiper strip consisting of an oscillating finger acting to move the unsecured edge of the strip across the secured-together edge into substantially the plane of the sheet, held: Not infringed by defendant's structure in which no wiper strip was employed and the corresponding means defendant did employ was not a mechanical equivalent. Patent 1589718 also found not infringed.—Beacon Folding Machine Company v. Rotary Machine Company et al. (Circuit Court of Appeals for the First Circuit). April 17, 1929.

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Demountable Wheel Rims for Automobiles: Claims Pending Broadly on Structure: Infringement.—Where appellee's demountable wheel rims for automobiles did not include the feature of novelty upon which claims 1, 2, 6, 8 and 9 of appellant's patent No. 1095775 were based though the claims in scope appeared to read broadly upon defendant's structure, yet in order to save them from invalidity under the prior art it was necessary to read the patent limitations into them, held: Claims not infringed.—Universal Rim Company v. Motor Rim & Wheel Corporation. (Circuit Court of Appeals for the Seventh Circuit). April 17, 1929.

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## APRIL 18

Discovery of Cause of Defect and Applying Known Remedy: Invention.—Where the prior art disclosed a method of treating the fabric to be used in making rubber tires for automobiles with an alkali solution to prevent deterioration due to oxidiza-

tion of the sulphur contained in the rubber, and appellant applied an alkali solution to the rinse water of laundered cloths to prevent deterioration of the garments while on the line to dry due to the settling of sulphur contained in the air, held: Appellant's claims patentable, since invention may exist in the discovery of the cause of a defect in the existing machine or process and applying a remedy therefor even though, after the cause is understood, the remedy would be obvious. Claims 3 to 6, patent 1708519 Ex parte Phair. (Board of Appeals of the Patent Office). April 18, 1929.

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Rejection: Idle Limitation in Claim: Applications.—Where claim 5 included the expression "driving gearing between said motor and drum including driving pinions at opposite ends of one of said rotors,," and nothing was stated as having cooperative relation with said pinions, held: Claim unpatentable, the limitation to driving pinions at opposite ends of the rotor being an idle limitation. Patent 1708188.—Ex parte Osgood. (Board of Appeals of the Patent Office). April 18, 1929.

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Rejection: Prior Patent as "Literal Anticipation:" Applications.—Where the prior patent was very different in structure and method of operation from appellant's claimed structure, but was readable upon the claim, held: Claim rejected, the reference constituting an "absolute literal anticipation." Claims 15, 16 and 17, Patent 1708188. —Ex parte Osgood. (Board of Appeals of the Patent Office). April 18, 1929.

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Rejection: Claims Indefinite: Applications.—Where claim 11 specified "means whereby power is delivered, * * * means for causing transmission of power, * * * and means for imparting the power," and included as the limiting feature the statement that "said power transmission and imparting means includes gears carried on each end of said casing and movable relation thereto," held: Claim unpatentable, as not meeting the requirements of Section 4888 R. S. Claims 9 and 12 to 14 also rejected. Patent 1708188.—Ex parte Osgood. (Board of Appeals of the Patent Office). April 18, 1929.

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## APRIL 19

Remedy in Equity: Process Against Commissioner of Patents: Suits Brought in District Other than Place of Officials Residence: Section 51 of Judicial Code: Applications and Proceedings Thereon.—Where suits in equity were brought in the District Court for the District of Maryland under Section 4915 of Revised Statutes (44 Stat. 1335) against Commissioner of Patents to compel him to issue certain letters patent, which he, in an ex parte proceeding in the Patent Office, had refused to issue; and the Commissioner, although maintaining his private residence within the jurisdiction, refused to accept service of subpoenas there, claiming that he can be sued only in the District of Columbia, his official residence, held: Motions to dismiss suits granted, because, under Section 51 of Judicial Code (28 U. S. C. 112a), such suits may not be brought against the Commissioner, without his consent, except at the place of his official residence, the District of Columbia, be being located by law at the Patent Office at such place.—Canon et al. v. Robertson, Commissioner, etc. (District Court for the District of Maryland). April 19, 1929.

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Rejection of Claims: Alternative Expression: Application.—The expression "at least partially" is not such as to render a claim alternative. Claim 5, Patent 1708677. —Ex parte Maxson. (Board of Appeals of the Patent Office). April 19, 1929.

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Rejection of Claims: Means Reciting Characteristic of Another Means: Application.—Claim 1, calling for a final means which was not a structure separable from the previously recited means but was merely a characteristic of such means, held: Claim disallowed. Patent 1708677.—Ex parte Maxson. (Board of Appeals of the Patent Office). April 19, 1929.

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Rejection: Combination of References: Application.—Where a rejection on a combination of references involves such changes in the construction of the basic references involves such changes in the construction of the basic reference as would amount practically to a reorganization thereof with a mode of operation not con-

templated or suggested by such reference, held: Rejection reversed. Claims 1, 5, 11, 12 and 13, Patent 1708677.—Ex parte Maxson. (Board of Appeals of the Patent Office). April 19, 1929.

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## APRIL 20

Combination of References: System for Purifying Oil: Invention.—Where appellant's system for purifying oil consisted of a suction device to remove the oil from the cylinders to the rectifier and means for pumping the purified oil back into the crank case, and the basic patents showed similar devices except for the means for returning the oil to the crank case and this means was present in another patent, held: Rejection of claims sustained. Claims 1 to 7, Patent 1708283. Claim 8 allowed. —Ex parte Skinner. (Board of Appeals of the Patent Office). April 20, 1929.

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Collar Sweaters: Integral Part of Sweater: Validity.—Where claims 1 and 3, Patent 1003155, included a sweater having as an integral part of it a collar adapted to be folded within the neck portion or in an upright position so as to cover and protect the neck, and means to hold the collar in position, whereas the prior art covered auxiliary collars that were not integral parts of the sweater itself, held: Claims valid.—Simon v. Clinton Knitting Company, Inc. (District Court for the Northern District of New York). April 20, 1929.

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Collar Sweaters: Manner of Sewing: Infringement.—The patent sweater, provided with a collar made integrally with it and adapted to fold within the neck portion or to unfold into an upright position around the neck and having means to hold it in each position, held: Infringed by defendant's garment involving the same inventive idea but in which there were some variations in manner of sewing the collar to the garment. Claims 1 and 3, Patent 1003155.—Simon v. Clinton Knitting Company, Inc. (District Court for the Northern District of New York). April 20, 1929.

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## APRIL 22

Application of German Inventors: Time for Filing: Application Filed Within Six Months of Adoption of Treaty of Berlin, But After Expiration of Limit Prescribed by Nolan Act and Section 4887, R. S.: Remedy in Equity: Applications.—Where application for letters patent was filed in this country more than 12 months after filing application in Germany, the time limitation prescribed by Section 4887 of Revised Statutes (35 U. S. C. 32), and after expiration of time limited by Nolan Act of March 3, 1921 (41 Stat. 1313), but within six months of adoption of Treaty of Berlin (42 Stat. 1939); and applicants, in suit in equity under Section 4915 of Revised Statutes (35 U. S. C. 63), contended that effect of Treaty, adopting by reference Section 308 of Versailles Treaty, relating to priority rights of foreign inventors, was to extend time for filing application for six months after its effective date, held: Decree directing issuance of letters patent reversed, because Treaty of Berlin should not be construed as providing priority rights of German and American inventors should be again extended after their rights had already been protected in accordance with Section 308 of Versailles Treaty by Nolan Act and reciprocal decree of Germany, and because, even if Treaty of Berlin be so construed, such construction must rest upon adoption by that Treaty of Section 308 of Versailles Treaty, which is not self-effectuating, and no supporting legislation has been enacted in aid thereof.—Robertson, etc., v. General Electric Co. et al. (Circuit Court of Appeals for the Fourth Circuit). April 22, 1929.

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Treaties: Self-executing Provisions: Provisions Relating to Patents.—Provisions in treaties with the United States relating to patents, unless a contrary intention is clearly indicated, should be construed, not as of themselves making changes in domestic patent laws, but as contemplating that the parties signatory will enact appropriate legislation and promulgate proper rules to effectuate the ends which they are designed to accomplish.—Robertson, etc., v. General Electric Co. et al. (Circuit Court of Appeals for the Fourth Circuit). April 22, 1929.

## APRIL 23

Joinder of Parties Plaintiff: Constructive Trust Relationship: Infringement.—A constructive trust in property may be enforced by one prejudiced or deprived of a benefit by fraud or a breach of trust on the part of another who occupies a fiduciary relation with respect to such property and thereby gains an advantage for himself.—The Moto Meter Company, Inc., et al. v. National Gauge & Equipment Company. (District Court for the District of Delaware). April 23, 1929.

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Motion to Dismiss: Joinder of Parties Plaintiff: Infringement.—Where the Moto Meter Company, having a community of interest with Boyce and Leander Corporation, acquired the capital stock of the infringing defendant and then declined to join in as party plaintiff in a suit for infringemet; and Boyce and the Leander Corporation brought suit and joined The Moto Meter Company as coplaintiff. held: Defendant's motion to dismiss denied, the joinder of parties plaintiff being proper.—The Motor Meter Company, Inc., et al. v. National Gauge & Equipment Company. (District Court for the District of Delaware). April 23, 1929.

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Joinder of Parties Plaintiff: Infringement.—A license may be permitted to make the patent owner a coplaintiff, even against his will, in a suit to enjoin infringement. —The Moto Meter Company, Inc., et al. v. National Gauge & Equipment Company. (District Court for the District of Delaware). April 23, 1929.

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Combination of References: Patentability.—Where claim 2 was rejected as being merely for an aggregation of features selected from four different references but it was not stated which of the patents would be taken as the basic reference, nor how it could be modified by introduction of prior art devices to produce the structure called for in the claim, held: Claim patentable. Patent 1708471.—Ex parte Farnsworth. (Board of Appeals of the Patent Office). April 23, 1929.

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Combination of References: Apparatus for Handling Fluids: Patentability.—Claim 1 differing from the basic reference in that it called for the supply and discharge of water from the bottom of the compartments and for the use of a four-way valve, held: Unpatentable in view of other patents disclosing those features.—Patent 1708471.—Ex parte Farnsworth. (Board of Appeals of the Patent Office). April 23, 1929.

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## APRIL 24

Truck Bodies: Combination of References: Patentability.—Where claim 5 covered a truck body and called for stakes supporting extension side boards and a special means for supporting the stakes, in addition to matter found in the basic reference, and the additional limitations were not clearly shown in the supplemental reference, held: Claim allowable. Patent 1708639.—Ex parte Styslinger. (Board of Appeals of the Patent Office). April 24, 1929.

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Applications: Claims: Structure claims purporting to cover the structure but purported to cover method of making the structure by implied limitations such as "arranged to receive;" and the distinction between appellant's structure and that of the patent resided in the procedure, held: Claims anticipated, since claims for a structure should define the invention by a recitation of structural features rather than by limitations as to procedure. Claims 1 to 4, Patent 1708639.—Ex parte Styslinger. (Board of Appeals of the Patent Office). April 24, 1929.

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Claims: Change in Material: Applications.—Claim 6, limited to a non metallic body carried by the truck frame, held: Unpatentable, mere change in material not being a patentable feature. Patent 1708639.—Ex parte Styslinger. (Board of Appeals of the Patent Office). April 24, 1929.

Ash Tray and Receptacle: Change in Material Involving Invention: Validity.—Where the patent ash stand consisted of an ash tray supported on the upper end of a tube, a waste receptacle at the bottom of the tube, a skirt surrounding the receptacle and forming a cavity to receive it; and the stand differed from prior art stands in that the receptacle was made of glass, whereby ready inspection was facilitated, saving time and labor, held: Patent valid. Patent 1646086.—Smokador Manufacturing Company, Inc., v. Tubular Products Company. (Circuit Court of Appeals for the Second Circuit). April 24, 1929.

## APRIL 25

Filing of Disclaimers: Procedure.—When the question of the validity of the patent has passed through all the courts then available, some of the claims being held valid, others invalid, a disclaimer should be required to be filed as to the invalid claims as a condition to proceeding upon the valid claims.—R. Hoe & Co., Inc., et al. v. Goss Printing Press Company. (Circuit Court of Appeals for the Second Circuit.) April 25, 1929.

## APRIL 26

Method of Making Insulator Caps: Invention.—Four claims, including method of making an insulator cap or the like from a blank, which includes forging a cup and simultaneously extruding laterally spaced ear lugs on the bottom thereof, held: Unpatentable, there being nothing novel in the idea of shaping a mold to the form of the article to be produced nor in forming pockets in such mold into which the metal may be extruded in the forging operation. Patent 1709328.—Ex parte Stover. (First Assistant Commissioner of Patents.) April 26, 1929.

Aggregation: Hosiery Finishing Apparatus: Patentability.—Where the claimed structure comprised elements, each supporting and supplementing the others, which, though they do not operate simultaneously, are associated in a unitary device; and the claims stood rejected as being aggregations on the ground that each element functioned independently and without reference to the others, held: Claims allowable. Claims 1, 3, 5 and 6, Patent 1709397. Claims 2, 4, 7, 8, 9 and 10 held unpatentable over the allowed claims.—Ex parte Gray. (Board of Appeals of the Patent Office.) April 26, 1929.

## APRIL 27

Detachable Wear Plate for a Machine: Invention.—Claim 21, directed to an attachment to be used in connection with yarn tensioning mechanisms, and containing as a limitation the use of a detachable wear plate on that part of the machine subject to wear where the yarn drags over it, held: Unpatentable. Patent 1708514.—Ex parte McKean. (Board of Appeals of the Patent Office.) April 27, 1929.

Yarn Tension Devices: Invention.—Claims 22 and 23, directed to yarn tension devices and including as a limitation an element associated with the plate and adapted to keep the yarn from threading beneath the plate, held: Patentable. Patent 1708514.—Ex parte McKean. (Board of Appeals of the Patent Office.) April 27, 1929.

## APRIL 29

Motion to Recall and Amend Mandate: Infringement: Extent.—Where the defendant's neon lamp was found to be an infringement of Patent 1125476, which specified that the area of electrode must exceed 1.5 square decimeters per ampere as the rule of relationship, but no ruling was made as to the caesium lamp having an area of 0.7 per ampere, the opinion stating merely that caesium plays a part which is equivalent to additional surface area of the electrodes; and plaintiff now brings motion to have mandate amended to include the caesium lamp as an infringing device, held: Motion denied, since any infringement procedure must be by supplemental bill or by independent suit.—Claude Neon Lights, Inc., v. E. Machlett & Son. (Circuit Court of Appeals for the Second Circuit.) April 29, 1929.

Toilet Seat: Validity.—Where Patent 1273703 covered a toilet seat composed of laminated wood core with a covering of hard rubber vulcanized on the core and united thereon throughout its entire surface, which possessed advantages over prior art sets in that it had no crevices, the outer surfaces being free from germ impregnation; and the prior art showed a seat made of wood with rubber vulcanized thereto under high pressure, and with portions of the wood exposed, held: Patent valid.—Brunswick-Balke-Collender Company v. The Seamless Rubber Company. (Circuit Court of Appeals for the Second Circuit.) April 29, 1929.

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Toilet Seat: Infringement.—The appellee's toilet seat having each of the elements of the patent claim, comprising a plurality of cross grained layers of wood veneer thoroughly dried, and a roughened pubescent surface with the layers of wood in the core cemented together, held: Patent infringed. Patent 1273703.—Brunswick-Balke-Collender Company v. The Seamless Rubber Company, Inc. (Circuit Court of Appeals for the Second Circuit.) April 29, 1929.

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Inoperative Disclosure: Indicating Systems: Patentability.—Where the original case did not completely disclose the signaling systems claimed by the appellant and the examiner rejected the claims as being drawn to an inoperative disclosure, holding that it did not contain a sufficiently clear statement of the operation of the system whereby the structure of the impulse when used in the system could be inferred, held: Claims allowed, it being within the skill of the worker in the art to fulfill desired stated requirements. Four claims, Patent 1709067.—Ex parte Field. (Board of Appeals of the Patent Office.) April 29, 1929.

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## APRIL 30

Alleged Indefiniteness in Claims: Applications.—The rejection of certain claims as being indefinite in the use of the word "normally," held: Reversed, the claims being readily understood when read in the light of appellant's disclosure. Patent 1709083.—Ex parte Littlefield. (Board of Appeals of the Patent Office.) April 30, 1929.

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Claims Not Clearly Defining Invention: Applications.—Where the claims are drawn to a protective system and the primary purpose of the structure is to control the operation of the device, the socalled protective feature being only incidental, held: Claims do not properly define the invention. Claims 5, 9, 10, 11, 12, 14, 18, 20 and 23. Patent 1709083.—Ex parte Littlefield. (Board of Appeals of the Patent Office.) April 30, 1929.

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Claims Misdescriptive: Electrical Control Apparatus: Applications.—Claims stating that a predetermined voltage is maintained in the secondary, whereas it is not apparent that the voltage is maintained constant or given any particular predetermined value, held: Misdescriptive. Claims 5, 9, 11, 12, 14, 18, 20 and 23. Patent 1709083.—Ex parte Littlefield. (Board of Appeals of the Patent Office.) April 30, 1929.

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Combination of References: Electrical Controlling Apparatus: Patentability.—Rejection of claims 4, 5, 9, 10, 11, 14, 18, 20 and 23 on a combination of references showing the various features in appellant's electrical system, held: Sustained. Patent 1709083.—Ex parte. Littlefield. (Board of Appeals of the Patent Office.) April 30, 1929.

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Substitution of Materials: Expansion Joints for Paving: Invention.—Where claims 3 and 4 covered a performed bituminous expansion joint strip reinforced by relatively thin side surfacing sheets of asbestos, and the prior patent showed an asphaltic composition provided with side surfacing sheets of elastic fibrous felt, held: Claims anticipated, there being nothing inventive involved in substituting for the relatively thin side surfacing sheets of fibrous material sheets of asbestos material which was well known to possess the properties desired. Patent 1709692.—Ex parte Swope et al. (Board of Appeals of the Patent Office.) April 30, 1929.

Omission of Step in Process: Combination of References: Patentability.—Where appellants omitted a purification step from their process of forming cellulose products which may be used in the manufacture of artificial silk, which process was found in a prior patent; and another reference showed it was usual to omit the purification step, held: Appellants' claims unpatentable. Claims 1 to 3, Patent 1709513. Claims 3 and 4, being more limited, were allowed.—Ex parte Bassett et al. (Board of Appeals of the Patent Office.) April 30, 1929.

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## MAY 1

Time Element as Basis for Novelty: Method of Forming Bearings: Infringement.—Where the centrifugal casting of babbitt metal lining upon bronze, with soldering tin between, was old, but appellant claimed its process was novel because casting was effected in about three seconds, well within the period of six seconds which was alleged to be the period of dangerous oxidization of the tin, and evidence showed defendant's babbitt was applied about 18 seconds after application of the soldering tin, held: Defendant's process did not infringe. Patent 1302584.—American Bearing Corporation v. Milwaukee Die Casting Company. (Circuit Court of Appeals for the Seventh Circuit). May 1, 1929.

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## MAY 2

Hand Operated Can Opener: Infringement.—Where defendants' can opener is designed and can be successfully used only to cut out the top of a can in much the same manner as prior art devices are used, and the patent claims depend for validity upon those features which adapt the device to perform a different function, to remove the tops of cans by cutting through the wall of the can below the flange of the top, held: Patent not infringed. Patent 1360256.—Star Can Opener Company v. Bunker-Clancey Manufacturing Company et al. (District Court for the Western District of Missouri). May 2, 1929.

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Refrigerating Apparatus: Disclaimers: Scope of.—A disclaimer entered in claims 10 and 15, Patent 1337175, for refrigerating apparatus, specifying that ⅜ inch copper tubing or copper tubing of less than ½ inch in diameter be used, a limitation not considered and passed upon by the Patent Office during prosecution of the application, held: Disclaimer sustained in view of rule established in Permutit Company v. Wadham, 13 F. (2d) 454.—Frigidaire Corporation v. General Necessities Corporation. (District Court for the Eastern District of Michigan). May 2, 1929.

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Refrigerating Apparatus: Validity.—Claims 10, 15, 16 and 18 of Patent No. 1337175, relating to a refrigerating apparatus comprising the use of a refrigerating coil, a condensing coil and a compressor which draws gases from the refrigerating coil and compresses them, after which they are cooled to form a liquid in the condensing coil; and distinguishing from prior devices in using means to cool the condensor coil by air rather than by passing water over the coils, held: Invalid, air cooling being old per se and old in the combination.—Frigidaire Corporation v. General Necessities Corporation. (District Court for the Eastern District of Michigan). May 2, 1929.

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Powder Box: Arrangement of Lining: Patentability.—The arrangement of lining in a powder box, the lining covering the bottom and sides of the box, and not extending over the top, as in the references, with the advantage that fracture of the lining is not necessary to gain access to the powder; and the bent-over lips for holding the lining in place not being found in the references, held: Claim covering the device patentable. Patent 1709840.—Ex parte Compton. (Board of Appeals of the Patent Office). May 2, 1929.

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## MAY 3

Claims: Patentably Different: Applications.—Where claim 6 covering a weir meter, differs from claim 5 in adding "the valve M with a passage which when the valve

is open, does not obstruct the thoroughfare," held: Claims patentably distinct. Patent 1710474.—Ex parte Dodd. (Board of Appeals of the Patent Office). May 3, 1929.

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Claims: Patentably Different; Applications.—In specifying that the "passageway" of claim 1, directed to a weir water meter, be a "deep, narrow passageway," held: Claim 2 patentably defined thereover. Claims 4 and 7, containing further limitations, were also allowed. Patent 1710474.—Ex parte Dodd. (Board of Appeals of the Patent Office). May 3, 1929.

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Claims: Misleading: Applications.—Where the specification stated that the valve opening "may well be 3 or 4 inches in diameter," and the claim, covering the weir meter, stated that a valve contained therein was of "substantial vertical depth and width." held: Rejection of claim as being misleading overruled. Claims 5 and 6, Patent 1710474.—Ex parte Dodd. (Board of Appeals of the Patent Office). May 3, 1929.

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Steaming Tube for Hair-waving: Validity.—A steaming tube for hair-waving consisting of sheets of white paper and a sheet of metal foil rolled into a little tube with foil projecting beyond the paper at the ends, which in use is slipped over a strand of hair which has previously been wound around a rod in corkscrew fashion and wrapped about with a flannel wetted in a certain chemical solution, and the assembly inserted in an electric heater for which the article is adapted, held: Invalid in view of prior art.—The LeMur Company v. W. G. Shelton Company. (Circuit Court of Appeals for the Eighth Circuit). May 3, 1929.

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Unfair Competition: Steaming Tube for Hair-waving: Infringement.—Where defendant used an article much the same as that of plaintiff's patented article, and the instructions for using the article were substantially the same, but defendant marked its goods with its own name plainly, wrapped them in colored paper and put special and conspicuously different markings thereon, held: Suit dismissed as to unfair competition, the patented article having been held invalid.—The LeMur Company v. W. G. Shelton Company. (Circuit Court of Appeals for the Eighth Circuit). May 3, 1929.

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Machines for Folding Edges of Shoe Uppers: Infringement.—Where demonstrations at rehearing proved that the curved notches in the disc of defendant's device for folding edges of shoe uppers did not press the fold at its edge and therefore did not include a means corresponding to the toe in the patent structure which was designed to pinch the edge of the fold and hold it during the rolling operation, held: Patent not infringed. Patent 1527395. (Decision of March 16, 1929, (IV U. S. Daily, 338) modified).—Beacon Folding Machine Company v. Rotary Machine Company et al. (Circuit Court of Appeals for the First Circuit). May 3, 1929.

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## MAY 4

Suits in Equity: Counterclaim: Independent and Unrelated Cause of Action: Infringement.—A counterclaim in a suit for infringement of patent, brought in a district of which the complainant is not an inhabitant and in which he has no regular and established place of business, is not limited to the subject matter of the bill and matters connected therewith, since the complainant consents to being sued therein on a counterclaim based on an independent and unrelated cause of action, as for infringement of another patent.—Pengilly v. Koolfast Radiator Company. (District Court for the Northern District of Ohio). May 4, 1929.

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Counterclaim: Different Cause of Action: Motion to Strike: Infringement.—Where plaintiff brought infringement suit on patent for "A lighter for cigarettes and the like," and defendant set up in counterclaim another patent covering "Certain new and useful improvements in cigar lighters," claiming infringement by plaintiff, held: Motion to strike counterclaim denied, since plaintiff, in bringing suit in a district in which he is not an inhabitant, consents to be sued by counterclaim on an independent and unrelated cause of action.—Pengilly v. Koolfast Radiator Company. (District Court for the Northern District of Ohio). May 4, 1929.

## MAY 7

Brooms: Arrangement of Stitching: Patentability.—The claims for a broom having as their novel feature an arrangement of stitching such that the stitches were more compacted and closer together at the margins of the brush head than is the case in conventional practice, and farther apart in the intermediate portion, held: Patentable, this arrangement not being present in the references. Patent 1711433.—Ex parte Thomson. (Board of Appeals of the Patent Office). May 7, 1929.

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Seizure by Alien Property Custodian: Conveyance to and by Chemical Foundation, Inc.: Title and Conveyances.—Defendant's contention that plaintiff did not show good title to the patent due to the fact it had been seized by the Alien Property Custodian and conveyed by him to the Chemical Foundation, Inc., and that under the trust provision of the charter of the Chemical Foundation, Inc., there was no power to convey any interest in the patent to the plaintiff, held: Overruled, due to lack of evidence. Patent 1180264.—Westinghouse Lamp Company v. C. E. Manufacturing Company, Inc. (District Court for the District of Rhode Island). May 7, 1929.

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Thoriated Tungsten Filaments for Lamps: Infringements.—Where the patent covered a filament made for incandescent lamps and thorium was added to the tungsten in small percentages for the purpose of retarding or preventing offsetting and burning out of the tungsten due to the current and heat incident to the use of the lamp for lighting purposes, the filaments being made from paste forced through a die, the only method of filament making known at the time; and defendant employed tungsten filament made of drawn wire, containing a small, but scientifically exact, quantity of thorium, and the filament was used in radio tubes which were operated on a current sufficient only to produce electronic emission, with the result that the mechanical problem due to offsetting was not present, held: Infringement not shown. Patent 1180264.—Westinghouse Lamp Company v. C. E. Manufacturing Company, Inc. (District Court for the District of Rhode Island). May 7, 1929.

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## MAY 9

Aggregations: Undergarment: Patentability.—Where claim 1 included as elements an undergarment provided with the usual front and rear closures, and a pair of shoulder straps, without specifying any cooperative relation between the straps and closures, held: Claim aggregative.—Patent 1711362.—Ex parte Neilson. (Board of Appeals of the Patent Office). May 9, 1929.

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Union Suits for Men: Patentability.—Claim 6, relating to special means employed for adjusting the shoulder straps for the union suits, held: Patentably differentiated from the prior art. Patent 1711362.—Ex parte Neilson. (Board of Appeals of the Patent Office). May 9, 1929.

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Aggregation: Men's Union Suits: Patentability.—Claims 2 and 3, covering men's union suits provided with the usual front and rear closures, and having as a novel feature shoulder straps so designed as to function not only as supports for the garment but as means to effect closing of the openings, rejected by examiner as being aggregations, held: Claims patentable, there being cooperative relation between the straps and the closures. Patent 1711362.—Ex parte Neilson. (Board of Appeals of the Patent Office). May 9, 1929.

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## MAY 10

Validity: Panels for Radio Dial: Designs.—A design for a panel for a radio dial including a circular plate with a central opening for the condenser shaft, an opening through the top through which to read the dial, and a lower knob for purposes of operating the vernier, the surface of the panel being milled or cross-hatched, except at the periphery and around the openings, held: Patent invalid, the

mechanical parts being functional, and the design part, that relating to general outline and form of the panel and its surface finish, not being beyond the skill of journeyman designers. Design Patent 68828.—Martin Copeland Company v. Pilot Electric Company et al. (Circuit Court of Appeals for the Second Circuit). May 10, 1929.

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## MAY 13

Poultry Packing: Methods of Packing: Angle of Position: Validity.—Claims for an article consisting of packed poultry and for a method of packing poultry and including "as an article of commerce, a package comprising a container containing a plurality of birds in sitting position placed in opposite rows, thereby providing a free open space between two rows of birds, the tail ends of the sitting birds in engagement with the bottom of the container, and the neck ends in engagement with the top of the container, parts of said birds being placed in engagement whereby the birds will be maintained in sitting position," the pith of the invention being stated to reside in the angle at which the birds are held in position, held: Invalid, since mere change in position amounting to mere change in degree does not in general constitute invention. Patent No. 1516012.—George F. Hinrichs, Inc., v. Henderson et al. (Circuit Court of Appeals for the Eighth Circuit). May 13, 1929.

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## MAY 17

Cooling and Dispensing Cabinets: Patentability.—Where claims 9 of Patent 1711581, relating to apparatus for cooling bottles of beverage during delivery, covering U-shaped passageways so arranged that the bottles are placed in one of the upper branches of the U and withdrawn from the other branch in a dry condition; and the prior art disclosed a single passageway provided with holes whereby the infrigerant entered the compartment with the bottles, held: Claims anticipated, there being no invention involved in duplicating the passageways nor in stopping up the holes to keep the refrigerant outside the passageways.—Ex parte Bixler. (Board of Appeals of the Patent Office). May 17, 1929.

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## MAY 18

Dials for Panel Board in Radio Set: Infringement.—Where the defendant's dial included a composite member, made up of the knob, washer, cover, disk and scale, which system did not include the dial shaft and was complete without it, and in the patent device the dial when taken from the shaft fell to pieces and ceased to be an integral part; and the patent device included "a bearing designed to hold the cover plate against movement away from the panel," a feature not present in defendant's structure, held: No infringement, the devices being structurally and functionally different. Patent 1595863.—Dorsey v. Pilot Electric Company et al. (Circuit Court of Appeals for the Second Circuit). May 18, 1929.

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Dials for Panel Board in Radio Set: Infringement.—Patent No. 1618921, covering a special type of dial for a panel of a radio set, held: Not infringed.—Dorsey v. Pilot Electric Company et al. (Circuit Court of Appeals for the Second Circuit). May 18, 1929.

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## MAY 20

Brush Machines: Conversion of Intermittent to Continuous Motion: Patentability. —Claims 1 to 3, 8 and 9, covering tuft setting mechanism for brush machines, and based on the feature of transmitting intermittent motion to a work table through the use of a continuously moving cam in lieu of an intermittently moving cam, held: Unpatentable, it being usual in the arts to convert continuous motion to intermittent motion and vice versa. Patent 1712216.—Ex parte Jobst. (Board of Appeals of the Patent Office). May 20, 1929.

Brush Machines: Adjusting Gear: Patentability.—Claim 6, covering brush machines, and being limited to "means for adjustably connecting the removable gear mechanism from the tool operating mechanism to permit the setting of said tool and cams in predetermined timed relation," held: Unpatentable, no invention being necessary for properly adjusting the gear with respect to the other elements. Patent 1712216.—Ex parte Jobst. (Board of Appeals of the Patent Office). May 20, 1929.

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## MAY 24

Lathes for Turning Metal: Validity.—Patent No. 1542803, relating to lathes for turning irregular bodies of metal such as cams, cheek pieces of cranks, etc., held: Valid, since not anticipated by any of the prior art devices, none of them disclosing the purpose, means and mechanism for accomplishing the end of the patent in suit, and a structure corresponding to the plaintiff's device, built up from two prior patents, "indicated inventive thought."—Gordon Form Lathe Company v. Walcott Machine Company. (Circuit Court of Appeals for the Sixth Circuit.) May 24, 1929.

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Lathes for Turning Metal: Infringement.—Where claim 2, Patent No. 1542803, read on defendant's structure, a comparison of the operative parts of the two machines indicating that the same essential elements and the same principle of operation were present in each, and it was shown that defendant built up his machine after inspecting plaintiff's apparatus and noting its defects, made a more perfect machine, held: Defendant infringed, since superiority of operation does not of necessity negative infringement.—Gordon Form Lathe Company v. Walcott Machine Company. (Circuit Court of Appeals for the Sixth Circuit). May 24, 1929.

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## MAY 25

Omission of Element of Combination: Stone Sawing Machine: Infringement.—Patent 1242983 for stone sawing machines, including one source of power to rotate saws and feed stone cars proportionally toward the saws, held: Not infringed by defendant's device which did not include equivalent of the single source of power to operate saws and feed cars proportionally, since in a patent combination claim each element is considered material and patentee can not be allowed to prove that any part of the combination is immaterial.—Rossi v. Barclay. (District Court for the District of Vermont). May 25, 1929.

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Combination of References: Tapered Drawn Structural Element: Patentability.—Claims 1, 2 and 4 to 7, including a seamless drawn tubular structural unit having a uniform longitudinal taper both internally and externally, the ratio of fiber to cross by basic reference showing all the structure called for except that the metal is sectional area increasing in the direction of diminishing diameter, held: Anticipated rolled and welded at the adjacent edges, taken with another patent showing it is old to make seamless tapered tubes by drawing. Ex parte Barnhart. (Board of Appeals of the Patent Office). May 25, 1929.

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## MAY 27

Confection Frozen on Stick: Validity.—Patent No. 1505592, covering a "drink on a stick" and directed to a process consisting in inserting a stick into a container holding flavoring matter, sugar and a potable liquid, subjecting the mixture to refrigeration, heating the container to loosen the wall to permit withdrawal of the confection, whereupon the surface immediately refreezes forming a smooth surface of ice, the product being of such character that the flavoring matter and sugar can be sucked therefrom leaving a tasteless mass of snow and ice, held: Valid over prior art.—The Popsicle Corporation et al. v. Isadore Weiss. (District Court for the Southern District of New York). May 27, 1929.

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Implied License to Use Process Through Sale of Molds: License.—License to use plaintiffs' process can not be implied from the sale of the mold to the defendant in

the absence of evidence that defendant purchased it from someone authorized to sell the molds without restriction, where they are capable of use for purposes other then carrying out the process of the patents. Patents 1470524 and 1505592.—The Popsicle Corporation, et al. v. Isadore Weiss. (District Court for the Southern District of New York). May 27, 1929.

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Process: Confection Frozen on Stick: Validity.—Patent No. 1470524, relating to a process wherein a stick adapted to serve as a handle is placed in a substance that is fluid at normal temperature and the product then subjected to refrigeration, during which the substance becomes attached to the handle by congelation, held: Valid, over a lollypop in which the confection is not liquid at ordinary temperatures, and over a prior patent disclosing a substance frozen to a metal handle having no pores into which water could enter to form a bond and a flexible looped cord facilitate handling the ice but which could not be used to hold a confection while being eaten.—The Popsicle Corporation et al. v. Isadore Weiss. (District Court for the Southern District of New York). May 27, 1929.

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## MAY 31

Carbureter: Adjusting Orifice: Patentability.—Where the carbureter included a pipe rotatably mounted in the venturi, a vane and gas orifice located on the pipe 90 to 180 degrees apart, so that the vane would tend to move the orifice to position to cause it to have a component in the direction of air flow, with result that the gas flow varied inversely with respect to the speed of air; and the reference disclosed vane and orifice 90 degrees apart but discussed effect of adjusting orifice to different positions, held: Claims for carbureter anticipated. Claims 1 and 4, Patent 1711748. —Ex parte Schley. (Board of Appeals of the Patent Office). May 31, 1929.

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Method and Apparatus: Claims.—Where the examiner contended that claims 8, 9 and 10 were improper method claims because of inclusion of apparatus, but the apparatus was not specifically included as elements and was impliedly included by reason of the statements of functions of the apparatus, held: Claims were proper method claims. Patent 1711748.—Ex parte Schley. (Board of Appeals of the Patent Office). May 31, 1929.

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Carbureter: Mechanical Expedient: Patentability.—The feature of providing a spring to dampen the oscillations of a nozzle member is nothing more than a mechanical expedient. Claim 7, Patent 1711748.— Ex parte Schley. (Board of Appeals of the Patent Office). May 31, 1929.

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Carbureter: Distinguishing One Claim From Another: Claims.—Claim 2, held: Patentably distinguished from claim 3, where it differed therefrom in specifying a fuel nozzle which produced a Pitot-tube effect on the fuel discharged therefrom. Patent 1711748.—Ex parte Schley. (Board of Appeals of the Patent Office). May 31, 1929.

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## JUNE 1

Incandescent Lamp: Patentability.—Claim 5, covering a particular construction comprising a flash with the lamp adjustable by the movable battery element bearing against the lamp socket, held: Patentable over prior art. Patent 1712368.—Ex parte Voorhees. (Board of Appeals of the Patent Office). Junt 1, 1929.

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Combination of References: Incandescent Lamp: Patentability.—An incandescent lamp with a filament extending through the focus and along the axis, with means for adjusting the filament along the axis, held: Unpatentable over a combination of references, one showing the arrangement set forth except for the adjusting means, and the other illustrating the adjusting means. Claims 1 to 4 and 6, Patent 1712368.—Ex parte Voorhess. (Board of Appeals of the Patent Office). June 1, 1929.

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Spoke Tighteners: Device for Tightening Wheel Rims to Wood Fellys: Infringement.—Patent No. 1411391, relating to a spoke tightener for wheels and comprising

"a shim provided with an orifice adapted to receive the tenon of a spoke and to be positioned between the spoke and felly of a wheel, and an opening leading to the orifice from the outer edge of the shim," with the distinguishing feature residing in having said opening slightly smaller than the tenon at the junction of the opening with the orifice, held: Infringed by defendant's device which involved the same principle of operation and included equivalent structure, though it varied somewhat as to structural features.—Tucker Brothers Manufacturing Company v. Honeycutt. (District Court for the Western District of Missouri). June 1, 1929.

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Spoke Tighteners: Device for Tightening Wood Wheel Spokes: Infringement.—Patent No. 1424530, covering a "device for tightening wood wheel spokes after they have become loose in the felly through shrinkage or wear," held: Not infringed, owing to the closeness of the prior art to the devices.—Tucker Brothers Manufacturing Company v. Honeycott. (District Court for the Western District of Missouri). June 1, 1929.

# Syllabi of Trade Mark Decisions

*(See Also Master Index on Page 3)*

## MARCH 8

"Dry Goods Economist:" "The Office Economist:" Infringement.—Where plaintiff published and sold a weekly trade journal under the title "Dry Goods Economist," devoted to operation of retail dry-goods stores, and defendant issued a house organ monthly under the title "The Office Economist" which was not sold but was mailed free to possible customers, held: Defendant did not infringe, there being no confusion as to the titles, and the periodicals being different in appearance, purposes and subject matter.—Textile Publishing Company v. Art Metal Construction Company. (District Court for the Southern District of New York.) March 8, 1929.

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Res Adjudicata: "The Office Economist:" Infringement.—Where during the opposition proceedings in the Patent Office, the defendant had been denied registration of the mark "The Office Economist" for the reason that the question whether confusion in trade would be likely seemed at least reasonably doubtful, held: This decision as to right of registration is not res adjudicata as to the question of infringement.—Textile Publishing Company v. Art Metal Construction Company. (District Court for the Southern District of New York.) March 8, 1929.

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Confusing Similarity: Injunction: Infringement.—Where appellee owned the mark "Dux-Bak" immediately below which was printed, first the figure in side view of a duck, and then the words "Waterproofed and Mildewproofed;" and appellant used the word "Rex All" underneath which was placed the figure of a crown and the words "Mildewproofed and Waterproofed," and appellee sought to enjoin alleged infringement, held: Injunction granted, the marks being such, when stenciled on the goods, as to cause confusion.—Clifton Manufacturing Company v. Crawford-Austin Manufacturing Company. (Circuit Court of Appeals for the Fifth Circuit.) March 8, 1929.

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## MARCH 9

Time for Filing Request: Renewal.—The intention of the law is that request for renewal of a trade mark registration must be filed before the period for which the registration was issued has expired.—Ex parte Regal Shoe Company. (Commissioner of Patents.) March 9, 1929.

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## MARCH 20

Descriptive: Color: Registration.—Where appellant's trade mark consisted of a combustible orange colored disc bearing the words "Orange Disc," used on coal, and the examiner ruled that the mark was merely a label or tag of a single color and as such not registrable, held: Registration allowed, as the mark was arbitrary, fanciful and nondescriptive of the goods to which it was applied.—Ex parte Payne Coal Company, Inc. (Assistant Commissioner of Patents.) March 20, 1929.

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## MARCH 21

Confusing Similarity: "Renu;" "Renol:" Opposition.—Where applicant's mark comprised a distinctively shaped panel having the word "Renu" printed in a peculiar manner at its upper portion and a disc depicted at its lower portion, and opposer's mark consisted of the word "Renol" set within an oval border line; and evidence was introduced to show that "Renu" had been commonly used in prior registrations,

held: Registration allowed, the marks not being deceptively similar. S. S. Stafford, Inc., v. Sandhop. (Assistant Commissioner of Patents.) March 21, 1929.

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## MARCH 22

Laches: "Pheasant": Opposition.—Where opposer interposed no objection to applicant's use of the mark "Pheasant" during a period of several years, held: Such laches constituted ground for dismissing opposition.—The H. H. Meyer Packing Company. (Assistant Commissioner of Patents.) March 22, 1929.

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Evidence: "Pheasant": Abandonment.—Where there was merely evidence of non-use of the mark but there was no evidence of intent to abandon, held: Applicant had not abandoned its mark "Pheasant."—The H. H. Meyer Packing Company v. The E. Kahn's Sons Company. (Assistant Commissioner of Patents). March 22, 1919.

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Confusion: "Pheasant": Opposition.—The mark "Pheasant," held: Not confusingly similar to a composite mark including the word "Partridge" and the picture of a partridge, since the two marks do not look alike, sound alike, or convey the same meaning.—The H. H. Meyer Company v. The E. Kahn's Sons Company. (Assistant Commissioner of Patents.) March 22, 1929.

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Confusion: "Silk-lif:" "Silk-Life:" Opposition.—"Silk-lif" as a trade mark for a compound designed to be used in the treatment of hosiery and lingerie to prevent runs and fading, held: Not registrable over opposer's mark "Silk-Life" used on soap intended for cleaning hosiery and underwear and which was alleged to lengthen life and improve luster of the goods, the marks being identical in appearance, spelling, sound and significance.—Lightfoot Schultz Company v. Cosby. (First Assistant Commissioner of Patents). March 22, 1929.

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## MARCH 23

Descriptive Properties of Goods: Opposition.—Where applicant sought registration of its mark "Lux-Gro" for a preparation for the treatment of the hair and scalp, and opposer owned the trade mark "Lux" used in connection with preparations having detergent, washing and cleansing properties and adapted to be used for the hair and scalp, held: Registration denied, the goods having the same descriptive properties, both being toilet articles.—Lever Brothers Company v. Lux-Gro Laboratories. (Assistant Commissioner of Patents.) March 23, 1929.

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## MARCH 25

Goods Sold in Foreign Countries: Infringement.—Where defendant affixed his infringing trade mark to the containers in this country and shipped the goods from the port of New York to foreign countries, held: Injunction proper, the alleged infringing acts being within Section 16 of the Trade Marks Act of 1905. Hecker-H-O Company. Inc., v. Holland Food Corporation. (District Court for the Southern District of New York.) March 25, 1929.

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"H-O": "Hofood": Infringement.—The plaintiff's mark "H-O" used upon certain cereal products, held: Infringed by defendant's trade mark "Hofood" used upon goods having the same descriptive properties.—Hecker-H-O Company, Inc., v. Holland Food Corporation. (District Court for the Southern District of New York.) March 25, 1929.

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Confusion: Representation of Bear: Registration.—Applicant's mark consisting of a pictorial representation of a bear standing upon a block presumably representative of a cake of ice, used upon mints, held: Confusingly similar to trade mark consisting of a representation of a bear in an upright position holding a huge stick of candy. Ex parte Fox's Glacier Mints, Ltd. (First Assistant Commissioner of Patents.) March 25, 1929.

## MARCH 26

Collateral Proceedings: Opposition.—Where petitioner's predecessor had received judgment by default in opposition proceedings and the office had allowed cancellation of the mark as being res adjudicata in view of that judgment; and petitioner appealed from the decision allowing cancellation and also filed petition requesting that the opposition proceeding be reopened, held: Final decision on petition for reopening held in abeyance until after decision on appeal granting cancellation.—Societe Anonyme Des Anciens Establissements Panhard & Levassor v. Panhard Oil Corporation. (First Assistant Commissioner of Patents.) March 26, 1929.

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Res Adjudicata.—Matters Which Should Have Been Adjudicated in Opposition Proceedings: Cancellation.—Where, in an opposition proceeding, the petitioner failed to mention prior use of his mark in connection with canned goods, and in the proceedings for cancellation of registrant's trade mark he endeavored to bring in this additional matter, held: Petitioner estopped to set forth new matter, as the doctrine of res adjudicata applies not only to matters previously adjudicated but also to all matters that could have been adjudicated in the former proceeding.—American Fruit Growers, Inc., v. John Braadland, Ltd. (Assistant Commissioner of Patents.) March 26, 1929.

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## MARCH 28

Confusing Similarity: "Jade 'Or" and "Jardin d'Or": Opposition.—Where applicant sought registration of its trade mark "Jardin d'Or" for toilet preparations, and opposer owned the mark "Jade 'Or", used on goods of the same descriptive properties, held: Registration denied, the marks being confusingly similar to each other. —George Borgfeldt & Co. v. Frederick Stearns & Company. (Assistant Commissioner of Patents.) March 28, 1929.

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## APRIL 2

Confusion: "Poro": Cancellation.—Where the mark "Poro" was used by petitioner and the mark "Toro" by respondent, on toilet articles for shampoos, petitioner being prior in point of time, and evidence introduced indicated that petitioner dealt exclusively with colored people, selling to them through agents, whereas registrant's goods were sold in drug stores and largely to white people; and petitioner sought cancellation of registrant's mark, held: Petition allowed, it being found that colored people in purchasing from drug stores would be confused as to origin of goods.—Malone v. Aladdin Products Company. (First Assistant Commissioner of Patents). April 2, 1929.

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## APRIL 3

Descriptive Terms: Manner of Merchandising Article: "Take It Yourself": Registration.—Applicant seeking registration of the notation "Take It Yourself" as a trade mark for oils and greases, held: Denied registration, since the notation merely describes the manner in which the article is merchandised and, to that extent, describes a characteristic of the article itself.—Ex parte Standard Oil Company of New Jersey. (Commissioner of Patents.) April 3, 1929.

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Individual Name: Geographical Term: "Semet-Solvay Coke": Registration.—Where only one instance of the use of "Semet" as the name of an individual was cited and only one instance of the use of "Solvay" as a town name was furnished, and appellant sought registration of the notation "Semet-Solvay Coke," with the word "coke" disclaimed, as a trade mark, held: Registration allowed, the words not being reasonably well known as a surname and geographical name. Ex parte Semet-Solvay Company. (Assistant Commissioner of Patents.) April 3, 1929.

## APRIL 5

Motion to Reopen: Cancellation.—It is well settled that a case will not be reopened for the taking of further testimony unless it can be shown that the testimony was "newly discovered," that is, was not in the possession of the party now seeking to produce it, and could not have been obtained by the usual and expected search.—Marshall Field & Company v. Trivers. (Commissioner of Patents.) April 5, 1929.

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Descriptive Terms: Registration.—Where the term "Grid-Head," for garment and laundry pressing machines, is applied to the presshead which is sometimes formed with a foraminous bottom, held: Registration denied, the term being definitive of the article rather than indicative of the originator of the article. Ex parte The Prosperity Company, Inc. (Assistant Commissioner of Patents.) April 5, 1929.

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## APRIL 9

Actions: Trade Mark Act of 1905: Injunction Against Use of Mark Within Limits of State and Not Affecting Interstate Commerce: Infringement.—The Trade Mark Act of 1905 (U. S. C. Tit. 15, sec. 96:) does not allow a remedy upon it for infringing a trade mark registered under it, within the limits of a State and not affecting interstate commerce, foreign commerce, or commerce with Indian Tribes.—United States Printing and Lithographing Co. v. Griggs, Cooper & Co. (Supreme Court of the United States.) April 9, 1929.

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## APRIL 17

Confusion: "Soponite" and "Sapolio": Opposition.—Applicant seeking registration of the notation "Soponite" as a trade mark for soap, hand cleaner and general household cleaner, held: Denied registration over opposer's mark "Sapolio" for goods of a like character because of likelihood of confusion in the mind of the purchasing public.—Enoch Morgan's Sons Company v. Menlove. (Assistant Commissioner of Patents.) April 17, 1929.

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Confusion: "Pi-Lo-Jell" and "Jell-O": Opposition.—Where applicant sought registration of the mark "Pi-Lo-Jell" as a trade mark for gelatine powder, the word "Jell" being disclaimed except as it is used in connection with the notation, and opposer owned the trade mark "Jell-O", applied to substantially the same goods, held: Registration denied, the marks being confusingly similar, as purchasers would forget or eliminate the prefix "Pi" and likely call for "Lo-Jell" or "Jell-O".—Postum Cereal Company, Inc., v. Haas-Lieber Grocery Company. (First Assistant Commissioner of Patents.) April 17, 1929.

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## APRIL 19

Dismissal of Appeals: Failure to Appear or File Return: Procedure.—Where, in case of appeal to the Commissioner of Patents from the decision of the examiner of trade marks or the examiner of trade mark interferences, no brief is filed or appearance made in behalf of the appellant, held: Appeal dismissed.—Ex parte The Ohio Chemical & Manufacturing Co (First Assistant Commissioner of Patents.) April 19, 1929.

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## APRIL 24

Descriptive Properties: Registration.—Where applicant sought a trade mark for the notation "Granite State" for use on cotton duck in the piece and there was a prior registration of the mark as applied to ginghams in the piece, held: Registration refused, the goods being so nearly alike as to be likely to cause confusion.—Ex parte John Boyle & Company, Inc. (First Assistant Commissioner of Patents.) April 24, 1929.

## APRIL 25

Notation Written in Distinctive Manner: Registration.—Applicant's trade mark comprising the notation "Doctor B. F. Davis" arranged with the word "Doctor" above the name "B. F. Davis," the larger letters being in the center, the other letters tapering toward each end and the entire outline completed by the use of two triangular dots at each end, held: Registrable, the entire notation being set forth in an unusual and distinctive manner.—Ex parte Marsh. (First Assistant Commissioner of Patents.) April 25, 1929.

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Descriptive Words: "Masque": Registration.—The word "Masque," as mark for cosmetics, though written in a distinctive manner in that certain of the letters were written distinctively, held: Descriptive and not registrable since the purchasing public when pronouncing it would merely regard the term as the common word "Mask." —Ex parte Beauty Research Laboratories, Inc. (First Assistant Commissioner of Patents, 1929.) April 25, 1929.

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Confusion: "Masque": Registration.—Where applicant sought registration of the mark "Masque" and it was found that the word "Mask" has long been registered for goods of the same character, held: Registration denied because of probable confusion.—Ex parte Beauty Research Laboratories, Inc. (First Assistant Commissioner of Patents.) April 25, 1929.

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## APRIL 27

Descriptive Properties of Goods: "Jack Frost": Opposition.—Where applicant sought registration of the notation "Jack Frost" for use on coffee and tea in dry form, and the opposer owned the same mark as applied to concentrated extracts and syrups for making non-alcoholic maltless beverages, held: Registration allowed, the descriptive properties of the goods being different.—F. B. Chamberlain Company v. Chase & Sanborn. (Assistant Commissioner of Patents.) April 27, 1929.

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## MAY 1

Descriptive Properties of Goods: Opposition.—Where applicant's mark "Jiffy Jacks" was applied to men's, women's and boy's jackets and the opposer owned the mark "Jiffy" used upon mechanics suits, cloth shirts and trousers, held: Registration of applicant's mark denied, the goods of both parties being clearly outer wearing apparel and belonging to the same class.—Guiterman Bros., Inc., v. Shapiro & Rubin. (First Assistant Commissioner of Patents.) (May 1, 1929.

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Confusion: Opposition.—Where applicant sought registration of the notation "Jiffy Jacks" and beneath such notation the words "Rival Brand," the latter words being disclaimed, and the mark being used on men's, women's and boys' jackets, and the opposer owned the mark "Jiffy" applied to mechanics suits, cloth shirts and trousers, held: Registration denied, confusion being quite probable as purchasers would be apt to recognize and call for the garments by the name "Jiffy."—Guiterman Bros., Inc., v. Shapiro & Rubin. (First Assistant Commissioner of Patents.) May 1, 1929.

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## MAY 2

"Flash Cracker;" Injunction Pendente Lite: Unfair Competition.—Where defendant used red, white and blue cartons and containers similar in size and appearance to those made by plaintiff and employed a folder almost identical to that used by plaintiff; and plaintiff brought motion for preliminary injunction, held: Injunction granted, for unfair competition.—Hitt Flashcracka Company v. Victory Sparkler & Specialty Co. (District Court for the District of Delaware.) May 2, 1929.

## MAY 3

Right to Priority: Interference.—Where it was shown that registrant assigned her interest in the mark on May 26, 1910, the assignees coming into legal possession of the trade mark registration and taking no steps to indicate intention to abandon it, and their rights continued during the life of the registration, viz., until April 23, 1927, and each of the parties in interference adopted the mark prior to the latter date, held: Priority denied to either of the parties, as neither could claim priority of adoption over the others, the rights at the time of adoption having been vested in the assignees.—Eugene J. Murphy Company v. McFarland. (Assistant Commissioner of Patents.) May 3, 1929.

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Confusion: Opposition.—Where applicant sought registration of the notation 'Rocklath" as a trade mark for plaster boards and the opposer proved prior adoption of the notation "Locklath" used upon identically the same kind of goods, held: Registration of "Rocklath" denied, the first portions of the marks being so alike in spelling and sound that the marks considered as a whole are confusingly similar.—Plastoid Products, Inc., v. United States Gypsum Company. (First Assistant Commissioner of Patents.) May 3, 1929.

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## MAY 4

Showing of Damages Sufficient to Support Opposition: Opposition.—Where applicant sought registration of a composite trade mark bearing the notation "Yankee" prominently above the entire representation and the words "For Duco Finish Varnish Enamel or Furniture Body Polish" below the representation, and opposer did not establish prior use of the word "Yankee" as a trade mark but did establish use of it for a long time on its goods, held: Registration to applicant denied, the opposer having acquired a right to use the mark.—Yankee Polish Company, Inc., v. Yankee Dandy Products Company. (First Assistant Commissioner of Patents). May 4, 1929.

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Descriptive Properties of Goods: Opposition.—Descriptive properties of shoe polish and of polishes for furniture held to be the same.—Yankee Polish Company, Inc., v. Yankee Dandy Products Company. (First Assistant Commissioner of Patents.) May 4, 1929.

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## MAY 6

Priority of Use: Requisites to Acquire Title to Technical Trade Mark: Opposition.—Where opposer had adopted the trade mark "Resistox," and applied it to materials comprising aldehyde-amine condensation products, but did not prove it had actually put the commodity so marked on the market, held: Opposition not sustained, since mere sending out of unsolicited samples of a commodity with the mark affixed does not constitute trade mark use of the mark.—The Rubber Service Laboratories Co. v. American Cyanamid Company. (Assistant Commissioner of Patents.) May 6, 1929.

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Stipulation as to Use of Mark: Effect: Opposition.—Where applicant and opposer stipulated that applicant had used its mark since December 15, 1927, held: Burden placed on opposer to show beyond a reasonable doubt its own trade mark use prior to that date.—The Rubber Service Laboratories Co. v. American Cyanamid Company. (Assistant Commissioner of Patents.) May 6, 1929.

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Confusing Similarity: Opposition.—"Retardox" and "Resistox," for goods having the same descriptive properties, held: Confusingly similar.—The Rubber Service Laboratories Co. v. American Cyanamid Company. (Assistant Commissioner of Patents.) May 6, 1929.

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Confusion: Colors: Opposition.—The applicant seeking registration of a mark consisting of a green color on the tips of the free ends of kitchen and household

tools or utensils, and the opposer being prior in point of time and owning a mark consisting of a blue color on the tips of the free ends of the same class of goods, held: Applicant's mark registrable, since the opposer, having adopted a particular color as a trade mark and used it on a particular portion of a kitchen utensil, cannot extend its proprietary rights to include any other primary color used in like manner upon the same goods.—A. & J. Manufacturing Company v. R. Wallace & Sons Manufacturing Company. (First Assistant Commissioner of Patents.) May 6, 1929.

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## MAY 8

Confusing Similarity: Cancellation.—Petition for cancellation of registrant's mark comprising a diamond shaped outline within which appears the letter "B" and below all of which appears the notation " 'Diamond B' Motor Oils," held: Allowed, the mark being similar in appearance and sound to petitioner's trade mark "Diamond C" for motor oils.—Sinclair Refining Company v. Blackburn. (First Assistant Commissioner of Patents). May 8, 1929.

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## MAY 9

Subjects of Registration: Catalogues Describing Goods for Sale: Registration.—A mark comprising the words "Great American" with the representation of an Indian beneath them carrying a bow and arrows, used upon a jewelry catalog, delivered without charge to prespective customers of the goods advertised, and issued regularly, the catalog being of considerable size, containing many illustrations, some highly colored and ornamental, adapted to be of great value to dealers in reselling the goods, held: Registrable.—Ex parte The Oscamp Nolting Co. (First Assistant Commissioner of Patents). May 9, 1929.

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## MAY 13

Confusion: Opposition.—Where applicant sought registration of the notation "Waltex" placed within a diamond shaped figure or outline, as a trade mark for composition insulating wall boards, and the opposer was long prior in point of time and owned the mark "Celotex" as applied to the same class of goods, held: Registration allowed, since the marks differ in spelling, significance, sound and appearance, the first portion of the marks being different and the latter portion having been registered to other parties.—The Celotex Company v. Wilson. (First Assistant Commissioner of Patents). May 13, 1929.

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## MAY 17

Confusion: "Plastex": "Craftex": Opposition.—Where applicant sought registration of the notation "Plastex" as a trade mark for a composition of animal and mineral substances used for interior finishes for buildings, and opposer owned the mark "Craftex," used on the same class of goods, held: Opposition dismissed, since the marks are different in appearance, sound and suggestion, the common portion "Tex" being old in trade mark registrations.—Craftex Company v. Plastex Company of America, Inc. (Assistant Commissioner of Patents). May 17, 1929.

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## MAY 18

Confusion: Infringement.—Where the plaintiff uses the trade mark "Soiesette" as applied to cotton fabrics and the defendant uses the notation "Soisette" as applied to toilet paper, held: Plaintiff's mark not infringed, there being no confusion since the two products are in different classes, there is no association of the two products in the selling of them, and the advertisements for the two products would not be placed in the same periodicals.—Ponemah Mills and American Bleached Goods Company, Inc. v. Universal Crepe & Tissue Mills, Inc. (District Court for the Southern District of New York). May 18, 1929.

Unfair Competition: Infringement.—Where the bill of complaint included a charge of unfair competition, but there was no similarity in labels, packages, advertisements, etc., although both parties used the word, "Soisette" and included phonetic spelling of it, held: Charge of unfair competition not sustained.—Ponemah Mills et al. v. Universal Crepe & Tissue Mills, Inc. (District Court for the Southern District of New York). May 18, 1929.

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False Descriptive Expressions: Registration.—The notation "Crow-Tox" as a trade mark for "a nonpoisonous preparation for protecting seed against birds and animals and for invigorating seed," held: Registration denied, it being well settled that a word cannot be appropriated as a trade mark which is either truly descriptive or falsely descriptive of the goods to which it is applied, the word "Tox" in this case being defined as a poison.—Ex parte Bonide Chemical Co., Inc. (Assistant Commissioner of Patents). May 18, 1929.

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## MAY 25

Fraud of Opposer as a Bar to Exclusive Use of Mark: "Purple Cross": Opposition. —Where the opposer seeking to prevent registration to applicant of the notation "Purple Cross" as a trade mark for toilet paper had been guilty of fraud in advertising, held: Opposition dismissed, since the opposer must be guiltless of false misrepresentation as to the mark relied upon as a basis for the opposition or in advertising the goods on which the mark is used.—Sanquoit Paper Co., Inc., v. Weistock. (Assistant Commissioner of Patents). May 25, 1929.

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Order to File Copies of Licenses: Motion for Judgment of Record: Cancellation.—Where certain specified licenses were referred to in the answer to a petition for cancellation of trade mark, and petitioner brought motion for judgment on the record for respondent's failure to furnish copies of the licenses, the petitioner seeking the copies not to establish title to the trade marks but to show that th marks had been so farmed out by licenses that the registraions were not valid, held: Motion denied, but the case remanded to the Examiner with instructions to fix a time within which respondent should file copies of the licenses.—Brockton Shoe Manufacturing Company, Inc., v. Brown. (Assistant Commissioner of Patents). May 25, 1929.

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Order Entered by Consent: Modification: Cancellation.—Decision of the Examiner of Interferences modifying an order which had been entered by consent between the parties in trade mark cancellation proceedings held to be without authority.—Brockton Shoe Manufacturing Company, Inc., v. Brown. (Assistant Commissioner of Patents). May 25, 1929.

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## JUNE 1

Descriptive Notations: "Unitube:" Registration.—Where a disclaimer of the notation "Unitube," constituting part of a composite mark used by the appellant on anesthetic tablets and solutions which were sold in unit tube containers, had been required on the ground of its being descriptive, held: Decision requiring disclaimer reversed, the notation not being found descriptive of the tablets and solution, the goods to which the mark was applied.—Ex parte Smith. (First Assistant Commissioner of Patents). June 1, 1929.

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## JUNE 3

Confusion: Descriptive Properties: "Air-O:" Cancellation.—Where registrant's mark "Air-O" was used for belts for men's and women's wear and petitioner had previously adopted the word "Arrow" associated with a pictorial representation of an arrow, for other articles of wearing apparel such as shirts, collars, etc., and petitioner sought cancellation of the mark "Air-O," held: Petition denied there being no evidence of confusion and the descriptive properties of the goods being different. —Cluett, Peabody & Co., Inc., v. Wright. (Assistant Commissioner of Patents). June 3, 1929.

Descriptive Marks: "Goose Load:" Registration.—The notation "Goose Load," "Snipe Load," "Deer Load," etc., accompanied with the pictorial representation of the habitat of the bird or animal for which a particular type of ammunition was intended, for various cartridge loads, held: Not registrable, as being descriptive of the class of goods to which the marks were applied.—Western Cartridge Company v. Remington Arms Company, Inc. (First Assistant Commissioner of Patents). June 3, 1929.

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Anticipation: "Goose Load:" Opposition.—The notation "Goose Load," "Deer Load," etc., accompanied with pictorial representation of the habitat of the bird or animal for which the particular type of ammunition was intended, for various cartridge loads, held: Not registrable because of prior registrations and opposer's prior use of pictorial representations of game used in connection with game loads and other forms of ammunition.—Western Cartridge Company v. Remington Arms Company, Inc. (First Assistant Commissioner of Patents). June 3, 1929.

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# COPYRIGHT SECTION

APRIL 27

## *Decision on Right to Provide Copyrighted Radio Music in Hotel*

GENE BUCK, AS PRESIDENT OF THE AMERICAN SOCIETY OF COMPOSERS, AUTHORS & PUBLISHERS, AND DE SYLVA, BROWN & HENDERSON, INC., PLAINTIFFS, V. WILSON DUNCAN, OPERATING RADIO STATION KWKC, AND JEWELL-LA SALLE REALTY COMPANY; SAME V. JEWELL-LA SALLE REALTY COMPANY. IN EQUITY, NOS. 1204 AND 1207, DISTRICT COURT FOR THE WESTERN DISTRICT OF MISSOURI.

HOTELS which own central radio receiving sets may receive and furnish to their guests, in public and private rooms, copyrighted musical compositions broadcast from a radio station without being guilty of infringement of the copyright, the Court held herein, on the ground that the hotel did not "perform" the copyrighted compositions within the meaning of the Copyright Act.

The reception of a musical composition on a radio receiver is not a performance at all, the Court stated, and the fact that the hotel transmitted the composition received to its guests in the different rooms did not make such an act a performance as is required to constitute an infringement.

### Agreement of Court

The Court agreed with the contentions of the plaintiff that if another than the owner of a copyrighted musical composition perform without license such composition by playing publicly for profit a record of it on a phonograph, his act is an infringement of the copyright. Such fact, it was held, however, does not make it an infringement of the copyright for such person to receive and furnish publicly for profit such a composition by means of a radio receiving set. The phonograph record is a separate and distinct thing from the original performance, it was pointed out, whereas the radio reception of a musical composition is not a reproduction, but a hearing of the original performance.

The full text of the memorandum decision of Judge Otis follows:

In these two cases plaintiffs seek injunctions against and damages from the defendant Jewell-La Salle Realty Company, on account of alleged copyright infringements. In case No. 1204 it is alleged that the defendant infringed and threatens to continue to infringe the copyright to a musical composition entitled "Just Imagine" and in case No. 1207 it is alleged that the defendant infringed and is threatening to continue to infringe the copyright to a musical composition entitled "I'm Winging Home (Like a Bird that is on the Wing)."

The facts are that the Jewell-La Salle Realty Company owns and operates in Kansas City, Mo., a hotel known as the La Salle Hotel. In that hotel it has a master radio receiving set by means of which it furnishes musical entertainment to its guests in its public rooms and also to 200 private rooms by means of wires leading from this master radio receiving set. Any musical composition picked up by the receiver can be and is simultaneously heard throughout the hotel.

### Were Heard in Hotel.

On October 4, 1928, and at other times, the musical compositions "Just Imagine" and "I'm Winging Home (Like a Bird that is on the Wing)" were thus heard in the hotel.

These musical compositions were copyrighted. The American Society of Composers, Authors & Publishers had the ex-

clusive non-dramatic performing rights in and to these musical compositions and these suits were brought by Gene Buck, one of the plaintiffs, as president of that society, and by the owners of the copyrights.

The question in the cases, so far as Count 1 in each case is concerned, is whether the defendant upon the facts stated infringed the copyright.

1. Section 1 of the Copyright Act provides:

> That any person entitled thereto, upon complying with the provisions of this act, shall have the exclusive right: * * *
> (e) To perform the copyrighted work publicly for profit if it be a musical composition; * * *.

Did the defendant "perform" the copyrighted works here involved "publicly for profit"? If it did, the injunctions sought should issue and damages should be awarded.

I think the defendant did not perform these musical compositions in the sense in which the word "perform" is used in the act.

One who plays a musical composition on a piano, thereby producing in the air sound waves which are heard as music, certainly performs that musical composition and if the instrument he plays on is a piano plus a broadcasting apparatus, so that waves are thrown out, not only upon the air, but upon the ether, then also he is performing the musical composition. He who only hears the performance is not performing. If the sound waves from the piano fall on the unaided ears of a listener, that listener has no part in the performance and if he is deaf so that he cannot hear without the aid of an amplifier electrically operated which magnifies the sound waves so that they become perceptible to him, he still has no part in the performance. It is true in the latter case he has been enabled to hear the music only by means of a machine operated by himself. By that means he has made that which was inaudible audible to himself. But he has not performed because he has not created. He has heard only what the performer at the piano created and sent out to be heard.

**Listener Not a Performer**

Would it be said that one who listens over a telephone to a performance on a piano at some point removed from him is himself performing the composition that he hears? It seems to me that that cannot be said. If not, why not? The listener has not heard the sound waves produced by the piano in that case. The original sound waves have been translated into electrical impulses which have been caried by a wire to the place where the listener is. There, by a machine electrically operated, those electrical impulses have been changed again into sound waves which fall upon the listener's ears. The listener over the telephone has not performed because he has not created the music which he has heard.

The right to perform a musical composition is the right to translate that musical composition into waves of sound or waves of ether for the enjoyment of those who are enabled either by natural or artificial means to receive the auditory sensations those waves are calculated to produce. The right to perform a musical composition does not carry with it a proprietary interest in the waves that go out upon the air or upon the ether. They are as much the common property of all as the sunshine and the zephyr.

If I throw open a window so that I can hear the music of a band passing by, am I producing that music? Am I then the performer or participating in the performance? If I lift a telephone receiver and hear the voice of a friend, am I producing that voice? Is it my speech or his? If in perfect analogy to these illustrations, by mechanical means, I receive as music what has been produced elsewhere in such a way that it penetrates my house, I am not the performer who has produced that music.

It is true that if one plays on his phonograph a record of a piece of music he is performing. If it is a copyrighted musical composition and if the performance is public and for profit, then his act is an infringement of the copyright. Plaintiffs say that there is no difference in principle between playing by phonograph a record impressed on bakelite and playing by radio receiver a record impressed on the ether. Obviously, there is a difference. The record on bakelite is a separate and distinct thing from the original performance in the studio where the record was made. Playing that record is performing anew the musical composition imprinted on it. The waves thrown out upon the ether are not a record of the original performance. They are the original performance. Their reception is not a reproduction, but a hearing of the original performance.

The reception of a musical composition on a radio receiver is not a performance at all. Of course, then, the defendant did not perform these copyrighted musical compositions.

Moreover, infringement must be an in-

tentional act. I do not mean by that that one who performs a copyrighted musical composition publicly for profit is not guilty of infringement merely because he does not know the piece is copyrighted. The law is otherwise. But certainly there must have been an intentional performance of the musical composition. There is an intentional performance when, for example, one plays on an instrument from a sheet of music a piece of music. There is an intentional performance when one plays on a phonograph a record. In either of these cases if the performance is public and for profit, there is infringement, if the musical composition is copyrighted, and that whether the performer is or is not cognizant of the copyright.

Suppose, however, the proprietor of a hotel has a phonograph playing in his dining room for the entertainment of his guests and suppose that without any request from him or participation on his part a stranger surreptitiously places in the machine a record of a copyrighted musical composition. Would it not be unthinkable that that hotel proprietor should be held guilty of infringement and subject to damages? His intent in no wise entered into that performance. If it was a performance, in no sense was it his performance. It is not possible that mere ownership of a musical instrument carries with it liability for any use to which another may put that instrument.

So, in this case the defendant did not intentionally perform the copyrighted musical composition, even if it be granted that radio reception is performance. The defendant had a right to have a radio in its hotel for the entertainment of its guests and to operate that radio. If, while it was operating, some other than the defendant, wholly without defendant's participation, put upon the ether and so threw into defendant's radio electric impulses which came out of the radio as an audible rendition of a copyrighted musical composition, that was not in any sense the act of the defendant. The intent of the defendant did not enter into that act. If it was a performance of a musical composition it was a performance not by the defendant, but by the broadcaster on the defendant's instrument.

### No Citations Made

If radio reception of a musical composition is not performance of that composition and if, though it be, it is not performance by the owner of the radio receiving instrument, it is not necessary to consider whether the defendant operated its radio for profit. The plaintiffs are not entitled either to the injunctions prayed or damages sought.

I have cited no authorities because there are none. The case is one of first impression. Certain cases have been cited by the plaintiffs by reason of dicta thought by plaintiffs to be pertinent to the issue here and those cases I have carefully considered but I think they do not justify any other conclusion than that which I have reached.

2. In Count 7 of Case No. 1207 it is charged that the defendant infringed the copyright of a musical composition entitled "He's the Last Word." The infringement is admitted by the defendant. The sole question is as to the proper measure of damages. Plaintiffs insist that the minimum damages which may be allowed are $250, and the defendant insists that the damages which may be allowed are $10.

The weight of authority is with the plaintiffs. Waterson, Berlin & Snyder Co. v. Tollefson, 253 Fed. 859; Witmark & Sons v. Pastime Amusement Co., 298 Fed. 470; Remick & Company v. General Electric Company, 16 Fed. (2d) 829; Buck et al. v. Heretis, 24 Fed. (2d) 876. In only one decided case (Berlin, Inc., v. Daigle, 26 Fed. (2d) 149) was a contrary conclusion reached and that case on appeal was reversed by the Circuit Court of Appeals for the Fifth Circuit. Berlin, Inc., v. Diagle, 31 Fed. (2d) 832, decided April 2, 1929.

I resolve the issue in favor of the plaintiffs and on this count award plaintiffs' damages against the defendant in the amount of $250 and an attorney's fee in the amount of $100.

A decree embodying the foregoing conclusions may be submitted for approval and entry.

April 18, 1929

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